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IN THE
Supreme Court of the United States

OCTOBER TERM, 1986

MEAD DATA CENTRAL, INC.,

Petitioner,

—against—

WEST PUBLISHING COMPANY,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT**

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Questions Presented for Review

Respondent is the dominant publisher of state and federal judicial opinions in the United States. Although judicial opinions are not themselves protected by copyright, respondent claims copyright protection for its "arrangements" of opinions in published volumes, and on that basis respondent seeks to enjoin petitioner, the proprietor of LEXIS, from adding to LEXIS a "star pagination" feature that would identify, by citations to page numbers, where portions of opinions can be found in volumes published by respondent. The courts below upheld respondent's claim.

The questions presented, as to which the Courts of Appeals are in conflict, are:

1. Whether a publisher of uncopyrighted judicial opinions is entitled to copyright protection of the page numbers of such opinions.
2. Whether a rival reporter's references to the page numbers of published judicial opinions, for the purpose of identifying where portions of opinions can be found, can be enjoined as an actionable infringement of copyright.

Statement Pursuant to Rule 28.1

Petitioner Mead Data Central, Inc. is a wholly-owned subsidiary of The Mead Corporation, an Ohio corporation. Mead Data Central, Inc. has the following subsidiary which is not wholly-owned: Applied Information Technologies Corporation. The Mead Corporation is publicly held and has no parent corporation.

The Mead Corporation has the following subsidiaries and affiliates which are not wholly-owned: Upper Peninsula Land Company; Northwood Forest Industries, Ltd.; BC Chemicals Ltd.; Georgia Kraft Company; Adelphi Partnership; Harima M.I.D., Inc.; Mead Emballage, S.A.; Mead Imballaggi SPA; Newmark Associates; Mead-Pac AB; Northwood Panelboard Company; Primus; California Reinsurance Mgt. Corp.; Hopewell International Company, Inc.; Wrenford Insurance Company Ltd.; Brunswick Pulp Land Co.; Mead Toppan Company, Ltd.; Seaboard Paper Company; Sistemas de Envase Y Embalaje, S.A.; Brunswick Pulp & Paper Company; Xenia Paperboard Corporation; International Fibre Sales, S.A.; and Newmark Associates —K.

TABLE OF CONTENTS

	PAGE
Questions Presented for Review	i
Statement Pursuant to Rule 28.1	ii
Table of Authorities	iv
Opinions Below	1
Basis of Jurisdiction	2
Statutory Provisions Involved	2
Statement of the Case	2
A. Factual Background	3
B. The Decisions Below	5
ARGUMENT	8
Federal Copyright Law Does Not Reserve to Re- porters of Judicial Opinions Any Exclusive Right to Identify Where Passages of Opinions Can Be Found in Published Volumes.	12
A. Copyright Protection Cannot Be Extended to Public Domain Material, Such as Page Num- bers	13
B. Identifying Where Public Domain Material Can Be Found in a Published Volume Is Not an Exclusive Right Reserved to Authors by Copyright	15
CONCLUSION	18

TABLE OF AUTHORITIES

Cases

	PAGE
<i>Banks Law Publishing Co. v. Lawyers' Co-Operative Publishing Co.</i> , 169 F. 386 (2d Cir. 1909) (per curiam), <i>appeal dismissed</i> , 223 U.S. 738 (1911)	3, 7, 8, 9
<i>Banks v. Manchester</i> , 128 U.S. 244 (1888)	10
<i>Building Officials & Code Adm. v. Code Technology, Inc.</i> , 628 F.2d 730 (1st Cir. 1980) ...	12
<i>Compco Corp. v. Day-Brite Lighting, Inc.</i> , 376 U.S. 234 (1964)	10
<i>Durham Industries, Inc. v. Tomy Corp.</i> , 630 F.2d 905 (2d Cir. 1980)	14
<i>Eggers v. Sun Sales Corp.</i> , 263 F. 373 (2d Cir. 1920)	17
<i>Gillespie v. United States Steel Corp.</i> , 379 U.S. 148 (1964)	11
<i>Harper & Row, Publishers, Inc. v. Nation Enterprises</i> , 105 S. Ct. 2218 (1985)	3, 9, 14, 15
<i>Hoehling v. Universal City Studios, Inc.</i> , 618 F.2d 972 (2d Cir.), <i>cert. denied</i> , 449 U.S. 841 (1980)	14
<i>Kellogg Co. v. National Biscuit Co.</i> , 305 U.S. 111 (1938)	11
<i>Kipling v. G.P. Putnam's Sons</i> , 120 F. 631 (2d Cir. 1903)	17
<i>New York Times Co. v. Roxbury Data Interface, Inc.</i> , 434 F. Supp. 217 (D.N.J. 1977)	17
<i>Sears, Roebuck & Co. v. Stiffel Co.</i> , 376 U.S. 225 (1964)	11

<i>Sony Corp. v. Universal City Studios, Inc.</i> , 464 U.S. 417 (1984)	3, 9, 15, 16
<i>United States v. Loew's, Inc.</i> , 371 U.S. 38 (1962)	11
<i>United States v. General Motors Corp.</i> , 323 U.S. 373 (1944)	11
<i>Walker v. Time Life Films, Inc.</i> , 784 F.2d 44 (2d Cir.), <i>cert. denied</i> , 106 S. Ct. 2278 (1986)	14
<i>Warner Bros. v. American Broadcasting Companies, Inc.</i> , 720 F.2d 231 (2d Cir. 1983)	14
<i>Wheaton v. Peters</i> , 33 U.S. (8 Pet.) 591 (1834) ..	10, 12

Statutes

17 U.S.C. § 102(a)	13
17 U.S.C. § 102(b)	4
17 U.S.C. § 103(b)	13
17 U.S.C. § 105	14
17 U.S.C. § 106	15, 16
17 U.S.C. § 501	15, 16
28 U.S.C. § 1254(1)	2
28 U.S.C. § 1292(a)	2
28 U.S.C. § 1331	2
28 U.S.C. § 1338	2

Other Authorities

M. Nimmer, <i>Nimmer on Copyright</i> (1985) ..	9, 13, 14, 17
R. Stern, E. Gressman & S. Shapiro, <i>Supreme Court Practice</i> (6th ed. 1986)	11



IN THE
Supreme Court of the United States

October Term, 1986

No. 86-

MEAD DATA CENTRAL, INC.,

Petitioner,

—against—

WEST PUBLISHING COMPANY,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO
THE UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT**

Mead Data Central, Inc. ("MDC") petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Eighth Circuit entered in this action on September 4, 1986.

Opinions Below

The majority opinion of the Court of Appeals is reported at 799 F.2d 1219 and appears in Appendix A hereto. The opinion of Judge John W. Oliver, concurring in part and dissenting in part from the majority opinion, is reported at 799 F.2d 1230 and appears in Appendix B hereto. The opinion of the District Court is reported at 616 F. Supp. 1571 and appears in Appendix C hereto. The modified preliminary injunction issued by the District Court appears in Appendix D hereto.

Basis of Jurisdiction

The judgment of the Court of Appeals was entered on September 4, 1986. No petition for rehearing was filed. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

This is an action for alleged copyright infringement over which the District Court had jurisdiction under 28 U.S.C. §§ 1331 and 1338. The Court of Appeals had jurisdiction under 28 U.S.C. § 1292(a).

Statutory Provisions Involved

This case involves Sections 101-03, 106 and 501 of the Copyright Act of 1976, 17 U.S.C. §§ 101-810 (1982) (the "Copyright Act"). The text of these and certain related provisions of the Copyright Act appears in Appendix E hereto.

Statement of the Case

This case involves the claimed right of West Publishing Company ("West"), under the Copyright Act, to forbid star pagination¹ to West-published reports of judicial opinions. Although it is unquestioned that judicial opinions are

¹ Star pagination is the means by which reporters of judicial opinions traditionally have identified where, within parallel sets of reports, corresponding pages of judicial opinions appear. *See, e.g.*, 45 S. Ct. (1926) ("The corresponding pages of the official U.S. Reports are indicated in this volume by citation over each title, supplemented by star paging"). Star pagination appears today in such familiar publications as *Supreme Court Reporter*, *Lawyers' Edition*, *New York Supplement*, *California Reporter*, *Atlantic Reporter*, *Northeastern Reporter*, *Pacific Reporter*, and *Northwestern Reporter*. Judicial notice may be taken that "law book publishers in the United States have long and traditionally used star pagination in their publication of court opinions." 799 F.2d at 1235 [Appendix B at B13] (Oliver, J., dissenting).

in the public domain and that no reporter of opinions can prevent another from citing to the volume titles (*i.e.*, "800 F.2d") and page numbers (*i.e.*, "800 F.2d 123") indicating where published reports of opinions *begin*, West has nonetheless claimed in this case, and the courts below have held for the first time, that citations to page numbers *within* published reports of opinions (*i.e.*, "800 F.2d at 125") is copyright infringement and can be enjoined.

As a result of the decisions below, MDC has been prevented from adding a star pagination feature to LEXIS, the legal profession has been denied the full advantages of the latest advances in computer technology, and the law of copyright has been fundamentally distorted. The decisions below conflict with a decision of the United States Court of Appeals for the Second Circuit on the identical question, *Banks Law Publishing Co. v. Lawyers' Co-Operative Publishing Co.*, 169 F. 386 (2d Cir. 1909) (*per curiam*) (upholding star pagination in *Lawyers' Edition*), *appeal dismissed*, 223 U.S. 738 (1911), and are contrary to applicable decisions of this Court. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S. Ct. 2218 (1985); *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

A. Factual Background

MDC. MDC conceived and first implemented the concept of computer-assisted legal research. The LEXIS service, which MDC introduced in 1973, offered the legal profession, for the first time, an alternative to conventional methods of legal research, which had changed little since the turn of the century. With LEXIS, a lawyer in the smallest firm could have access to a vast on-line library of legal materials, and legal research could be conducted faster, more economically, and more thoroughly than ever was

possible with conventional research tools, such as indices and digests.

The LEXIS service, today, has more than 300,000 trained users, is available in 47 countries worldwide, and offers users an ever-expanding collection of legal and related materials on-line, including the full text of opinions handed down by virtually all state and federal courts in the United States. LEXIS allows users to conduct legal research using words, logic, and search requests of virtually unlimited length and complexity. Reports of opinions in LEXIS are offered in various court and subject matter "libraries," such as FEDTAX (for federal tax materials), which MDC originated and which have no counterpart in any West publication. Individual opinions in LEXIS are identified by court, date, party names, and one or more citations to published sources, including West publications.

West. Respondent West is the dominant publisher of state and federal judicial opinions in the United States. Since approximately 1880, West has reported the full text of state and federal court opinions in series of published volumes, which West refers to as "National Reporter System" publications. West claims separate compilation copyrights for each volume of these publications, which are evidenced by separate Certificates of Registration for each volume. The "National Reporter System" is not itself protected by copyright, as no "system" is. *See* 17 U.S.C. § 102(b) [Appendix E at E3]. In response to LEXIS, West in 1975 brought out its own computer-assisted, on-line service, which is known as WESTLAW.

The LEXIS Star Pagination Feature. MDC developed and in June 1985 announced a combination of new software and database enhancements (collectively, the "LEXIS Star Pagination Feature") that would allow LEXIS research results to appear together with "jump" citations to pages of

opinions in published sources.² The LEXIS Star Pagination Feature would work the same way, and would provide the same type of information, as the star pagination which appears in various print publications of West and other legal publishers. The LEXIS Star Pagination Feature would identify where the text of judicial opinions begins and ends on the pages in cited sources, and thus enable LEXIS users better to find specific passages of opinions, to make better use of citation services such as Shepard's, and to make jump citations to opinions in briefs and other legal writings.

West's Complaint. In response to MDC's announcement of the LEXIS Star Pagination Feature, West—whose WESTLAW service has no star pagination feature—brought the present lawsuit claiming that “MDC's intended use of West's page numbers will constitute copyright infringement” (Complaint ¶ 28). West's complaint did not challenge MDC's right to identify the pages where opinions reported in West publications *begin*, but claimed only that MDC's proposed use of the page numbers *within* such opinions was copyright infringement.

B. The Decisions Below

The District Court. West moved for a preliminary injunction on its copyright claims, which was granted. The District Court held that “West's page numbers . . . are necessarily within the scope of copyright protection,” 616 F. Supp. at 1577 [Appendix C at C8], and that “use of the second and succeeding numbers following the initial citation to West's arrangement, the so-called ‘jump cite’ (*i.e.*,

² An illustration of the LEXIS Star Pagination Feature appears in Appendix F to this petition. The first page of Exhibit F shows a LEXIS response to the search request NATIONAL REPORTER SYSTEM, without star pagination; the second page shows how the same research result would appear with star pagination.

479 F.2d 701, 702), infringes on West's copyright." *Id.* at 1579 [Appendix C at C12]. The District Court accordingly entered an order preliminarily enjoining MDC from "displaying, referencing or including the page numbers of any and all publications within plaintiff's National Reporter System . . . published during the period from January 2, 1910 to the present within or in relation to the text of court opinions contained in the LEXIS database." *West Publishing Co. v. Mead Data Central, Inc.*, Civ. No. 4-85-931 (D. Minn. Oct. 31, 1985) [Appendix D at D1-D2] (Modified Order).

The Court of Appeals. In a two-to-one decision, the Court of Appeals affirmed the District Court's order. Senior District Judge John W. Oliver, sitting by designation, voted to reverse the District Court's order and filed a comprehensive opinion dissenting from the substance of the majority opinion.

The Court of Appeals majority, rejecting the District Court's view as to what "this case turns on,"³ held that "[t]he key to this case . . . is *not* whether numbers are copyrightable." 799 F.2d at 1227 [Appendix A at A14] (emphasis added). The majority conceded that "two always comes after one, and no one can copyright the mere sequence of Arabic numbers." *Id.* at 1227 [Appendix A at A13].

Having found, however, that the *only* matter in West publications allegedly copied by MDC—page numbers—was *not* protected by copyright, the majority proceeded nonetheless to find that MDC's proposed use of this *uncopyrighted* matter would constitute copyright infringe-

³ "[T]his case turns on whether or not the succeeding page numbers themselves are protected by copyright." 616 F. Supp. at 1579 [Appendix C at C11]. *Accord* 799 F.2d at 1236 [Appendix B at B15] (Oliver, J., dissenting).

ment. It reached this conclusion on two theories: First, the majority found that star pagination would make it possible for LEXIS users, by making hundreds of separate search requests for no comprehensible purpose, to view judicial opinions in the same sequence as those unrelated opinions might appear in a West-published volume. 799 F.2d at 1227 [Appendix A at A14-A15]. Second, the majority found that the very function of star pagination was unlawful: “[j]ump cites to West volumes within a case on LEXIS are infringing because they enable LEXIS users to discern the precise location in West’s arrangement of the portion of the opinion being viewed.” *Id.* [Appendix A at A15].⁴ The majority did not recognize that the “arrangement” of “portions” of judicial opinions is the work of courts, not reporters; nor did it mention the widespread practice of star pagination in reports of opinions by West and others.

With respect to the Second Circuit’s decision in *Banks Law Publishing Co. v. Lawyers’ Co-Operative Publishing*

⁴ The majority’s reference to “West’s arrangement” apparently refers to West’s claim that it “arranges” reports of opinions into volumes (e.g., District Court opinions are published in *Federal Supplement* volumes) and then, within volumes, further “arranges” reports of opinions in various ways. In *Federal Supplement* advance sheet volumes, for example, West claims that it “arranges” opinions in chronological order.

Despite the majority’s extensive discussion of it, West’s alleged “arranging” activity is quite beside the point of this case. West’s complaint does not allege copying by MDC of any purported “arrangements of reports” in West publications, and the District Court’s injunction does not even mention “arrangements.” MDC has been enjoined from using one and only one thing: “page numbers.” *West Publishing Co. v. Mead Data Central, Inc.*, Civ. No. 4-85-931 (D. Minn. Oct. 31, 1985) [Appendix D at D2] (Modified Order). Judicial notice can be taken that the “arrangement” of judicial opinions in LEXIS bears no similarity to that in any West publication—just as the “arrangement” of opinions in *Supreme Court Reporter* volumes is wholly dissimilar from that in *U.S. Reports*, to which West star paginates.

Co., 169 F. 386 (2d Cir. 1909) (per curiam) (upholding star pagination in *Lawyers' Edition*), *appeal dismissed*, 223 U.S. 738 (1911), the Eighth Circuit majority concluded that the *Banks* holding was inconsistent with "modern cases," 799 F.2d at 1226 [Appendix A at A11], and would not be followed. As a result, a direct conflict now exists between the Courts of Appeals.

The Dissenting Opinion. Like the majority, Judge Oliver in dissent found that the page numbers in West publications were not protected by copyright. Unlike the majority, however, Judge Oliver recognized that use of uncopyrighted matter cannot be infringement: "one simply cannot infringe a non-existent copyright." 799 F.2d at 1235 [Appendix B at B12] (Oliver, J., dissenting).

Judge Oliver rejected the majority's theory that West "case arrangements" were infringed by LEXIS star pagination, because (i) the injunctive order in this case does not prohibit use of—or even mention—"arrangements," 799 F.2d at 1238 n.30 [Appendix B at B20] (Oliver, J., dissenting); (ii) the record contains no evidence that "MDC intends in any way to duplicate or reproduce West's 'arrangement of cases,' whatever those arrangements may be," *id.* at 1234 [Appendix B at B12]; and (iii) "law book publishers in the United States have long and traditionally used star pagination in their publication of court opinions," and "MDC intends to do no more than what other law book publishers have been doing for a long, long period of time." *Id.* at 1235 [Appendix B at B13].

ARGUMENT

The decisions below, departing from more than a century of established legal publishing and professional practice, hold for the first time that star pagination among reports of judicial opinions is copyright infringement. These holdings

conflict with a decision of the Court of Appeals for the Second Circuit on the identical question, *Banks Law Publishing Co. v. Lawyers' Co-Operative Publishing Co.*, 169 F. 386 (2d Cir. 1909) (per curiam) (upholding star pagination in *Lawyers' Edition*), *appeal dismissed*, 223 U.S. 738 (1911), and are contrary to applicable decisions of this Court. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S. Ct. 2218 (1985); *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

In extending copyright protection to, and barring use of, public domain material—page numbers—the decisions below violate the “fundamental principle that only that which is original with the copyright proprietor or his assignor can be protected by his copyright.” 1 M. Nimmer, *Nimmer on Copyright* § 3.04 (1985). This principle, without doubt the most elemental in the law of copyright, was reiterated and confirmed by this Court just two terms ago:

[C]opyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original—for example, . . . materials in the public domain. . . .

Harper & Row, Publishers, Inc. v. Nation Enterprises, 105 S. Ct. 2218, 2224 (1985). The contrary holding below calls for prompt review by this Court, particularly given the public importance of judicial opinions and their accessibility to the public.

Court rules and universal custom require citations to West publications in American legal writings. Since the 1890's, West has held itself out as “the official Reporter of the Federal Courts,” 1 Fed. Cas. iii (1894), *quoted in* 799 F.2d 1234 n.13 [Appendix B at B11] (Oliver, J., dissenting), and in a substantial and growing number of states, West is the *de jure* “official” reporter. In barring

LEXIS from identifying where passages of opinions appear in West publications, the decisions below deny the legal profession any practical alternative to West as a source of jump citations to lower federal and many state court opinions, and thereby confer on West the very power to restrict access to judicial opinions that this Court has repeatedly forbidden. *See, e.g., Banks v. Manchester*, 128 U.S. 244, 253 (1888); *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 668 (1834).

The decisions below also have ominous implications for the development of new technologies and innovation. Until now, authors and inventors have been free to design around copyright and patent monopolies, secure in the knowledge that they had "free access to copy whatever the federal patent and copyright laws leave in the public domain." *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234, 237 (1964). The LEXIS Star Pagination Feature is in the best tradition of such innovation, combining public domain materials—judicial opinions and page numbers—with ingenious new systems and software which can distinguish page citations from other numbers within the body of opinions stored on-line, cause jump citations to appear as running heads of data displays, and allow users to move about within opinions on-line.

In barring MDC's proposed use of uncopyrighted page numbers, the decisions below repudiate the traditional privilege of authors and inventors to use the public domain aspects of existing products in the development of new ones. The anomaly of this result is difficult to understate. The American economy has been built, in substantial part, on imitative improvements to pre-existing technologies, such as books. To extend copyright protection to public domain material, such as the page numbers of books, is to block off one of the most basic means of innovation and competition,

and to subvert fundamental interests of "the consuming public." *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 122 (1938), *quoted in Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964). Until this case, attempts to extend copyright protection to uncopyrighted matter had been uniformly condemned as a *per se* violation of the antitrust laws. *See United States v. Loew's, Inc.*, 371 U.S. 38 (1962).

The public domain material to which West lays claim—the page numbers of published judicial opinions—forms part of the system of citation used in and followed by courts throughout the country. The rules of procedure of the federal courts are prescribed by this Court. This Court's supervisory powers extend to the citation system followed by the courts throughout the country, and any claim by an individual reporter of decisions to property rights in an essential element of the citation system calls for this Court's review.

Although the Court of Appeals' judgment is interlocutory, the facts underlying the legal issues presented by this petition are undisputed. Moreover, without review now by this Court, it may be years before the LEXIS Star Pagination Feature can be made available to the legal profession, and the Court of Appeals' fundamental distortion of the law of copyright will stand as an erroneous signal to other courts that public domain material can be monopolized by copyright. The questions decided below and presented here for review are "fundamental to the further conduct of th[is] case." *United States v. General Motors Corp.*, 323 U.S. 373, 377 (1944). *Accord Gillespie v. United States Steel Corp.*, 379 U.S. 148, 153 (1964). Certiorari is thus appropriate at this time, and "the case may be reviewed despite its interlocutory status." R. Stern, E. Gressman & S. Shapiro, *Supreme Court Practice* 225 (6th ed. 1986).

Federal Copyright Law Does Not Reserve to Reporters of Judicial Opinions Any Exclusive Right to Identify Where Passages of Opinions Can Be Found in Published Volumes.

For more than 150 years, the public policy of this nation has forbidden claims of copyright in judicial opinions. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 668 (1834). The prohibition against copyright in judicial opinions is a rule of “free access,” *Building Officials & Code Adm. v. Code Technology, Inc.*, 628 F.2d 730, 734 (1st Cir. 1980), which ensures that the public can find and know the laws that govern them.

If the concept of “access” to judicial opinions means anything, it means that the public is entitled to “knowledge of the location of opinions and parts of opinions” in published sources. 799 F.2d at 1228 [Appendix A at A15-16]. That is what star pagination—citations to page numbers—is designed to provide. “[I]t is inconceivable . . . that the public policy that denies all right of copyright to a court opinion would nevertheless grant copyright to the page numbers of the volume in which such a court opinion is published.” 799 F.2d at 1237 [Appendix B at B19] (Oliver, J., dissenting). Yet that is precisely the effect of what the Court of Appeals majority held in this case.

The majority opinion below distorted the law of copyright in two fundamental ways: First, the majority extended West’s copyright claims to matter—page numbers—which the majority itself acknowledged was unprotected by copyright. Second, the majority enjoined as infringement a service—imparting “knowledge of the location of opinions and parts of opinions” in published volumes, 799 F.2d at 1228 [Appendix A at A15-A16]—which is patently beyond the scope of any exclusive rights reserved to authors by copyright.

A. Copyright Protection Cannot Be Extended to Public Domain Material, Such as Page Numbers.

The preliminary injunction in this case bars use of one and only one thing: "page numbers." *West Publishing Co. v. Mead Data Central, Inc.*, Civ. No. 4-85-931 (D. Minn. Oct. 31, 1985) [Appendix D at D2] (Modified Order). The premise of the District Court's injunction was a legal conclusion—"page numbers themselves are protected by copyright," 616 F. Supp. at 1579 [Appendix C at C11]—which was untenable on its face, and which the Court of Appeals majority understandably rejected. Under the decision of the Court of Appeals, MDC is enjoined from citing to the page numbers in West publications, "*not* because the numbers themselves are copyrighted," 799 F.2d at 1228 [Appendix A at A16] (emphasis added), but because, in the majority's words, "MDC's intended use of West *page numbers* would infringe West's copyright in its *arrangements*." *Id.* at 1229 [Appendix A at A19] (emphasis added).

In thus extending West's copyright claims to bar use of *uncopyrighted* matter—page numbers—the majority committed fundamental error. By statutory definition, copyright protection subsists only in "original works of authorship." 17 U.S.C. § 102(a) (1982) [Appendix E at E2]. Works of authorship can, and frequently do, incorporate public domain or other uncopyrighted material, but the copyright protection of such a work "covers *only* the elements contained therein which are original with the copyright claimant." 1 M. Nimmer, *Nimmer on Copyright* § 3.04 (1985) (emphasis added). Nowhere is this fundamental principle clearer than in the case of compilations, such as West "National Reporter System" publications, the copyright of which "does not imply any exclusive right in the preexisting material," 17 U.S.C. § 103(b) (1982)

[Appendix E at E3], and specifically excludes opinions prepared by federal judges. See 17 U.S.C. § 105 (1982) [Appendix E at E3-E4].

It may be assumed, *arguendo*, that West publications include original elements which are entitled to copyright protection. From that premise, however, it simply does not follow that *uncopyrighted* elements in West publications—such as the opinions,⁵ the volume titles,⁶ or the page numbers⁷—are or can ever be protected by copyright. The late Professor Nimmer stated the rule:

Even if the defendant has copied from the plaintiff's copyrighted work, if the only material thus copied are the elements of plaintiff's work which are not protected, then the resulting copy will not constitute an infringement.⁸

The Eighth Circuit majority cited this Court's decision in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S. Ct. 2218 (1985), for the proposition that "a use

⁵ "West does not and could not claim any copyright in the judicial opinions themselves." 799 F.2d at 1223 n.2 [Appendix A at A4].

⁶ "[T]he title to a volume of law reports, certainly a most important part of the whole volume, simply is not subject to copyright." 799 F.2d at 1234 [Appendix B at B11] (Oliver, J., dissenting).

⁷ "[T]he copyright we recognize here is in West's arrangement, not in its numbering system." 799 F.2d at 1228 [Appendix A at A16] (emphasis added). "[S]uch a claim [to page numbers] has been rejected by every court that has had occasion to decide the question." 799 F.2d at 1248 [Appendix B at B42] (Oliver, J., dissenting).

⁸ 2 M. Nimmer, *Nimmer on Copyright* § 8.01[D] (1985). Accord *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S. Ct. 2218, 2224 (1985); *Walker v. Time Life Films, Inc.*, 784 F.2d 44, 48 (2d Cir.), *cert. denied*, 106 S. Ct. 2278 (1986); *Warner Bros. Inc. v. American Broadcasting Companies, Inc.*, 720 F.2d 231, 239-40 (2d Cir. 1983); *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905, 915 (2d Cir. 1980); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 980 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980).

that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement." *Id.* at 2235. The quoted proposition, however, refers to uses of *copyrighted material*, such as former President Ford's memoirs. As to *uncopyrighted material*, *Harper & Row* held, consistently with long-standing doctrine:

[C]opyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original—for example, . . . materials in the public domain. . . . 105 S. Ct. at 2224.

The majority opinion below conflicts directly with the above quoted principle.

B. Identifying Where Public Domain Material Can Be Found in a Published Volume Is Not an Exclusive Right Reserved to Authors by Copyright.

Besides extending copyright protection to uncopyrighted matter, the majority committed equally fundamental error in its analysis of copyright infringement. Under the Copyright Act, an owner of copyright has five "exclusive rights." 17 U.S.C. § 106 (1982) [Appendix E at E4].⁹ An "infringement" of copyright occurs only when unauthorized use is made of a copyrighted work in "one of the five ways set forth in the statute." *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984). See 17 U.S.C. § 501 (1982) [Appendix E at E5]. Use of a copyrighted work in a manner not exclusively reserved to authors under the Copyright Act is, by definition, a non-infringing use in the public domain. *Sony*, 464 U.S. at 433.

⁹ To paraphrase the statute, the exclusive rights of a copyright owner are (i) to reproduce the copyrighted work in copies; (ii) to prepare derivative works based on the copyrighted work; (iii) to distribute copies of the copyrighted work to the public; (iv) to perform the copyrighted work publicly; and (v) to display the copyrighted work publicly. See 17 U.S.C. § 106 [Appendix E at E4].

In this case, the Court of Appeals did not analyze the LEXIS Star Pagination Feature according to whether it violated any of the exclusive rights reserved to authors under 17 U.S.C. §§ 106 and 501. Instead, the majority held that MDC's proposed use of West page numbers was infringing on two theories having no basis whatever in the relevant statutory language or case law.

The majority's first theory of infringement—that LEXIS subscribers theoretically could, using star page citations as their guide, request separately all the decisions in a West-published volume in the order they appear—was unsupported by any citation of statutory or case law authority, was wholly artificial and contrived, and is contrary to applicable decisions of this Court.

If permitted to be offered, the LEXIS Star Pagination Feature would provide the same demonstrated and unquestionably lawful research assistance that is provided by the star pagination in thousands of West and non-West published reports of opinions spanning more than 100 years. Even assuming, *arguendo*, that users of LEXIS could sit mindlessly at a LEXIS terminal, could separately request hundreds of cases in sequence, and could thus abuse the service to make an unauthorized reproduction of the purported "arrangements" of opinions in West publications—a feat that LEXIS users could accomplish far more readily and inexpensively with a photocopying machine—that is no ground for holding that MDC, the *originator* of a service having other and lawful uses, has committed an infringement. As this Court held just three terms ago:

[T]he sale of copying equipment, like the sale of other articles of commerce, does not constitute contributory infringement if the product is widely used for legitimate, unobjectionable purposes. Indeed, it need merely be capable of substantial noninfringing uses.

Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417, 442 (1984).

The majority's second theory of infringement—that “[j]ump cites to West volumes within a case on LEXIS are infringing because they enable LEXIS users to discern the precise location in West’s arrangement of the portion of the opinion being viewed,” 799 F.2d at 1227 [Appendix A at A15]—is even further removed from applicable law.

The “exclusive rights” of an author, 17 U.S.C. § 106 (1982) [Appendix E at E4], contain nothing remotely like any exclusive right to make “jump cites” to pages in published volumes. It is impossible to infringe exclusive rights to “reference” a work, as the preliminary injunction provides,¹⁰ or to provide “access” to a work, as the District Court suggested,¹¹ or to provide “knowledge of the location of opinions or parts of opinions” in a work, as the Court of Appeals majority suggested,¹² because no such rights are reserved to authors by copyright. *Cf. Kipling v. G.P. Putnam’s Sons*, 120 F. 631, 635 (2d Cir. 1903) (indices do not infringe work being indexed); *New York Times Co. v. Roxbury Data Interface, Inc.*, 434 F. Supp. 217, 226 (D.N.J. 1977) (same); 2 M. Nimmer, *Nimmer on Copyright* § 8.09[B], at 8-110.4 & n.13 (1985) (same). See also *Eggers v. Sun Sales Corp.*, 263 F. 373, 375 (2d Cir. 1920) (“identity of pagination,” in reprint of public domain work, was “not of sufficient importance to constitute infringement of copyright”).

The injunction in this case is not directed to unauthorized copying of original expression. The terms of the injunction bar use by MDC, not of any original writings by West, but of public domain material: page numbers. This injunction was issued, not to prevent MDC from selling “copies” of any original writings by West, but to prevent MDC from

¹⁰ Modified Order of October 31, 1985 [Appendix D at D1-D2].

¹¹ 616 F. Supp. at 1579 [Appendix C at C12].

¹² 799 F.2d at 1228 [Appendix A at A15-A16].

imparting "*knowledge* of the location of opinions and parts of opinions" in West publications. 799 F.2d at 1228 [Appendix A at A15-A16] (emphasis added). Wholly aside from the right and need of the public to have free access to judicial opinions, the idea that copyright protection is an instrument for the suppression of "*knowledge*" is fundamentally misguided, and should be reviewed by this Court.

CONCLUSION

For the reasons set forth above, a writ of certiorari should issue to review the judgment of the Court of Appeals for the Eighth Circuit.

Respectfully submitted,

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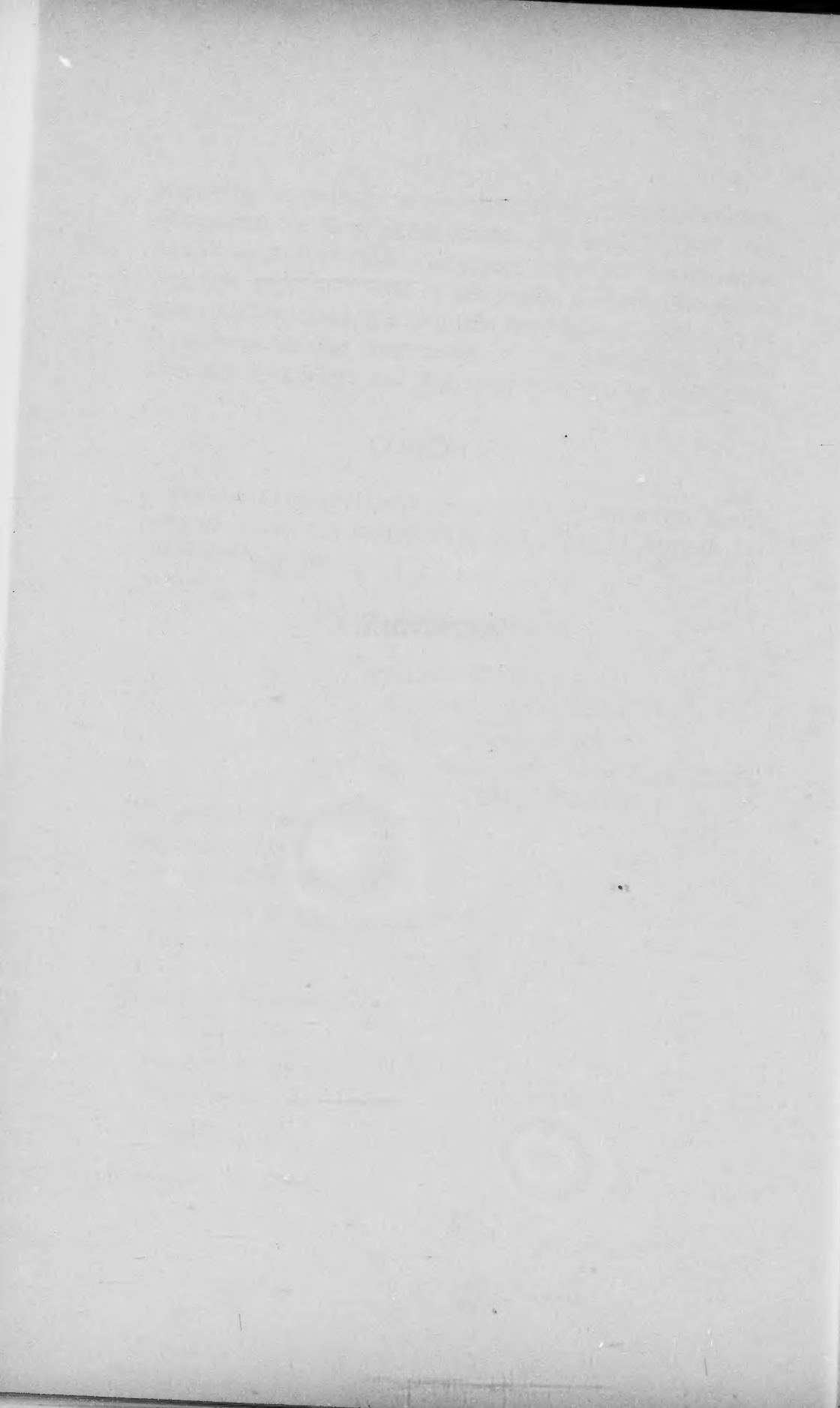
FAEGRE & BENSON

Minneapolis, Minnesota

Of Counsel

December 3, 1986

APPENDIX A



Majority Opinion

UNITED STATES COURT OF APPEALS

EIGHTH CIRCUIT

No. 85-5399.

Submitted Feb. 11, 1986.

Sept. 4, 1986.

WEST PUBLISHING COMPANY,

Appellee,

v.

MEAD DATA CENTRAL, INC.,

Appellant.

Before ARNOLD and FAGG, Circuit Judges, and OLIVER,*
Senior District Judge.

William E. Willis, New York City, for appellant.

Vance K. Opperman, Minneapolis, Minn., for appellee.

ARNOLD, *Circuit Judge.*

Mead Data Central, Inc. (MDC) appeals from a preliminary injunction issued by the District Court for the District of Minnesota¹ in a copyright-infringement action brought by West Publishing Company (West). West's claim is based upon MDC's proposed introduction of "star pagination," keyed to West's case reports, into the LEXIS system of computer-assisted legal research.

* The Hon. John W. Oliver, Senior United States District Judge for the Western District of Missouri, sitting by designation.

¹ The Hon. James M. Rosenbaum, United States District Judge for the District of Minnesota.

Majority Opinion

For more than a century, West has been compiling and reporting opinions of state and federal courts. West publishes these opinions in a series of books known as the "National Reporter System." Before it publishes an opinion, West checks the accuracy of case and statutory citations in the opinion and adds parallel citations, prepares headnotes and a synopsis for the opinion, and arranges the opinion in West's style and format. West then assigns its report of each opinion to one of the individual series in the National Reporter System, such as *Federal Reporter*, *Second Series* or *Bankruptcy Reporter*; this assignment is based on the court and/or the subject matter of the opinion. Next, West assigns the case to a volume in the series, further categorizes and arranges the cases within the volume, and prepares additional materials, such as indices and tables of cases, for each volume. Volumes and pages are numbered sequentially to facilitate precise reference to West reports; citing the proper volume number, series name, and page number communicates the exact location of a West report, or a portion thereof, within the National Reporter System. West represents that upon completion of each volume, it registers a copyright claim with the Register of Copyrights and receives a Certificate of Registration for the volume.

MDC developed, owns, and operates LEXIS, a computer-assisted, on-line legal-research service first marketed in 1973. LEXIS, like West's National Reporter System, reports the decisions of state and federal courts. Since LEXIS's inception, MDC has included on the first computer screen of each LEXIS case report the citation to the first page of West's report of the opinion. West concedes that citation to the first page of its reports is a noninfringing "fair use" under 17 U.S.C. § 107, so these citations are not at issue here.

Majority Opinion

On June 24, 1985, MDC announced that it planned to add "star pagination" to the text of opinions stored in the LEXIS data base. This new service, named the LEXIS Star Pagination Feature, was to be available to LEXIS users by September or October of 1985. This feature would insert page numbers from West's National Reporter System publications into the body of LEXIS reports, providing "jump" or "pin point" citations to the location in West's reporter of the material viewed on LEXIS. Thus, with the LEXIS Star Pagination Feature, LEXIS users would be able to determine the West page number corresponding to the portion of an opinion viewed on LEXIS without ever physically referring to the West publication in which the opinion appears.

In response to MDC's announcement, West brought this action, claiming, *inter alia*, that the LEXIS Star Pagination Feature is an appropriation of West's comprehensive arrangement of case reports in violation of the Copyright Act of 1976, 17 U.S.C. §§ 101-810. West sought, and was granted, a preliminary injunction. *West Publishing Co. v. Mead Data Central, Inc.*, 616 F. Supp. 1571 (D. Minn. 1985). The District Court held that there is a substantial likelihood that West's arrangements of case reports are protected by copyright law, that MDC's copying of West's pagination constitutes copyright infringement, and that MDC's star pagination is not a fair use of West's copyrighted works. 616 F. Supp. at 1575-1581. The Court further held that the balance of the harms to West and to MDC involved in granting or denying a preliminary injunction weighed in favor of granting an injunction, and that the public interest also favored preliminary injunctive relief. 616 F. Supp. 1581-1583. We affirm.

Majority Opinion

ANALYSIS

Whether a preliminary injunction should issue turns upon four factors: (1) the probability that the movant will succeed on the merits; (2) the threat of irreparable harm to the movant should a preliminary injunction be denied; (3) the balance between this harm and the harm that granting the injunction will cause to the other parties litigant; and (4) the public interest. *Dataphase Systems, Inc. v. C L Systems, Inc.*, 640 F.2d 109, 113 (8th Cir. 1981) (en banc). None of these factors by itself is determinative; rather, in each case the four factors must be balanced to determine whether they tilt toward or away from granting a preliminary injunction. *Id.* On appeal, we may not disturb the District Court's balancing of the equities absent a clearly erroneous factual determination, an error of law, or an abuse of discretion. *O'Connor v. Peru State College*, 728 F.2d 1001, 1002 (8th Cir. 1984); *Edudata Corp. v. Scientific Computers, Inc.*, 746 F.2d 429, 430 (8th Cir. 1984) (per curiam).

I.

MDC's principal contention here is that there is no likelihood that West will succeed on the merits of its copyright claim. MDC readily concedes that portions of West's National Reporter System publications that are not at issue here, such as headnotes prepared by West, merit copyright protection.² Yet, MDC maintains that any aspects of West's reporters affected by the LEXIS Star Pagination Feature are not copyrightable. The dominant chord of MDC's

² West does not and could not claim any copyright in the judicial opinions themselves. See *Wheaton v. Peters*, 8 Pet. 591, 668, 33 U.S. 591, 8 L.Ed. 1055 (1834) ("no reporter . . . can have any copyright in the written opinions delivered by this court").

Majority Opinion

argument is that West claims copyright in mere page numbers. MDC adds that in any event, whether West claims copyright in its case arrangement or simply in its pagination, West's claim must fail because neither case arrangement nor pagination can ever qualify as the original work of an author. Even were this possible, MDC goes on, West's case arrangement and pagination do not in fact meet this standard. Finally, MDC contends that even were West's arrangement of cases protected by copyright, the proposed use of West's page numbers in LEXIS reports would not constitute infringement.

We do not agree with MDC that West's claim here is simply one for copyright in its page numbers. Instead, we concur in the District Court's conclusion that West's arrangement is a copyrightable aspect of its compilation of cases, that the pagination of West's volumes reflects and expresses West's arrangement, and that MDC's intended use of West's page numbers infringes West's copyright in the arrangement.

A. Copyright Protection

The Copyright Act provides copyright protection for "original works of authorship fixed in any tangible medium of expression." 17 U.S.C. § 102(a). The standard for "originality" is minimal. It is not necessary that the work be novel or unique, but only that the work have its origin with the author—that it be independently created. *Hutchinson Telephone Co. v. Fronteer Directory Co.*, 770 F.2d 128, 131 (8th Cir. 1985). Little more is involved in this requirement than "a prohibition of actual copying." *Alfred Bell & Co. v. Catalda Fine Arts*, 191 F.2d 99, 102-103 (2d Cir. 1951); see also M. Nimmer, 1 *Nimmer on Copyright* § 2.01 (1985).

Majority Opinion

To be the original work of an author, a work must be the product of some "creative intellectual or aesthetic labor." *Goldstein v. California*, 412 U.S. 546, 561, 93 S. Ct. 2303, 2312, 37 L. Ed. 2d 163 (1973). However, "a very slight degree of such labor[,] . . . almost any ingenuity in selection, combination or expression, no matter how crude, humble or obvious, will be sufficient" to make the work copyrightable. M. Nimmer, 1 *Nimmer on Copyright*, *supra*, § 1.08[C][1]; *id.*, § 1.06. See *Rockford Map Publishers v. Directory Service Company*, 768 F.2d 145, 148-149 (7th Cir. 1985) (map based on Agriculture Department photographs and legal descriptions is copyrightable, no matter how quickly or with what little effort it is produced), *cert. denied*, — U.S. —, 106 S. Ct. 806, 88 L. Ed. 2d 781 (1986); *Universal Athletic Sales Co. v. Salkeld*, 511 F.2d 904, 908 (3d Cir.) ("even a modicum of creativity may suffice for a work to be protected"), *cert. denied*, 423 U.S. 863, 96 S. Ct. 122, 46 L. Ed. 2d 92 (1975).

MDC argues that case arrangement is *per se* uncopyrightable because it cannot meet these standards. However, it is apparent on the face of the Copyright Act that it is possible for an arrangement of pre-existing materials to be an independently produced work of intellectual creation. Section 103 of the Act, 17 U.S.C. § 103, establishes that "the subject matter of copyright . . . includes compilations and derivative works." A "compilation" is defined in the Act as:

a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

Majority Opinion

17 U.S.C. § 101. An arrangement of opinions in a case reporter, no less than a compilation and arrangement of Shakespeare's sonnets, can qualify for copyright protection.

We find support for this view in *Callaghan v. Myers*, 128 U.S. 617, 9 S. Ct. 177, 32 L. Ed. 547 (1888), which indicates that an original arrangement of opinions is copyrightable whenever it is the product of labor, talent, or judgment. The plaintiff in that case, Myers, held copyrights for several volumes of reports of the Supreme Court of Illinois. He had purchased these rights from the official reporter of that Court, who had prepared the volumes. In addition to the Court's opinions, the volumes contained a substantial amount of material original to the reporter, including headnotes, statements of facts, tables of cases, indices, and so on. Myers brought an infringement action against the publishers of a competing reporter of Illinois Supreme Court opinions who had copied from Myers's reports material created by the official reporter, as well as the arrangement and pagination of some volumes. The trial court found Myers's copyrights valid and infringed. The Supreme Court affirmed, holding that the fact that Myers sought to protect material prepared by the official court reporter did not bar his claim, since no Illinois legislation forbade the reporter to obtain a copyright for matter that was the product of his intellectual labor. 128 U.S. at 646-647, 95 S. Ct. at 184.

As MDC points out, the treatment of case arrangement and pagination in *Callaghan* was not crucial to the Court's decision, since the defendants had also made use of other portions of Myers's volumes, such as headnotes and statements of facts. Nonetheless, we find *Callaghan's* discussion of the copyrightability of case arrangements instructive. The Supreme Court noted that while the reporter could

Majority Opinion

claim no copyright in the opinions themselves, 128 U.S. at 649, 9 S. Ct. at 185, *citing Wheaton v. Peters*, 8 Pet. 591, 668, 33 U.S. 591, 668, 8 L. Ed. 1055 (1834), he could copyright other portions of his reports. Mr. Justice Blatchford wrote that, in addition to headnotes, statements of facts, arguments of counsel, case tables, and indices,

[s]uch work of the reporter, which may be the lawful subject of copyright, comprehends . . . the order of arrangement of the cases, the division of the reports into volumes, the numbering *and paging* of the volumes, the table of the cases cited in the opinions (where such table is made), and the subdivision of the index into appropriate, condensed titles, involving the distribution of the subjects of the various head-notes, and cross-references, where such exist.

Callaghan, 128 U.S. at 649, 9 S. Ct. at 185 (emphasis ours).

Later in its opinion, however, when considering several volumes that Myers claimed the defendants had infringed by copying their case arrangement and pagination, the Court quoted with approval the opinion of the Circuit Court, which stated:

Undoubtedly, in some cases, where are involved labor, talent, judgment, the classification and disposition of subjects in a book entitle it to a copyright. But the arrangement of law cases and the paging of the book may depend simply on the will of the printer, of the reporter, or publisher, or the order in which the cases have been decided, or upon other accidental circumstances.

128 U.S. at 662, 9 S. Ct. at 190, *quoting Myers v. Callaghan*, 20 Fed. 441, 442 (C.C. N.D. Ill. 1883). Evaluat-

Majority Opinion

ing the volumes at issue, the Circuit Court concluded that their case arrangement and pagination involved little labor, it therefore found the defendants' copying of the case arrangement and pagination of Myers's volumes not an independent infringement, but a matter to be considered in connection with other similarities in the parties' reporters. *Id.* The teaching of *Callaghan* with respect to the issues before us does not come through with unmistakable clarity. But as we read it, *Callaghan* establishes at least that there is no *per se* rule excluding case arrangement from copyright protection, and that instead, in each case the arrangement must be evaluated in light of the originality and intellectual-creation standards.

For the proposition that case arrangement and pagination cannot, as a matter of law, meet originality and intellectual-creation requirements, MDC relies heavily upon *Banks Law Publishing Co. v. Lawyer's Co-Operative Publishing Co.*, 169 Fed. 386 (2d Cir. 1909) (per curiam), *appeal dismissed by stipulation*, 223 U.S. 738, 32 S. Ct. 530, 56 L. Ed. 636 (1911). The plaintiff in *Banks* was the successor to the copyrights of an official reporter of the United States Supreme Court in published volumes of opinions compiled by the reporter. The defendant published a competing edition of the Supreme Court's decisions. The plaintiff claimed copyright infringement based on the defendant's reproduction of the plaintiff's arrangement of cases and on the defendant's star pagination to the plaintiff's reports. The trial court rejected the plaintiff's claim that its case arrangement and pagination merited copyright protection; the Second Circuit, in a per curiam opinion, reproduced the trial court's opinion in full, adopting the opinion as its own.

In our view, *Banks* does not support MDC's claim that case arrangement is uncopyrightable *per se*; we agree with the District Court that instead, the denial of copyright pro-

Majority Opinion

tection in *Banks* was based upon the official status of the reporter. See 616 F. Supp. at 1577. The plaintiff in *Banks* argued that its case arrangements were the product of sufficient intellectual labor to be copyrightable because the reporter's general, though not unalterable, approach in arranging cases was to begin each volume with what he considered to be the most important cases on hand and to group cases on the same subject matter together. The *Banks* court responded by noting that the official reporter was required by statute to prepare reports of Supreme Court decisions, gather them into volumes, and have them printed and published. To fulfill this duty, the court continued, the reporter must of necessity provide an orderly arrangement of cases and pagination for the volumes. The court concluded that "no valid copyright for these elements or details alone can be secured to the official reporter." 169 Fed. at 390. Although it acknowledged that "[t]he trend of some of the decisions and of the textwriters indicates that an arrangement of the material matter of a book may be the subject of a valid copyright," the court rejoined that,

[A]ny principle upon which such cases are based is not thought applicable where the arrangement of the cases, though involving some merit, so obviously was necessary to produce the volumes required by the statute. Such labor, under the circumstances presented, like the decisions and opinions of the court, became the property of the public.

Id. We conclude that the ultimate rationale for the *Banks* decision was that while under *Callaghan* the official reporter could copyright any material that was the product of his intellectual labor, because the reporter's statutory duties required case arrangement and pagination, these should not be considered the product of the reporter's intellectual labor.

Majority Opinion

MDC contends that *Banks* did not turn on the reporter's official status. It points out that the statute prescribing the reporter's duties in *Banks* did not specify how cases were to be arranged or how volumes of reports were to be paginated, so that the reporter exercised judgment and discretion in these matters. MDC concludes that *Banks* must therefore be read to hold broadly that arrangement and pagination are publishing details involving too little intellectual labor to be copyrightable. We agree with MDC that the reporter in *Banks* exercised independent judgment. However, the *Banks* court dismissed the matters in which the reporter exercised discretion as things done "voluntarily and in evident compliance with the proper and faithful discharge of his official duties." 169 Fed. at 389-390. While we would be inclined to examine the official reporter's independent efforts in arrangement and pagination on their merits to see if they meet originality and intellectual-creation requirements, the *Banks* court did not do so because it was unwilling to look past the fact that they were done to meet the reporter's statutory obligations.

Several other reasons persuade us not to give *Banks* the full force for which MDC contends. If it involved the copyright claims of an official reporter, so too did *Callaghan*, and yet *Callaghan* does not seem so hostile to the very idea that case compilation, arrangement, and paging can be protected by copyright. To the extent that *Banks* diverges from *Callaghan*, we of course follow the Supreme Court. *Banks*, moreover, requires a greater degree of intellectual creativity than the trend of modern cases, see, e.g., *Rockford Map*, *supra*. And it was written at a time when the statute did not in express words declare that "compilations and derivative works," defined to include "the collection and assembling of preexisting materials," can be copyrighted. See

Majority Opinion

Act of March 3, 1905, ch. 1432, Pub. L. No. 58-165, 33 Stat. 1000 (1905) (repealed 1909).

MDC argues, citing, *e.g.*, Order of June 7, 1978, Minnesota Supreme Court (unreported), that West is the "official reporter" for some states, and that, therefore, even a narrow reading of *Banks* supports its position. We are inclined to think that the term "official reporter" in orders discontinuing, for example, the *Minnesota Reports*, and providing that the *Northwestern Reporter* should henceforth be the "official reporter" for the opinions of the Supreme Court of Minnesota, means something quite different from the title "official reporter" held by Messrs. Wheaton and Peters. We do not believe that West is employed by any State, with a salary and duties fixed by statute, and with the details of its work controlled by statute or rule. But even if it is, the facts of this case, as found on the present record by the District Court, convince us that West has used sufficient talent and industry in compiling and arranging cases to entitle it to copyright protection under the 1976 Act as construed by the more recent cases.

Having determined that there is no *per se* rule that case arrangements are not copyrightable, we turn to examine the District Court's findings that West's arrangements in fact meet originality and intellectual-creation requirements.

West publishes opinions not from just one court, but from every state and all the federal courts in the United States. As it collects these opinions, West separates the decisions of state courts from federal-court decisions. West further divides the federal opinions and the state opinions and then assigns them to the appropriate West reporter series. State court decisions are divided by geographic region and assigned to West's corresponding regional reporter. Federal decisions are first divided by the level of the court they come

Majority Opinion

from into district court decisions, court of appeals decisions, and Supreme Court decisions; Court of Claims and military court decisions are also separated out. Before being assigned to a reporter, district court decisions are subdivided according to subject matter into bankruptcy decisions, federal rules decisions, and decisions on other topics. After an opinion is assigned to a reporter, it is assigned to a volume of the reporter and then arranged within the volume. Federal court of appeals decisions, for example, are arranged according to circuit within each volume of *West's Federal Reporter, Second Series*, though there may be more than one group of each circuit's opinions in each volume.

We conclude, as did the District Court, that the arrangement West produces through this process is the result of considerable labor, talent, and judgment. As discussed above, *supra* pp. 1223-1224, to meet intellectual-creation requirements a work need only be the product of a modicum of intellectual labor; West's case arrangements easily meet this standard. Further, since there is no allegation that West copies its case arrangements from some other source, the requirement of originality poses no obstacle to copyrighting the arrangements. In the end, MDC's position must stand or fall on its insistence that all West seeks to protect is numbers on pages. If this is a correct characterization, MDC wins: two always comes after one, and no one can copyright the mere sequence of Arabic numbers. As MDC points out, the specific goal of this suit is to protect some of West's page numbers, those occurring within the body of individual court opinions. But protection for the numbers is not sought for their own sake. It is sought, rather, because access to these particular numbers—the "jump cites"—would give users of LEXIS a large part of what West has spent so much labor and industry in compil-

Majority Opinion

ing, and would *pro tanto* reduce anyone's need to buy West's books. The key to this case, then, is not whether numbers are copyrightable, but whether the copyright on the books as a whole is infringed by the unauthorized appropriation of these particular numbers. On the record before us (and subject to reconsideration if materially new evidence comes in at the plenary trial on the merits), the District Court's findings of fact relevant to this issue are supportable. We therefore hold (again subject to reexamination after the record has closed) that West's case arrangements, an important part of which is internal page citations, are original works of authorship entitled to copyright protection.

B. Infringement

We further hold (with a similar qualification) that MDC's proposed use of West page numbers will infringe West's copyright in the arrangement. The LEXIS Star Pagination Feature, when used in conjunction with another LEXIS feature called "LEXSEE," will permit LEXIS users to view the arrangement of cases in every volume of West's National Reporter System. LEXSEE enables the LEXIS user to have his or her terminal display a case by "inputting" the citation to the first page of West's report of the case. With the LEXIS Star Pagination Feature, a LEXIS user could summon up the first case in a West Volume, page through it until he or she reaches the end of the case, and discern from the "jump cite" for the final page of the case the citation for the first page of the next case in the volume. The LEXIS user could then use LEXSEE to call up the next case. By repeating this procedure, the LEXIS user would be able to page through each succeeding case in the West reporter. MDC conceded at oral argument that this operation would be possible, but argued that LEXIS users

Majority Opinion

would be unlikely to perform it because of the cost involved in doing repeated LEXSEE searches. However, MDC has cited no authority, nor do we see any persuasive argument, for the proposition that because consumers may find an infringing work uneconomical, the work is not an infringement. An author's rights in a copyrighted work protect the author not only against infringing works less expensive than the original, but against more expensive infringements as well. Further, though this use of LEXIS may presently be uneconomical, changes in technology and other market conditions could well alter the situation.

Even if the LEXIS Star Pagination Feature did not make it possible to use LEXIS to page through cases as they are arranged in West volumes, we would still hold that MDC's use of West's page numbers infringes West's copyright in the arrangement. Jump cites to West volumes within a case on LEXIS are infringing because they enable LEXIS users to discern the precise location in West's arrangement of the portion of the opinion being viewed. MDC contends that these page numbers communicate nothing about West's arrangement. This might be true if MDC proposed to use the numbers in some way unconnected to their position in West's reporters, for example by simply printing a list of the numbers. However, MDC understandably has no interest in making such a use of the numbers; instead, it plans to replicate on LEXIS every page break in West's volumes and to note the corresponding West page number. Communication to LEXIS users of the location in West's arrangement of specific portions of text is precisely what the LEXIS Star Pagination Feature is designed to do.

With MDC's star pagination, consumers would no longer need to purchase West's reporters to get every aspect of West's arrangement. Since knowledge of the location of

Majority Opinion

opinions and parts of opinions within West's arrangement is a large part of the reason one would purchase West's volumes, the LEXIS Star Pagination Feature would adversely affect West's market position. "[A] use that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement." S. Rep. No. 473, 94th Cong., 1st Sess. 65 (1975), *quoted in Harper & Row Publishers v. Nation Enterprises*, — U.S. —, 105 S. Ct. 2218, 2235, 85 L. Ed. 2d 588 (1985).

MDC asserts that enjoining its use of West page numbers is tantamount to giving West a copyright in the Arabic numbering system. West cannot, MDC argues, claim that its use of the numbering system is an original work of authorship. It is true that some uses of a numbering system cannot meet originality requirements for copyright. See *Toro Co. v. R & R Products Co.*, 787 F. 2d 1208 (8th Cir. 1986) (arbitrary assignment of random numbers to replacement parts did not qualify for copyright protection). However, as already noted, the copyright we recognize here is in West's arrangement, not in its numbering system; MDC's use of West's page numbers is problematic because it infringes West's copyrighted arrangement, not because the numbers themselves are copyrighted.

MDC also argues that the LEXIS Star Pagination Feature does not infringe West's copyright because its citations to page numbers in West reporters are merely statements of pure fact. The flaw in this argument is that it does not distinguish between isolated use of the factual aspects of a compilation or arrangement and wholesale appropriation of the arrangement. "Isolated instances of minor infringements, when multiplied many times, become in the aggregate a major inroad on copyright that must be prevented." S. Rep. No. 473, 94th Cong., 1st Sess. 65 (1975), *quoted*

Majority Opinion

in *Harper & Row*, 105 S. Ct. at 2235. The names, addresses, and phone numbers in a telephone directory are "facts"; though isolated use of these facts is not copyright infringement, copying each and every listing is an infringement. See *Hutchinson Telephone v. Fronteer Directory*, 770 F. 2d 128 (8th Cir. 1985). Similarly, MDC's wholesale appropriation of West's arrangement and pagination for a competitive, commercial purpose is an infringement.³

We hold that West's arrangement of cases in its National Reporter System publications is entitled to copyright protection and that the LEXIS Star Pagination Feature infringes West's copyright in the arrangement. On the basis of the present record, it is probable that West will succeed on the merits at trial.

II.

MDC also contends that the District Court did not accurately assess and weigh the three remaining *Dataphase* factors: the threat of irreparable harm to West, the relative harm to MDC, and the public interest. We disagree.

In copyright infringement cases, the general rule is that a showing of a *prima facie* case raises a presumption of irreparable harm. *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1254 (3d Cir. 1983), *cert.*

³ In the District Court MDC also argued that its star pagination, like its citation to the first page of West's report of a case, is "fair use" of copyrighted material under 17 U.S.C. § 107. The District Court rejected this contention, noting that MDC's use is commercial, that MDC is appropriating the whole of West's arrangement, and that MDC's use will supersede a substantial use of West's volumes. 616 F. Supp. at 1580-1581. See *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 451, 104 S.Ct. 774, 793, 78 L.Ed. 2d 574 (1984); *Harper & Row*, 105 S. Ct. at 2226, 2235. MDC did not raise this issue in its briefs or its arguments on appeal, and we find the reasoning of the District Court persuasive.

Majority Opinion

dismissed, 464 U.S. 1033, 104 S. Ct. 690, 79 L. Ed. 2d 158 (1984). West has made a strong claim for copyright infringement and is therefore entitled to this presumption. Furthermore, MDC's intended use of West's page numbers may significantly affect demand for West's volumes; this further supports West's claim of irreparable injury. See *Wainwright Securities, Inc. v. Wall Street Transcript Corp.*, 558 F.2d 91, 94 (2d Cir. 1977), *cert. denied*, 434 U.S. 1014, 98 S. Ct. 730, 54 L. Ed. 2d 759 (1978). On the other hand, the harm which MDC claims it will suffer is principally loss of the market share and revenues it would garner from use of West's page numbers. Yet, West has demonstrated that it will probably succeed on its claim that MDC's use of West's page numbers is a copyright infringement.

Finally, the public interest favors issuing a preliminary injunction. While MDC argues that there is a public interest in free access to the law embodied in West's reporters, we note that West's works are not the only reports of judicial opinions available—MDC itself reports the decisions on LEXIS. More importantly, MDC's argument ignores the purpose of affording authors a monopoly in their copyrightable material; "[i]f every volume that was in the public interest could be pirated away by a competing publisher, . . . the public [soon] would have nothing worth reading.'" *Harper & Row*, 105 S. Ct. at 2230, *quoting* Sobel, *Copyright and the First Amendment: A Gathering Storm?*, 19 ASCAP Copyright Law Symposium 43, 78 (1971).

We conclude that the District Court correctly assessed the various *Dataphase* factors and that it did not abuse its discretion in determining that the balance of equities in this case favors issuing a preliminary injunction.

Majority Opinion

CONCLUSION

West has shown that it will probably succeed on the merits of its claim at trial; West's case arrangements are entitled to copyright protection and MDC's intended use of West page numbers would infringe West's copyright in its arrangements. The District Court correctly balanced this factor with the threat of irreparable harm to West, the relative harm to MDC, and the public interest to determine that West should be granted a preliminary injunction. Accordingly, the decision of the District Court will be affirmed.

We add a word about the procedural posture of this case. It comes to us on appeal from an order granting a preliminary injunction. The case has yet to be tried. We trust it will be tried soon. (Indeed, so far as any requirements of law are concerned, it could have been tried already: the pendency of an interlocutory appeal from an order granting or denying a preliminary injunction does not wholly divest the District Court of jurisdiction over the entire case.) When it is tried, and when judgment is entered, another appeal can be filed. At that time it will be our duty to examine anew, on the basis of the full record, the issues discussed in this opinion. As we have observed before, *e.g.*, *Independent Fed'n of Flight Attendants v. Trans World Airlines*, 655 F.2d 155, 159 (8th Cir. 1981), "[t]he District Court's findings, and our observations as to the governing law made in this opinion, are tentative and provisional, in the sense that different findings or conclusions might be warranted after a trial on the merits."

For this reason, the attention of the district courts in this Circuit is called to Fed. R. Civ. P. 65(a)(2), under which, in appropriate cases, those courts have discretion to combine the hearing on a motion for preliminary injunction

Majority Opinion

with the trial on the merits. This procedure is a good one, and we wish to encourage it. In the present case, for example, we got the definite impression at oral argument that most of the evidence on both sides had already been put in. If this is true, the case could have been tried with little additional effort, and the result could have been one appeal instead of two, with a final resolution of the case instead of a provisional one.

Affirmed.

APPENDIX B

Dissenting Opinion

**UNITED STATES COURT OF APPEALS
EIGHTH CIRCUIT**

No. 85-5399.

Submitted Feb. 11, 1986.

Sept. 4, 1986.

WEST PUBLISHING COMPANY,

Appellee,

v.

MEAD DATA CENTRAL, INC.,

Appellant.

OLIVER, Senior District Judge, concurring in part and dissenting in part.

This case pends on an interlocutory appeal noticed pursuant to Section 1292(a)(1) of Title 28, U.S.C., from a modified order of the district court which "preliminary enjoined [MDC] from displaying, referencing or including the page number of any and all publications within plaintiff's National Reporter System * * * published during the period from January 2, 1910 to the present within or in relation to the text of court opinions contained in the LEXIS data base." Addendum at 25a-26a.¹

¹ The "publications within plaintiff's National Reporter System" were listed as follows: *Supreme Court Reporter, Federal Reporter and Federal Reporter Second Series, Federal Supplement, United States Claims Court Reporter, Federal Rules Decisions, Bankruptcy Reporter, Atlantic Reporter and Atlantic Reporter Second Series, California Reporter, North Eastern Reporter and North Eastern Reporter Second Series, North Western Reporter and North Western Reporter Second Series, New York Supplement and New York Sup-*

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Dissenting Opinion

I concur in what the majority stated in regard to the procedural posture of the case and its discussion of Fed. R. Civ. P. 65(a)(2). At 1229. It is my view, however, that the majority's analysis of this case exceeds the limited scope of appellate review provided by a Section 1292(a)(1) appeal.

I therefore dissent because I do not believe, in light of the meager record before the district court, that the majority's analysis is consistent with the applicable law. It is my view that our panel should follow the lead of the First Circuit as stated in *Building Officials & Code Adm. v. Code Tech. Inc.*, 628 F.2d 730 (1st Cir. 1980), in which a not dissimilar question was presented on a Section 1292(a)(1) appeal.

That case, as does this case, involved the application of principles first enunciated in *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), and later applied in *Banks v. Manchester*, 128 U.S. 244, 9 S. Ct. 36, 32 L. Ed. 425 (1888), and *Callaghan v. Myers*, 128 U.S. 617, 9 S. Ct. 177, 32 L. Ed. 547 (1888). The First Circuit reversed the district court's grant of a preliminary injunction and remanded the case for a trial on the merits without making any definitive ruling on the merits of legal issues presented on the Section 1292(a)(1) appeal that pended in that court.²

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plement Second Series, Pacific Reporter and Pacific Reporter Second Series, Southern Reporter and Southern Reporter Second Series, South Eastern Reporter and South Eastern Reporter Second Series, and South Western Reporter and South Western Reporter Second Series. Addendum at 26a.

² The First Circuit concluded that: "We do not agree with the district court's conclusion that BOCA's probability of success on the merits justifies preliminary relief. We stop short, however, of ruling definitely on the underlying legal issues, since we feel that our final judgment should await the more complete hearing on the merits which may be anticipated in due course." 628 F.2d at 732.

Dissenting Opinion

I.

A.

MDC, for reasons I find difficult to understand, invoked the appellate jurisdiction of this Court pursuant to 28 U.S.C. § 1292(a)(1). MDC argued in the district court that the granting of a preliminary injunction restraining MDC from adding the "star pagination" feature "would give West the time it would need to do the considerable work necessary to add its own pagination feature to Westlaw." (App. 103).³

MDC obviously invited further delay that would permit West to play catch-up when it elected to notice a Section 1292(a)(1) appeal in this case. Certainly MDC was not required to notice such an appeal. *See Scarrella v. Midwest Federal Savings & Loan*, 536 F.2d 1207, 1209 (8th Cir. 1976, ("[a] party is not required to take an interlocutory appeal authorized by statute").⁴ MDC's citation and reli-

³ MDC also complains on appeal that the preliminary injunction granted by the district court gave West "a second chance to play catch-up and develop a feature similar to the LEXIS Star Pagination Feature for West's WESTLAW service." (MDC Brief at 22; *see also* pp. 20-1, 45).

⁴ *See also A & R Realty Co. v. Northwestern Mutual Life Insurance Co.*, 95 F.2d 703, 707 (8th Cir. 1938); ("If the right to appeal from the interlocutory order was not availed of, the failure to appeal would not diminish the right to a review of such order upon appeal from the final decree"); *Caradelis v. Refineria Panama, S.A.*, 384 F.2d 589, 591, n. 1 (5th Cir. 1967); and 9 Moore's Federal Practice ¶ 110.18 (1985), entitled "A Party Is Not Required to Take an Interlocutory Appeal Authorized by Statute," and the cases cited therein.

Di Giorgio v. Causey, 488 F.2d 527, 528 (5th Cir.) (1973), appropriately stated that "an appeal from the issuance or denial of a preliminary injunction is ordinarily no way to obtain appellate disposition of a case on its merits." That case emphasized that the "one fact which litigants and their counsel should not overlook is that on an appeal from a preliminary injunction this Court does not concern itself with the merits of the controversy."

Dissenting Opinion

ance on *O'Connor v. Peru State College*, 728 F.2d 1001, 1002 (8th Cir. 1984), see page 24 of MDC brief, establishes that it knew that the scope of appellate review on a Section 1292(a)(1) appeal from an "interlocutory order" is necessarily more narrow than the scope of appellate review of a "final decision" on an appeal taken pursuant to 28 U.S.C. § 1291.

O'Connor and Edudata Corp v. Scientific Computers, Inc., 746 F.2d 429, 430 (8th Cir. 1984) (per curiam), both cited in the majority opinion (Slip op. at 4), are but two recent Eighth Circuit cases that recognize the established Eighth Circuit rule in regard to the limited scope of appellate review on a Section 1292(a)(1) appeal.⁵

⁵ The Eighth Circuit rule goes back at least as far as Judge Walter Sanborn's opinion in *City of Council Bluffs v. Omaha & C.B. & St. Ry. Co.*, 9 F.2d 246, 249 (8th Cir. 1925). *Benson Hotel Corporation v. Woods*, 168 F.2d 694, 697 (8th Cir. 1948), in reliance on *City of Council Bluffs* and other Eighth Circuit cases, made clear that "[t]he decision of the trial court on granting the motion for preliminary injunction will not estop either of the parties on the trial of the case on its merits, nor would any determination of those questions by this court on appeal be binding on the trial court nor upon either of the parties in considering and determining the merits of the controversy." *City of Des Moines v. Continental Illinois Nat. B. & T. Co.*, 205 F.2d 729 (8th Cir. 1953), written by Judge John B. Sanborn, stated that "[a]n appellate court, in reviewing an order granting or denying a preliminary injunction, will not consider the merits of the controversy between the parties further than is necessary to determine whether the trial court abused its discretion in making the order and this is particularly true where the rights of the parties can better be determined upon full proof of the facts." 205 F.2d at 733. And see *Mesabi Iron Company v. Reserve Mining Company*, 270 F.2d 567, 570 (8th Cir. 1959), which stated that in "the instant case the merits of the crucial issues not having been determined by the trial court, we should not pass upon them" for the reason that "under the well-established rule, to do so would be futile, and we express no opinion on the merits of the issues involved in this case."

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Dissenting Opinion

The majority opinion recognized that the scope of appellate review on a Section 1292(a)(1) appeal is limited and circumscribed. For on page 1229 of the opinion it quoted that portion of *Independent Fed'n of Flight Attendants v. Trans World Airlines*, 655 F.2d 155, 159 (8th Cir. 1981), which concluded that "[t]he District Court's findings, and our observations as to the governing law made in this opinion, are tentative and provisional, in the sense that different findings or conclusions might be warranted after a trial on the merits."⁶

The reason the scope of appellate review on a Section 1292(a)(1) appeal is circumscribed is because the grant of a preliminary injunction by a district court is reviewed solely under an abuse of discretion standard. *Olin Water Services v. Midland Research Lab.*, 774 F.2d 303, 307 (8th Cir. 1985), the most recent Eighth Circuit case on that point, concluded that:

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The rule established in the earlier Eighth Circuit cases has not been altered. Indeed, *Edudata Corp.* was recently quoted and followed in *St. Jude Medical, Inc. v. Carbomedics, Inc.*, 764 F.2d 500 (8th Cir. 1985) (per curiam). See also *Sierra Club v. U.S. Corps of Engineers*, 771 F.2d 409 (8th Cir. 1985), which relied on *St. Jude Medical, Inc.* and other recent Eighth Circuit cases to support its conclusion that "[o]ur review of a grant or denial of preliminary relief is limited to determining whether the district court abused its discretion." 771 F.2d at 412. That case also stated that "[w]e are mindful that findings of fact and conclusions of law made by a court in granting or denying a preliminary injunction are not binding at the trial on the merits. *Universty of Texas v. Camenisch*, 451 U.S. 390, 395, 101 S. Ct. 1830, 1834, 68 L. Ed. 2d 175 (1981)." *Id.* at 413.

⁶ *Trans World Airlines* stated immediately before the portion of that opinion quoted by the majority that "[w]e emphasize the procedural posture of this case—an appeal from a ruling on a motion for preliminary injunction. In this situation our reviewing function is circumscribed." (Emphasis added).

Dissenting Opinion

Our *sole* task in reviewing an order of the district court granting a preliminary injunction is to determine whether the court abused its discretion. *Ferry-Morse Seed Co. v. Food Corn, Inc.*, 729 F.2d 589, 592 (8th Cir. 1984); *Dataphase Systems, Inc. v. C L Systems, Inc.*, 640 F.2d 109, 114 & n. 8 (8th Cir. 1981) (en banc); *accord University of Texas v. Camenisch*, 451 U.S. 390, 393, 101 S. Ct. 1830, 1832-33, 68 L. Ed. 2d 175 (1981). (Emphasis added).

Any possible doubt about the limited scope of review on a Section 1292(a)(1) appeal, in my view, was resolved by *University of Texas v. Camenisch*, *supra*, 451 U.S. 390, 101 S. Ct. 1830, 68 L. Ed. 2d 175 (1981). That case held that "the issue before the Court of Appeals [on an appeal from an order granting a preliminary injunction] was * * * whether the District Court had abused its discretion in issuing a preliminary injunction." ⁷ *Id.* 451 U.S. at 393, 101 S. Ct. at 1832.

While I concur in the majority's recognition of the established Eighth Circuit rule, I am not able to join the majority opinion because that opinion exceeds the limited scope of appellate review accorded by a Section 1292(a)(1) appeal.⁸ The majority opinion, as I read it, states much more than a tentative view of the merits of this case.

⁷ *Alabama v. United States*, 279 U.S. 229, 49 S.Ct. 26, 73 L.Ed. 675 (1929), cited with approval in *University of Texas*, concluded that the duty of the appellate court upon an appeal from an order either granting or denying an interlocutory injunction "at least generally, is not to decide the merits but simply to determine whether the discretion of the court below has been abused." 279 U.S. at 230-31, 49 S.Ct. at 266.

⁸ I recognize, of course, that MDC, like the Section 1292(a)(1) appellant in *Di Giorgio*, tended to brief and argue this appeal "as if

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Dissenting Opinion

B.

I concur with what the majority stated in its final paragraph in regard to the utilization of Fed. R. Civ. P. 65 (a)(2). I quite agree that if the hearing on West's application for a preliminary injunction had been consolidated with an advanced trial on the merits, that the entire case could have been tried with little additional effort, with the result of having one rather than two appeals. This case, in my view, is precisely the type of case in which Rule 65(a)(2) should have been used. For it is reasonably certain that once this case is tried on the merits, the losing party will notice a second appeal of right under Section 1291.⁹

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it were from a final judgment on the merits." 488 F.2d at 528. Although MDC cited *Dataphase Systems, Inc. v. C L Systems, Inc.*, 640 F.2d 109 (8th Cir. 1981) (en banc), it is clear that the major portion of MDC's argument was made under a bold face heading which argued that "The District Court Erred in Concluding That the LEXIS Star Pagination Feature Infringes Copyrights Claimed by West." That MDC did so does not, in my judgment, expand the circumscribed scope of appellate review applicable to a Section 1292(a)(1) appeal.

⁹ The Fifth Circuit in *Di Giorgio* appropriately noted that it was encountering Section 1292(a)(1) appeals with "more and more frequency." It then pointed out that "[w]e note that while such appeals are pending the general tendency is to allow the case on the merits to lie dormant. Then, after the lapse of considerable time, it is found that two appeals are required for the disposition of the case. This causes frustration attributed to judicial delays, when the fault lies not with the judiciary, beleaguered though it is by an unprecedented torrent of cases." 488 F.2d at 529.

The "torrent of cases" the Fifth Circuit noted in 1973 continues unabated in 1986. The Director of the Administrative Office has recently noted that "between 1969 and 1985 * * * appeals filings are up 226 per cent." 18 *The Third Branch*, No. 8, p. 6 (August

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Dissenting Opinion

II.

A.

Neither the district court nor the majority discussed any part of the record before the district court to support their respective conclusions that West, on the merits, will probably succeed in proving as matters of fact, that (1) West's arrangement of the cases in all of its publications since January 8, 1910 to the present may be subject to copyright; (2) that West's pagination of all those publications is an important part of such an arrangement and that, as such, is also subject to copyright; and (3) that MDC's intended use of star pagination may be said to constitute an infringement of West's copyright of all its post-January 2, 1910 publications.

Although West relied on *Hutchinson Telephone Co. v. Fronteer Directory Co.*, 770 F.2d 128 (8th Cir. 1985) (Tr. 11), in the district court, that court did not make any findings of fact or indicate in any way that it believed that the publication of a law report could be said to be comparable to the publication of a telephone directory.

The majority cited and relied on *Hutchinson*, both in regard to its discussion of "copyright protection," at 1223, and in discussion of "infringement," at 1227 and 1228. The majority, however, like the district court, did not make any reference to the record to support its ultimate concurrence with "the District Court's conclusion that West's

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1986). I do not believe that parties should be encouraged to notice Section 1292(a)(1) appeals. For the determination of such an appeal, absent exceptional circumstances, can serve no useful purpose for either the parties, the district court, or for a later panel of the Court of Appeals that will, in many, if not most cases, be required to rule a second appeal noticed under Section 1291.

Dissenting Opinion

arrangement is a copyrightable aspect of its compilation of cases, that the pagination of West's volumes reflects and expresses West's arrangement, and that MDC's intended use of West's page numbers infringes West's copyright in the arrangement." At 1223.

I find nothing in the record to support the requisite findings of fact upon which both the district court's and the majority's conclusions of law are based. This is not a case, in my judgment, that permits an application of the clearly erroneous standard of Fed. R. Civ. P. 52(a) because the district court did not make any findings of fact in regard to the relevant factual circumstances of this case. Further, as a member of the panel that decided *Hutchinson*, I am satisfied that case should be distinguished from this case on much the same grounds it was recently distinguished in *Toro Co. v. R & R Products Co.*, 787 F.2d 1208, 1213 (8th Cir. 1986).

West's arrangement of cases, however that arrangement may be made, is contained in each volume of its various publications. West has no general copyright on its "National Reporter System"; each separate volume published by West carries its own individual copyright. Most, but not all, of the exceedingly few Certificates of Copyright Registration in the record establish that West has recognized that it may not obtain a copyright on the major part of what it published in a particular volume of any one of those law reports.¹⁰

¹⁰ The record in this case does not contain any copies of a Certificate of Registration for any volume in which a State court opinion is published. Thus it is impossible to know what claims of copyright West may have made in regard to its reports of State court opinions. The record includes copies of only twelve of West's Certificates of Copyright Registrations for volumes in which lower federal court decisions are published. See Exhibits 1-12 (A59-A80).

Dissenting Opinion

The record shows, for example, that although West claimed authorship of the "entire work" encompassed in Volume 753 F.2d, West's Certificate of Registration Form TX 1-607-203 (Exh. 3, A63) did not make any claim of copyright for the page numbers that the majority opinion concluded was "an important part" of the whole of such a Volume.¹¹ One of the questions on the copyright registration form required West to "[g]ive a brief, general statement of the material that has been added to this work and in which copyright is claimed" (A64). West's answer stated "[c]ompilation of previously published case reports including but not limited to opinions, synopses, syllabi or case law paragraphs, key number classifications, tables and index digest, with revisions and additions."¹² (A64).

West stated on Form TX 1-607-203 that the "Title of the Work" was "Federal Reporter. Second Series. Volume 753 F.2d." The title to a law report is obviously a very important part of the whole of such a volume, however the published court opinions may be arranged.¹³ Yet, it is be-

¹¹ West's Certificate of Copyright Registration expressly stated that "[c]opyright is not claimed as to any part of the original work prepared by a United States Government officer or employee as part of that person's official duties." (A64).

¹² West's limited claim of copyright for other of its federal court reports is made in similar language in Exhibits 4 to 12, inclusive. Exhibits 1 and 2 are claims for the renewal of copyrights first registered on January 14, 1925 and November 5, 1924, respectively. The record does not show what claims of copyright were made in regard to the original registration of those volumes.

¹³ In 1880, West Publishing Company reprinted all previously reported lower federal court decisions between 1789 and 1879 in one set of 31 volumes called *Federal Cases*. "Unlike most sets of court reports where the cases are arranged chronologically, the decisions in this set are arranged alphabetically by name of case and are num-

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Dissenting Opinion

yond dispute, I believe, that the title to a volume of law reports, certainly a most important part of the whole volume, simply is not subject to copyright. See 1 *Nimmer on Copyright* "Titles," § 2.16, p. 2-186 and the cases cited therein, including *Duff v. The Kansas City Star*, 299 F.2d 320 (8th Cir. 1962).

The fact that the sequential numbering of the pages of any volume, including a volume of law reports, in an important part of the volume, does not support a finding of fact that such a part of the whole of a particular volume of West's publications is subject to copyright. Nor, in my judgment, does such a fact support a finding of fact that West's arrangement of cases is subject to copyright. All parts of a copyrighted volume may not be automatically considered a subject to copyright simply because a publisher claims a copyright on the whole volume.

B.

Nor does the record, as I read it, support any finding of fact upon which the majority could base its conclusion that "the LEXIS Star Pagination feature infringes West's copyright in the arrangement."¹⁴ At 1228. I hold that view

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bered consecutively." Jacobstein and Mersky, *Fundamentals of Legal Research* (The Foundation Press, 1981), at 36. When West commenced publication of its *Federal Reporter* series in 1880, the cases were "arranged" in a more traditional manner. The record shows West claimed in its Preface to its *Federal Reporter* series that "within a few years" after 1880, West "came to be recognized as the official Reporter of the Federal Courts." (Add. 46a).

¹⁴ I have the same view in regard to the district court's conclusion, unsupported as it is by any reference to the record, that "the use of the second and succeeding numbers following the initial citation to West's arrangement, the so-called 'jump cite' (i.e. 479 F.2d 701, 702), infringes on West's copyright." 616 F. Supp. at 1579.

Dissenting Opinion

even if it is assumed that the majority's assumption that West's pagination, as an "important part" of a West publication, is entitled to copyright may be valid. For I do not believe that anything in the sketchy record in this case can support a factual finding that MDC's intended star pagination of West's published court opinions would in any way infringe West's "arrangement of cases."

The record, as I read it, merely establishes that MDC only intends to add star pagination to the court opinions contained in its LEXIS data base. MDC, as I understand the record, does not intend to make, nor has it in fact made any use of West's "synopses, syllabi or case law paragraphs, key number classifications, tables and index digest, with revisions and additions" for which West claimed in its Certificates of Copyright Registration. The record, as I read it, cannot be said to support a finding of fact that MDC intends in any way to duplicate or reproduce West's "arrangement of cases," whatever those arrangements may be.

Thus, on the district court's record, the ultimate question presented on this Section 1292(a)(1) appeal is reduced to whether, under the applicable law, MDC's intended use of West's page numbers, standing alone, may be said to infringe some copyright to which West may be entitled under factual circumstances yet to be established on a trial of the merits of this case. It cannot be said that it is probable that West will succeed on the merits unless it can also be said that West will be able to establish that its page numbers are entitled to copyright; one simply cannot infringe a non-existent copyright.¹⁵

¹⁵ The majority more or less agrees that this is true. For it stated that if MDC's position is that "all West seeks to protect is numbers on pages * * * is a correct characterization, MDC wins: two always comes after one, and no one can copyright the mere sequence of Arabic numbers." At 1226.

Dissenting Opinion

The probability of whether West will succeed on the merits must, in my judgment, be viewed in light of the fact that law book publishers in the United States have long and traditionally used star pagination in their publication of court opinions which have been taken verbatim from earlier published and copyrighted works of both official and unofficial court reporters.¹⁶ I do not believe that the record in this case can be said to support a *Dataphase* conclusion that West will probably succeed on the merits when that record can be said only to support a finding of fact that MDC intends to do no more than what other law book publishers have been doing for a long, long period of time.

C.

Both the district court and the majority referred to the works of Shakespeare to support the granting of the preliminary injunction in this case.¹⁷ Whether a new "compilation" of Shakespeare's work may, in fact, be subject to copyright as an original work of authorship does not answer the question of whether West's "page numbers and its arrangement are necessarily within the scope of copyright protection," as the district court concluded. 616 F. Supp. at 1577. Neither the district court nor the majority cite any cases which suggest that the page numbers of a new com-

¹⁶ Indeed, it is apparent that West has long used and presently uses star pagination in the court opinions published in its *Supreme Court Reporter*, its *New York Supplement*, and its *California Reporter*.

¹⁷ The district court stated that unless "West's page numbers and its arrangement of cases" are considered "necessarily within the scope of copyright protection," that "one could not collect Shakespeare's plays—themselves not subject to copyright—into a copyrighted work." *Id.* at 1577. The majority stated that an "arrangement of opinions in a case reporter, no less than a compilation of Shakespeare's sonnets, can qualify for a copyright protection." At 1224.

Dissenting Opinion

pilation of any work of Shakespeare must be considered a subject of copyright. Nor is any authority cited to support the notion that the citation of the page numbers in a copyrighted compilation of Shakespeare's work would somehow infringe an earlier publication of Shakespeare's plays and sonnets. Current literary practice suggests that such page citations may not be said to constitute an infringement.¹⁸

A judicial opinion cannot, under *Wheaton v. Peters* be considered a subject of copyright. Nor, in my view, may a compilation of judicial opinions be considered a subject of copyright unless such a work is "formed by the collection and assembling of preexisting materials or of data that are * * * *arranged* in such a way that the resulting work *as a whole constitutes an original work of authorship.*" 17 U.S.C. § 101. (Emphasis added).¹⁹

While there may be some interesting copyright questions presented in regard to a compilation of Shakespeare's work,²⁰ I do not believe that the references made to his

¹⁸ My copy of John Bartlett's *Familiar Quotations* (Eleventh ed. Little, Brown and Company 1939), for example, shows that the quotations from Shakespeare's plays and sonnets in that work contain "jump cites" to the Act, the Scenes, and the Lines of the text of the plays and sonnets as earlier published in W.J. Craig's *The Complete Works of Shakespeare*, copyrighted by Oxford University Press. I seriously doubt that the addition of a page number citation by Bartlett to the other citations to Craig's earlier work would constitute an infringement of Oxford University Press' copyright.

¹⁹ Section 103 makes clear that "copyright in a *compilation or derivative work extends only to the material contributed by the author of such work*, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material." (Emphasis added).

²⁰ 1 *Nimmer on Copyright*, § 201[A], pp. 2-9, put and answered the following question in regard to an original work of Shakespeare:

Suppose a scholar were to painstakingly explore the stacks of the British Museum for a number of years, and finally after

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Dissenting Opinion

work can be said to support the view of either the majority or that of the district court.

III.

A.

The district court recognized that "this case turns on whether or not the succeeding numbers themselves are protected by copyright,"²¹ 616 F. Supp. at 1579. It stated, however, that the "Court *finds* two cases of particular interest and importance in providing an analytic framework in which to consider the claims of the parties," citing *Callaghan v. Myers*, 128 U.S. 617, 9 S. Ct. 177, 32 L. Ed. 547 (1888), and *Banks Law Pub. Co. v. Lawyers Co-Operative Pub. Co.*, 169 F. 386 (2nd Cir. 1909). *Id.* at 1575-76. (Emphasis added). The district court also stated that "this Court *finds* that *Callaghan* supports and *Banks* does not bar copyright protection for West's laboriously

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much effort find that which he was seeking, *i.e.*, a forgotten Shakespeare manuscript. The scholar may well have exercised much skill, training, knowledge and judgment, but should this entitle him to a copyright in the manuscript? Clearly not, since he did not engage in any act of authorship.

See also Judge Learned Hand's comment in regard to Keats' work in *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936), *aff'd*, 309 U.S. 390, 392, 60 S. Ct. 681, 84 L. Ed. 825 (1940), where he stated that "* * * if by some magic a man who had never known it were to compose anew Keats's Ode On a Grecian Urn, he would be an 'author,' and, if he copyrighted it, others might not copy that poem, though they might of course copy Keats's."

²¹ The district court also purported to recognize that "[i]t is beyond cavil that one cannot copyright the Arabic numbering system." *Id.* at 1579.

Dissenting Opinion

prepared, voluntary arrangement of cases.”²² *Id.* at 1578. (Emphasis added). The district court further recognized, however, that even under its reading of *Callaghan*, that the Court held in that case that “[i]f the arrangement of cases and the paging of the book depend simply on the will of the printer, or the order in which the cases have been decided, or upon other accidental circumstances, they of course are not subject to copyright protection because they then involve no labor, talent, or judgment.” *Id.* at 1576.

To support the issuance of its broad preliminary injunction the district court stated that West’s pagination “is not just a series of numbers each arising by one over its predecessor.” Without any reference to the record, the district court further stated that such pagination “is the basis of the West arrangement—the key to the self-index by which West’s arrangement is accessed.”²³ *Id.* at 1579.

The district court then stated that “[t]his is, the Court finds, what is meant by the words ‘taken as a whole’ in the copyright definition of ‘compilations,’” citing 17 U.S.C. § 101. *Id.* (Emphasis added).²⁴ The district court con-

²² The district court, of course, was stating a conclusion of law rather than making a finding of fact in stating its view in regard to what “*Callaghan* supports” and what “*Banks* does not bar.” The same thing is true of its statement that it “finds” that *Callaghan* and *Banks* are of “particular interest and importance in providing an analytic framework” for its decision of this case.

²³ The district court did not explain what a “self-index” might be or how an arrangement of cases may be “accessed.”

²⁴ That “finding,” like the others above noted, is actually a statement of a conclusion of law. That conclusion of law, in my judgment, is not tenable for the reason the words “taken as a whole” do not appear in Section 101’s definition of a “compilation.” That definition expressly provides that a “compilation” is a work “arranged in such a way that the resulting work as a whole constitutes an original work of authorship.” *Id.* (Emphasis added).

Dissenting Opinion

cluded as a matter of law, without any reference to the record, that "West's page numbers *and* its arrangement of cases are *necessarily* within the scope of copyright protection." *Id.* at 1577. (Emphasis added).

I do not agree that *Callaghan* and *Banks* provide "an analytic framework in which to consider the claims of the parties." *Id.* at 1576. Nor do I agree that "West's page numbers *and* its arrangement of cases are *necessarily* within the scope of copyright protection." *Id.* at 1577. (Emphasis added).

B.

The record in this case does not indicate in any way how or by whom West's page numbers are, in fact, created. West's affidavits do not identify any person as the "author" of any of the page numbers. The only thing the record in this case shows, as I read it, is that West's bound volumes carry the same volume numbers and the same page numbers as West's advance sheets.²⁵ How those page numbers are

²⁵ The Berring affidavit (A31-39), for example, simply states that West "arranges American judicial decisions within its National Reporter System publications" (A34 ¶ 13). There is no statement made in regard to how those cases are "arranged" or, more particularly, how the page numbers are placed in any of West's volumes.

The only mention of West's pagination is in paragraph 16 of the affidavit which states that there is, in fact, "identical numbering and paging of the volumes in both the advance sheets and the permanent, hardbound editions." (A38).

The Ginnow affidavit (A40-48) is likewise silent in regard to how, when or by whom the page numbers are, in fact, placed on West's volumes. Ginnow's affidavit, like that of Berring, simply reiterated that "decisions published in [West's] hard-bound, permanent volumes retain the same volume number and pagination used in the advance sheet volumes" and that "each volume in every Reporter series retains identical pagination between advance sheet volume and permanent volume to promote reliable and consistent citation." (A48, ¶ 24 and 25).

Dissenting Opinion

assigned West's advance sheets is a total mystery so far as the record is concerned.

Judicial notice may be taken of the fact that the original page numbers that appear on a slip opinion submitted by a judge for publication never appear in any West advance sheet.²⁶ There is indeed substantial doubt whether those page numbers could be considered part of the judge's work of authorship. For the pagination of a judge's slip opinion is, at best, the work of a judge's secretary or, in this day of advanced technology, the work of the secretary's word processor in electronic response to the secretary's punch of a button on a machine.²⁷

Thus, the factual question in regard to how or by what process, electronic or otherwise, West assigns a completely new set of page numbers to a judge's slip opinion is an open factual question that can only be determined on a trial of the merits. It is my view that West's probability of success on the merits simply cannot be measured on a record that does not provide any information in regard to whether West's new advance sheet pagination, like a judge's secretary's original pagination of his slip opinion, is nothing more than an electronic response to a direction given a machine or whether, as a matter of fact, West's new pagination may be considered an original work of authorship.

If, on the trial of the merits, it is established that West's new page numbers are assigned a judge's slip opinion by

²⁶ The page numbers on this slip opinion, for example, will, like Clementine, be lost and gone forever once the opinions in this case are published in a West advance sheet.

²⁷ This is also true where the judge drafts his opinion in long hand and "authors" the page numbers on his legal pad. For his secretary does not copy the judge's page numbers when the judge's long hand draft is transcribed; the secretary or the word processor, rather than the judge, is the "author" of the page numbers on the slip opinion in its typewritten form.

Dissenting Opinion

some automatic electronic process, it is inconceivable to me that the public policy that denies all right of copyright to a court opinion would nevertheless grant copyright to the page numbers of the volume in which such a court opinion is published. Therefore, I do not believe that the district court's discussion of *Callaghan* and *Banks* within the structure of its "analytic framework" can be said to support its *Dataphase* conclusion that West will probably succeed on the trial of the merits of this case.

C.

It is my view that the majority's analysis is based on what I believe is an incomplete and untenable view of *Callaghan* and *Banks*. Although the majority, in its discussion of *Banks* stated that "we would be inclined to examine the official reporter's independent efforts in arrangement and pagination on their merits to see if they meet originality and intellectual-creation requirements," at 1226, and although it stated that "*Callaghan* establishes at least that * * * in each case the arrangement must be evaluated in light of the originality and intellectual-creation standards," at 1225, the majority nevertheless definitely concluded that "West's case arrangements, an important part of which is internal page citations, are original works of authorship entitled to copyright protection."²⁸ At 13.

²⁸ The majority stated that the "key to this case * * * is *not* whether numbers are copyrightable, but whether the copyright on the books *as a whole* is infringed by the unauthorized appropriation of these particular numbers." (Emphasis added). At 1227. The majority also stated that "we concur in the District Court's conclusion that West's arrangement is a copyrightable aspect of its compilation of cases, that the pagination of West's volumes reflects and expresses West's arrangement, and that MDC's intended use of West's page numbers infringes West's copyright in the arrangement." At 1223. It further stated that "we agree with the District Court that * * * the denial of copyright protection in *Banks* was based upon the official status of the reporter." At 1225.

Dissenting Opinion

The majority, I believe correctly, concluded that "the treatment of case arrangement and pagination in *Callaghan* was not crucial to the Court's decision."²⁹ At 1224. The majority nevertheless concluded, I believe erroneously, that we must "follow the Supreme Court" for the reason that "*Callaghan* does not seem so hostile to the very idea that case compilation, arrangement, and paging can be protected by copyright." *Id.* at 1226. (Emphasis added).

The majority recognized that *Toro Co. v. R & R Products Co.*, *supra*, 787 F.2d 1208, had most recently held that "some uses of a numbering system cannot meet originality requirements for copyright."³⁰ At 1228. It, however, purported to distinguish *Toro Co.* by stating that "the copyright we recognize here is in West's arrangement, not in its numbering system; MDC's use of West's page numbers is problematic because it infringes West's copyrighted arrangement, not because the numbers themselves are copyrighted." *Id.* at 1228. The majority therefore concluded that the principles of copyright law stated in *Hutchinson* rather than those stated in *Toro Co.* were applicable to this case. I disagree.

In *Hutchinson*, this Court recognized that the principle that "telephone directories and similar publications" were subject to copyright was established by a "long line of cases." *Hutchinson*, of course, was based on and merely extended that "long line of cases." *Leon v. Pacific Tele-*

²⁹ The majority's suggestion that the "teaching of *Callaghan* with respect to the issues before us does not come through with unmistakable clarity," at 1225, was not made in regard to its recognition that "the treatment of case arrangement and pagination was not crucial to the Court's decision" in *Callaghan*.

³⁰ The majority further stated that "no one can copyright the mere sequence of Arabic numbers." At 1227. The preliminary injunction issued by the district court, of course, granted precisely that protection; that interlocutory order did not so much as mention West's arrangement of cases.

Dissenting Opinion

phone Co., 91 F.2d 484, 486 (9th Cir. 1937), the first case cited and relied upon in *Hutchinson*, quoted Justice Holmes' statement made in 1903 in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250, 23 S. Ct. 298, 300, 47 L. Ed. 460 (1903), that "directories and the like, * * * may be copyrighted." *Sampson & Murdock Co. v. Seaver-Radford Co.*, 140 Fed. 539, 542 (1st Cir. 1905), also cited in *Leon*, traces the origin of the directories' rule back to at least 1839.³¹

Professor Nimmer puts the directory cases in an entirely different category from the cases involving the publication of law reports.³² The fact that the slight amount of intel-

³¹ That case held that "[d]irectories and works of like character have been specifically protected, at least since *Lewis v. Fullarton*, 2 Beav. 6, decided in 1839, and that they are to be protected is now firmly established." *Jeweler's Circular Pub. Co. v. Keystone Pub. Co.*, 281 Fed. 83 (2d Cir.), cert. denied, 259 U.S. 581, 42 S. Ct. 464, 66 L. Ed. 1074 (1922), was also cited in *Leon*. That case was decided by the same panel that decided *Banks*. Judge Henry Wade Rogers concluded that "[i]t was at one time intimated in certain judicial opinions that directories were not entitled to copyright. But the law is now well established to the contrary in England. [Citing many English cases]. It is equally well-established law in this country. [Citing many federal cases]. And in *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250, 23 S. Ct. 298, 47 L. Ed. 460, Mr. Justice Holmes, writing for the court, speaks of directories as being capable of copyright." *Id.* at 85.

Judge Rogers treated *Callaghan* in substantially the same manner *Callaghan* would be treated two years later in *Eggers v. Sun Sales Corporation*, 263 Fed. 373 (2d Cir. 1920). The *Jeweler's Circular* court quoted Justice Blatchford's observation that, on the facts of *Callaghan*, "one of the most significant evidences of infringement exists frequently in the defendant's volumes, namely the copying of errors made by Mr. Freeman." *Id.* at 95.

³² 1 *Nimmer on Copyright*, § 2.04[B], pp. 2-40—2-42, discusses "catalogs and directories" and states that "[a]lthough some may question whether catalogs, directories and the like should be regarded as works of authorship subject to copyright protection, such protection has long been recognized, so that the present Copyright Act breaks no new ground in this respect." Professor Nimmer does the same thing in regard to "maps." *Id.* § 2.08[A], p.2-75 to 2-82.

Dissenting Opinion

lectual labor necessary to produce a plat map may be considered sufficient to establish copyright, as illustrated by *Rockford Map Pub. v. Dir. Service Co. of Colorado*, 768 F.2d 145 (7th Cir. 1985) (cited by the majority, at 1223 and 1226), does not, in my judgment, support the majority's conclusion that *Banks* "requires a greater degree of intellectual creativity than the trend of the modern cases." *Id.* at 1225-1226.

I find nothing in the record in this case to support a finding of fact that it takes more intellectual creativity to put page numbers on a volume of law reports today than it did in the yesterdays in which *Callaghan* and *Banks* were decided in 1888 and 1909, respectively. Indeed, the trial on the merits of this case may establish that West's pagination is no more than the work of a machine responding to a punch of a button, rather than the exercise of the will of a printer, who yesterday, was at least required to set type for the pagination of a volume of law reports.

IV.

I do not agree with the majority's statement that "the denial of copyright protection [in *Banks*] was based upon the official status of the reporter," at 1225; its statement that *Banks* "diverges from *Callaghan*"; or its conclusion that *Callaghan*, as a Supreme Court decision, must therefore be followed rather than *Banks*. *Id.* at 1226.

Professor Nimmer makes clear that the judicial opinions of both state and federal courts are in the public domain and are therefore not subject to copyright. 1 *Nimmer on Copyright*, § 5.06[C] at 5-58—5-59 (1985). Professor Nimmer cited *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 8 L. Ed. 1055 (1834), to support his conclusion in regard to federal court opinions. *Banks v. Manchester*, 128 U.S.

Dissenting Opinion

244, 9 S. Ct. 36, 32 L. Ed. 425 (1888), and *Building Officials & Code Administrators International, Inc. v. Code Technology, Inc.*, 628 F.2d 730 (1st Cir. 1980), were cited in regard to state court opinions; the latter was cited "for a discussion of the older cases." *Id.* at 5-58, n. 30. *Callaghan*, together with a "see" citation to the Second Circuit's opinion in *Banks*, and a "cf." citation to *Wheaton v. Peters*, was cited to support Professor Nimmer's statement that: "With respect to the public domain status of judicial opinions, somewhat anomalously the older decisions held that an official reporter paid by the state may personally claim copyright in the headnotes and synopses of court opinions, written as a part of his official duties, in the absence of an agreement to the contrary." *Id.* at 5-60, n. 32.

Banks v. Manchester, which the Court decided in tandem with *Callaghan*, was not cited or discussed by the majority. Both cases must, in my view, be given appropriate consideration, for both applied the principles of law established in *Wheaton v. Peters*. The majority opinion has not, in my view, given appropriate consideration to or recognition of the rationale of the three Supreme Court cases that control the determination of this case.

Part III of Professor Craig Joyce's article *The Rise of the Supreme Court Reporter: An Institutional Perspective on Marshall Court Ascendancy*, 83 Mich. L. Rev. 1291, 1351 to 1391 (1985) (hereafter cited as Joyce), is devoted to *Wheaton v. Peters*.³³ While I agree with Professor Joyce's suggestion that "[f]ew cases tell stories so fascinating as

³³ A shorter version of Professor Joyce's research was also published under the title of *Wheaton v. Peters: The Untold Story of the Early Reporters* in Yearbook 1985 of the Supreme Court Historical Society, pp. 34-92. Part III of the Yearbook article is substantially the same as Part III of the Michigan Law Review Article.

Dissenting Opinion

Wheaton v. Peters," *id.* at 1391, it is sufficient for present purposes to state that Peters, shortly after he succeeded Wheaton as the Court's official reporter, decided to publish a work entitled the *Condensed Reports of Cases in the Supreme Court of the United States, Containing the Whole Series of the Decisions of the Court From Its Organization to the Commencement of Peters' Reports at January Term 1827*. Peters' motive was basically a commercial one.

A glance at any one of Wheaton's *Reports* shows that the scholarly Wheaton, aided and encouraged by Justice Story, included elaborate head notes, a full summary of the arguments of counsel, together with a large number of appendices in the twelve volumes of Supreme Court reports he published between 1816 and 1827. The inclusion of that material in those volumes substantially increased the cost of Wheaton's *Reports*.³⁴ Peters compressed the twenty-four volumes of opinions published by all three earlier reporters into only six volumes of his *Condensed Reports*, which he published between 1830 and 1834. He was able to reduce the price for all the Court's opinions from \$130 to \$36 for his reports by using smaller type, omitting the arguments of counsel and appendix notes, and by substantial elimination of some concurring and dissenting opinions. *Id.* at 1365.

Both Justice Story and Justice Washington "enthusiastically supported Peters' undertaking." *Id.* at 1366. Wheaton's adverse reaction was predictable.³⁵ Wheaton employed

³⁴ To obtain copies of all the Court's opinions since 1790, one would be required to purchase three volumes of Dallas' *Reports*, nine volumes of Cranch's *Reports*, and the twelve volumes of Wheaton's *Reports*, at a total cost of \$130.

³⁵ Joyce states that: "Wheaton, * * * first learned of Peters' plans from [his publisher] who informed him also that the proposal had

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Dissenting Opinion

Elijah Paine and Daniel Webster to represent him. In May, 1831 Wheaton filed a bill in equity in the Circuit Court for the Eastern District of Pennsylvania "praying for an injunction to prevent the further printing, publication or sale of volume 3 of the *Condensed Reports* and an accounting of profits." *Id.* at 1370. That bill alleged that volume 3 of *Peters' Condensed Reports* "contained 'without any material abbreviation or alteration, all the reports of cases' in volume 1 of Wheaton's *Reports*." *Id.* at 1370.³⁶ A preliminary injunction was initially issued by Justice Baldwin, sitting as a Circuit Justice with Judge Hopkinson, but was dissolved two years later by Judge Hopkinson who acted alone during one of Justice Baldwin's not infrequent "derangement of the mind." *Id.* at 1371. The case then went on direct appeal to the Supreme Court.

Joyce accurately stated that "Wheaton's central point [on appeal]—that the decisions of the Court as rendered by the Reporter had always been regarded as subject to copyright by him—was not without substantial foundation."³⁷

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put almost an entire stop to the sales of both the *Reports* and the *Digest of Decisions*." *Id.* at 1376. Wheaton's publisher urged Wheaton to bring an action for infringement pointing out that "until an example is made of these literary Pirates there can be no security for the labours of authors and Publishers." *Id.* at 1376.

³⁶ Although I do not believe it legally significant, except to the extent it may relate to the majority's preoccupation with whether a reporter may or may not be an "official" reporter, it is to be noted that Wheaton was *not* an official reporter of the Court when he published Volume 1 of his reports. Volume 1 of Wheaton's *Reports* was published in 1816 before the Reporter's Act became effective on March 3, 1817.

³⁷ Joyce explained that "Wheaton's expectations regarding the copyrightability of his *Reports* had an entirely reasonable basis." *Id.* at 1374. In a preargument memorandum Wheaton wrote Daniel

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Dissenting Opinion

Id. at 1373. Wheaton's counsel recognized, however, that "unless Wheaton had somehow obtained copyrights in the manuscript opinions of the Justices in every significant decision handed down during his tenure as Reporter, the *Condensed Reports* had infringed no interest of any real value in the marketplace." *Id.* at 1377. Wheaton's counsel therefore argued that "Wheaton had acquired a copyrightable interest in all such opinions * * * 'by judges' gift.'" ³⁸ *Id.* at 1377.

Thomas Sergeant argued on behalf of Peters that, as a matter of public policy, the opinions of the Court must be considered to be in the public domain and not subject to copyright. *Id.* at 1378. After listening to four days of oral argument, the Court convened on March 19, 1834 to announce their opinions.³⁹ Joyce accurately stated that "Mc-

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Webster, he recognized that it could be held that the opinions of the Court may not be subject to copyright. Wheaton recognized that if the Court should so hold, he would be "reduced to arguing that the *Reports*, because they included parts individually susceptible to copyright, constituted compilations entitled to protection in their entirety." *Id.* at 1374.

The majority opinion, as I read it, is based on its acceptance of Wheaton's argument, which was rejected by the Supreme Court.

³⁸ Paine argued in part that "[w]ere not the opinions of the judges their own to give away? Are opinions matter of record, as is pretended? * * * [T]here is no law or custom to put opinions upon record, * * * Nor were they ever put on record in this case. * * * The copy[ri]ght in the opinions, as they were new, original and unpublished, must have belonged to some one. If to the judges, they gave it to Mr. Wheaton. That it did belong to them is evident; because they are bound by no law or custom to write out such elaborate opinions. * * * What right, then, can the public claim to the manuscript? The reporter's duty is to write or take down the opinions. If the court choose to aid him by giving them theirs, can anyone complain?" That argument is reported in 33 U.S. (8 Pet.) at 614.

³⁹ On March 18, 1834, after oral arguments were closed on March 14, 1834, Justice Story took the extraordinary action of conducting

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Dissenting Opinion

Lean's [majority] opinion left open the possibility that a tiny, unspecified portion of the matter claimed by Wheaton as author—* * * 'the statements of the cases . . . and the abstracts thereof'—might indeed have been infringed by Peters." ⁴⁰ *Id.* at 1384. He added, however, that for "all practical purposes," * * * the controversy had come to an end when McLean stated that:

It may be proper to remark that the court are unanimously of opinion, that no reporter has or can have any copyright in the written opinions delivered by this court; and that the judges thereof cannot confer on any reporter any such right.

Id. at 1385.

Although both Justices Thompson and Baldwin dissented in regard to other issues decided in *Wheaton v. Peters*, Joyce appropriately noted that "on the decision's central

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a conference with both Wheaton and Peters the day before the Court handed down its decision to try to get them to settle their controversy. Story gave both men a copy of a memorandum which advised the parties that the decision of the Court, if handed down, would unanimously hold that no right of property did or could exist in the Court's opinions, and that the Justices were without power to confer upon its Reporters any copyright thereto. As to the marginal notes and indices prepared by Wheaton, however, the Court had touched upon but not finally determined the litigants' rights. "Under the circumstances," the memorandum concluded, "the Court thinks, that it is a fit subject for honourable compromise between the parties." *Id.* at 1380. On the advice of Webster, Wheaton rejected the suggested compromise.

⁴⁰ Joyce also noted that "[i]n his dissent, Justice Baldwin carefully noted that, in the proceedings on remand, Wheaton might still prove his rights to literary property in 'the marginal notes, or syllabus of the cases and points decided, the abstract of the record and evidence, and the index to the several volumes.' 33 U.S. (8 Pet.) at 698g (F. Brightly ed. 1883)." *Id.* at 1384-85 n. 515.

Dissenting Opinion

point—the noncopyrightability of the opinions of the Justices—there was unanimity: the Court could allow no impediment to the fullest possible dissemination of its judgments.” *Id.* at 1390.

The impact of *Wheaton v. Peters*, in my judgment, has been both broad and lasting.⁴¹ The concluding sentence of Justice McLean’s opinion destroyed “a presumption of ownership, long shared by Wheaton, his predecessors and the Justices themselves, which if given the force of law would have bestowed upon the Reporters of the Supreme Court exclusive title to those classic expressions of American law that constitute the Court’s essential legacy to the nation.” *Id.* at 1386.

In 1883, West published the annotation “Literary Property at Common Law,” 17 Fed. 593 (1883), authored by Henry Wade Rogers.⁴² Rogers quoted the concluding sentence of *Wheaton v. Peters*, and added that “[a]ll that the reporter can copyright is his own individual work—the headnotes, the statement of the case, analysis or summary of

⁴¹ Joyce noted the immediate impact of *Wheaton v. Peters* in regard to the publication of Johnson’s *Chancery Reports Condensed* in 1836 in which the earlier published opinions of Chancellor Kent were “released from the state of confinement in which they are at present kept by means of the large sums asked for the volumes which contain them.” *Id.* at 1386, n. 524.

Wheaton v. Peters produced the flood of litigation between law book publishers reflected by the “older cases” to which Professor Nimmer made reference by his citation of *Building Officials*, cited in 1 *Nimmer on Copyright*, § 5.06[C], p. 5-52, n. 30.

⁴² Henry Wade Rogers was Tappan Professor of Law at the University of Michigan School of Law in 1883. He later served on the law faculties of Northwestern and Yale Law School. He was appointed to the Court of Appeals for the Second Circuit in 1913, serving until his death in 1926. See *Judges of the United States* (Judicial Conference of the United States, 1983).

Dissenting Opinion

the arguments of counsel, the index, etc." *Id.* 33 U.S. (8 Pet.) at 596.⁴³

Although the majority cited and quoted a short portion of *Wheaton v. Peters* in a footnote, at 1223, n. 3, it did not discuss that leading case in any detail. It did not even cite *Banks v. Manchester*. Rather, the majority discussed *Callaghan* in a manner that suggested that *Callaghan* must be viewed as having somehow qualified *Wheaton v. Peters*' rationale and its direct holding. I do not agree that *Callaghan* can be read in that manner. Nor do I agree with the majority's suggestion that the teaching of *Callaghan* "does not come through with unmistakable clarity." Slip op. at 8. For I believe *Callaghan's* teaching is clear when that case is read in tandem with *Banks v. Manchester*, 128 U.S. 244, 9 S. Ct. 36, 32 L. Ed. 425 (1888), as I believe it must.⁴⁴

Banks v. Manchester, on its facts, involved a case in which the defendant published only the court opinions that had been earlier published by the plaintiff. *Callaghan*, on

⁴³ A few years later, in *Banks v. West Publishing Co.*, 27 Fed. 50 (C.C. Minn. 1886), West successfully sustained its right to publish the opinions of the Supreme Court of Iowa in its *Northwestern Reporter* in the face of an Iowa statute which purported to give a copyright to Banks. West's argument that "there is no such thing as a copyright or other property right in the opinions of the judges" was sustained, as it should have been. *Id.* at 56.

Circuit Judge Brewer relied in the lower court opinion in *Banks v. Manchester*, 23 Fed. 143 (1885), which in turn had relied on *Wheaton v. Peters* and on both of the lower court's opinions in *Myers v. Callaghan* reported in 5 Fed. 726 (1881) and 20 Fed. 441 (1883), which were also based on *Wheaton v. Peters*. The Supreme Court, of course, affirmed the lower court decisions on which Circuit Judge Brewer relied when it decided *Banks v. Manchester* and *Callaghan* in 1888.

⁴⁴ *Banks v. Manchester* was decided on November 19, 1888, less than a month before *Callaghan* was decided on December 17, 1888. The opinions in both cases were written by Justice Blatchford.

Dissenting Opinion

the other hand, on its facts was a case in which the defendant not only published the plaintiff's earlier-published court opinions, the defendant also copied that part of the plaintiff's law reports—the head-notes and the statements of the cases prepared by the plaintiff—that *Wheaton v. Peters* recognized was subject to copyright.

The Court concluded in *Banks v. Manchester* that application of the principles enunciated in *Wheaton v. Peters* established that the defendant should prevail on the facts of that case. In *Callaghan*, the Court concluded that the application of the same principles of law supported a judgment that plaintiff was entitled to injunctive relief on the facts of that case.

The record in this case establishes a factual situation comparable to *Banks v. Manchester* rather than that presented in *Callaghan*. Hence, it is my view that our panel must follow *Banks v. Manchester's* application of the principles enunciated in *Wheaton v. Peters* and distinguish *Callaghan* on its facts.

In *Banks v. Manchester* it is clear the defendant published *only* the opinions of the Supreme Court of Ohio together with the syllabus and the statement of case that had also been prepared by the judges.⁴³ In affirming the circuit court's dismissal of the plaintiff's infringement action, the Court concluded in *Banks v. Manchester* that:

The question is one of public policy, and there has always been a judicial *consensus*, from the time of the decision in the case of *Wheaton v. Peters*, 8 Pet.

⁴³ The Court stated that "it is to be taken as true, * * * that what the defendant published in 'The American Law Journal' was exclusively the work of the judges, comprising not only the opinion or decision of the court or the commission but also the statement of the case and the syllabus or head note." 128 U.S. at 251, 9 S. Ct. at 39.

Dissenting Opinion

591 [, 33 U.S. 591], that no copyright could under the statutes passed by Congress, be secured in the products of the labor done by judicial officers in the discharge of their judicial duties. The whole work done by the judges constitutes the authentic exposition and interpretation of the law, which, binding every citizen, is free for publication to all, whether it is a declaration of unwritten law, or an interpretation of a constitution or a statute.

Id. 128 U.S. at 253, 9 S. Ct. at 39. The Court then quoted the final sentence of *Wheaton v. Peters* and added that “[w]hat a court, or a judge thereof, cannot confer on a reporter as the basis of a copyright in him, they cannot confer on any other person or on the State.” *Id.* at 254, 9 S. Ct. at 40.

In *Callaghan*, the defendant had copied the plaintiff's head notes and statements of each case—the only part of a law report subject to copyright. The Court cited *Banks v. Manchester* to support its conclusion that “there can be no copyright in the opinions of the judges, or in the work done by them in their official capacity as judges.” *Id.* 128 U.S. at 647, 9 S. Ct. at 184. It also concluded, consistent with *Wheaton v. Peters*, that there is “no ground of public policy” which prohibits a reporter from obtaining a copyright in that part of a law report “which will cover the matter which is the result of his intellectual labor.” *Id.* at 647, 9 S. Ct. at 184.⁴⁶ *Callaghan*, in its application of the

⁴⁶ *Callaghan* expressly adopted Justice Story's view of *Wheaton v. Peters* as expressed in *Gray v. Russell*, as reported in 1 Story, 11 (1839) (and reported as Case No. 5,728 in 10 Fed. Cases 1035). Justice Story stated in that case that it was “little doubted by the court [in *Wheaton v. Peters*], that Mr. Wheaton had a copyright in his own marginal notes, and in the arguments of counsel as prepared and arranged in his work.” *Id.* 128 U.S. at 650, 9 S. Ct. at 185.

Dissenting Opinion

principles stated in both *Wheaton v. Peters* and in *Banks v. Manchester* expressly adopted the circuit court's findings of fact in regard to all volumes of Freeman's *Illinois Reports* in litigation.⁴⁷ *Callaghan* noted in regard to volumes 32 to 38, inclusive, that Judge Drummond had stated in his first opinion that although there was an "appearance of independent labor performed" by defendant's editors, he found as a fact that it was apparent that "Mr. Freeman's volumes were used; in some instances words and sentences copied without change, in others, changed only in form; and the conclusion is irresistible, that for a large portion of the work [defendants] obtained that information from the volumes of Mr. Freeman." 128 U.S. at 660, 9 S. Ct. at 189.⁴⁸

In regard to volumes 39 to 46, the Court quoted Judge Drummond's finding of fact made in his second opinion that: "Upon comparing parts of each of the volumes, * * * I think there can be no doubt that in some respects, in each case, the Freeman volume has been used by the defendants

⁴⁷ The Court did so by quoting with approval the findings of fact made in Circuit Judge Drummond's first opinion in *Myers v. Callaghan* (which dealt with volumes 32 to 38 of plaintiff's Freeman's *Illinois Reports*) as reported in 10 Bissell 139 (1881) and from his second opinion in *Myers v. Callaghan* (which dealt with volumes 36 to 46 of the same reports) as reported in 20 Fed. 441 (C.C.N.D. Ill. 1883). Judge Drummond's first opinion is also reported in 5 Fed. 726 (C.C.N.D. Ill. 1881). Both Judge Drummond's opinions show that he relied solely on *Wheaton v. Peters* and that he made his findings of fact consistent with the principles stated in that case.

⁴⁸ Judge Drummond found, again as a matter of fact, that the defendant plagiarized plaintiff's head notes and statements of the cases in such a manner that "the paging of the [defendant's] volumes is substantially the same [as plaintiff's page numbers] so that the cases in the corresponding volumes appear on the same page." *Id.*

Dissenting Opinion

in the head-notes, the statements of facts, and the arguments of counsel." 128 U.S. at 661, 9 S. Ct. at 189.⁴⁹

Judge Drummond observed in his second opinion in regard to volumes 39 to 46 that the "fact appears to be, and indeed it is not a subject of controversy, that in arranging the order of cases, and in the paging of the different volumes, the Freeman edition has been followed by the defendants." *Id.* at 661, 9 S. Ct. at 189. He, however, added in the same sentence, that "while this is so, I should *not* feel inclined, *merely on that account* and independent of other matters to give a decree to the plaintiff, *although it is claimed* that the arrangement of the cases and the paging of the volumes are protected by a copyright." *Id.* (Emphasis added). The Court accepted Judge Drummond's conclusion that "the arrangement of law cases and the paging of the book may depend simply on the will of the printer, or the reporter, or publisher, or the order in which the cases have been decided, or upon other accidental circumstances." *Id.* at 662, 9 S. Ct. at 190.⁵⁰

Callaghan, as I read that case, treated the plagiarized pages of the plaintiff's volumes solely as a question of fact and that it applied the principles enunciated in *Wheaton v.*

⁴⁹ The Court apparently made its own examination of volumes 39 to 46. For it added its own finding that "one of the most significant evidences of infringement exists frequently in the defendants' volumes, namely, the copying of the errors made by Mr. Freeman." *Id.* 128 U.S. at 662, 9 S. Ct. at 190.

⁵⁰ The Court also quoted Judge Drummond's finding that although the object of the defendant's plagiarism of the plaintiff's page numbers was to avoid "confusion in the references and examination of the cases," he did not regard that fact "as an independent matter, but in connection with other similarities existing between the two editions, when I say, taking the whole together, the Freeman volumes have been used in editing and publishing the defendants' volumes." *Id.* at 662, 9 S. Ct. at 190.

Dissenting Opinion

Peters to all factual circumstances presented in that case. Those factual circumstances, as I have stated, were in sharp contrast to those presented in *Banks v. Manchester*, decided in tandem with *Callaghan*.⁵¹

Our panel must, of course, follow *Callaghan*. But our panel must also follow *Wheaton v. Peters* and *Banks v. Manchester*. *Callaghan*, as I read that case, simply applied the principles enunciated in *Wheaton v. Peters* to entirely different factual circumstances than those presented in either *Wheaton v. Peters* or in *Banks v. Manchester*.

The principles of law stated and applied in all three of the Supreme Court cases are the same. I believe that an appropriate application of those principles requires that the district court's interlocutory order be reversed rather than affirmed.

For it is my view that if pagination of a law report had been at issue in any of those three cases, the Court would not have hesitated to hold that star pagination in a volume of published law reports would not be subject to copyright. That was the conclusion of the only court that has considered that precise issue.⁵² I turn now to the Second Cir-

⁵¹ It is not unlikely that the Court quoted Judge Drummond's discussion of the identical pagination of the volumes in response to a legal argument made by the defendant in *Callaghan*.

Defendant argued that "[t]he paging of the Freeman edition is equally wanting in any element of literary property, originality or exclusive ownership. Ever since the invention of printing, books have been paged in numerical order, and appellee might with equal propriety claim an exclusive property in the system of Arabic numerals as in the paging of his books. Moreover, the printed paging is merely the mechanical labor of the printer, and is never performed by the author or publisher." 128 U.S. at 641, 9 S. Ct. at 183.

⁵² The Second Circuit has, of course, held that the pagination of a publication of other material that is in the public domain is not subject to copyright. See the discussion of *Eggers v. Sun Sales Corporation*, 263 Fed. 373 (2d Cir. 1920), *infra*, at page 1247.

Dissenting Opinion

cuit's decision in *Banks*. For I agree with the majority's conclusion that "the treatment of case arrangement and pagination in *Callaghan* was not crucial to the Court's decision" in that case. Op. at 1224.

V.

I dissent from the majority's acceptance of the district court's conclusion that "*Banks* does not support MDC's claim."⁵³ At 1225. The Second Circuit concluded in *Banks* that the plaintiff's infringement action was properly dismissed.⁵⁴ The plaintiff claimed in *Banks* that the eleven volumes (Vols. 38 to 49) of defendant's "L. Ed." reports, which contained forty volumes (Vols. 156 to 171, 173 to 178, and 180-195, inclusive) of plaintiff's "U.S." reports, infringed its copyright on its "U.S." reports.⁵⁵

The defendant, consistent with long-established practice in the publication of law reports, both in England and in the United States, used star pagination in order to permit

⁵³ The district court stated that "[t]his Court finds that MDC, in relying upon *Banks*, has chosen a fragile bark upon which to sail the rocky shoals of copyright law" and that "*Banks* does not prohibit West Publishing Company from obtaining a copyright in the pagination * * * of its publications." 616 F. Supp. at 1577.

⁵⁴ The Second Circuit held that "[w]e concur with Judge Hazel in his reasoning and conclusion that the *arrangement of reported cases in sequence, their paging and distribution into volumes*, are not features of such importance as to entitle the reporter to copyright protection of such details." (Emphasis added). 169 Fed. at 391.

⁵⁵ Defendant was able to include 40 volumes of the "U.S." reports in only 11 volumes of its "L.Ed." reports because the defendant's reports were printed in substantially smaller type and the arguments of counsel were omitted. The syllabuses and other editorial matters in the defendant's volumes were also more precise and substantially shorter than those published in plaintiff's volumes.

Dissenting Opinion

jump citations to particular pages in plaintiff's "U.S." reports. It is thus clear, that on the facts in *Banks*, the purchase of defendant's "L. Ed." because of defendant's use of star pagination, completely eliminated the need to purchase any of plaintiff's "U.S." reports. Plaintiff in *Banks*, as had the plaintiff in *Wheaton v. Peters*, sought to enjoin all of defendant's law reports.⁵⁶

Plaintiff, however, substantially amended its original complaint. Judge Hazel stated that by "stipulation of the parties the bill was amended to include *only* the charge of infringement arising out of *the arrangement of the cases*, the division into volumes, the table of cases, *and the numerical or star pagination* to indicate where in the official reports the different cases and points decided may be found." *Id.* at 386. (Emphasis added). *Banks* thus directly presented questions concerning the plaintiff's "arrangement of the cases" and the defendant's use of "star pagination."

Defendant broadly argued that "the reporter cannot have a copyright for *any* of the work produced by him in his official capacity" and further "broadly suggested that such labor is that of a paid employee and accordingly vests in the employer." *Id.* at 387-88. (Emphasis added). Judge Hazel rejected both those broad arguments. He recognized that the right to copyright the work of a paid employee, generally speaking, did vest in his employer. He concluded, however, that under *Banks v. Manchester* the "official re-

⁵⁶ Judge Hazel noted that plaintiff's "original bill charged the defendant with reproducing the syllabuses of the cases, table of cases, index digest, *together with the pagination and order of arrangement* of printing the decisions copyrighted by complainant and its predecessors." (Emphasis added). *Id.* at 386.

Dissenting Opinion

porter of the Supreme Court, though a sworn public officer, is not, however, confined to this strict rule." *Id.* at 388.⁵⁷

Citing *Banks v. Manchester*, Judge Hazel held that "[n]either the court nor the reporter *from motives of public policy*, can have any exclusive rights in the written or oral opinions of the court." *Id.* at 388. (Emphasis added). Judge Hazel concluded, and the Second Circuit concurred, that "the reporter's right to protection must be limited to his intellectual labor" and that "for another to simply adopt the plan of grouping of the cases, making marginal reference to the paging of the volumes issued under his direction, without in any way pirating the substance of his origination, is not enough, in my judgment, to establish infringement." *Id.* at 390.

Judge Hazel expressly relied on Justice Harlan's opinion written as a Circuit Justice in *Howell v. Miller*, 91 Fed. 129, 33 C.C.A. 407 (1898). He quoted with approval Justice Harlan's statement that "[i]f Miller had cut from Howell's books, delivered to him by the state, the General Laws of Michigan as therein printed, and the pages so cut out had been used when his compilation was printed—if

⁵⁷ Judge Hazel explained that "[t]here is abundant precedent for holding that a salaried reporter of the court, unless forbidden by statute, may secure copyright of the head-notes, statements of cases, title of the volume, arrangement or grouping of cases, index digest, synopsis of the arguments, and in short such portions of his compilation or authorship as requires the exercise of intellectual thought and skill," citing *Banks v. Manchester*, 128 U.S. 244, 9 S. Ct. 36, 32 L. Ed. 425. *Id.* at 388.

Judge Hazel added that it "had been held in the federal courts previous to the date of that decision [*Callaghan*] that an official court reporter is entitled to copyright protection for his marginal notes or synopsis of case, statement of cases, abstract of arguments of counsel, and indexes to volumes. See *Wheaton v. Peters*, 8 Pet. 591, 8 L. Ed. 1055; *Gray v. Russell*, 1 Story, 11 Fed. Cas. No. 5,728." *Id.* at 388.

Dissenting Opinion

this had been done and nothing more—there would have been no ground of complaint.” Judge Hazel then concluded that “an action for infringement does not lie if the defendant’s asserted wrongdoing simply consisted of reprinting the decisions of the court *with the paging*, the defendant independently supplying head-notes, statements of cases, etc.”⁵⁸ *Id.* at 391. (Emphasis added).

It is important to note that *Banks* considered the factual circumstances relating to that plaintiff’s arrangement of cases. In regard to both the plaintiff’s arrangement of the cases and its pagination of the volumes, Judge Hazel concluded that for a reporter “to merely arrange the cases *in sequence* [and to page] the volumes [were not] features or characteristics of such importance as to entitle him to copyright protection of such details.” 169 Fed. at 390. (Emphasis added). That conclusion, when read with Judge Hazel’s discussion of all three of the controlling Supreme Court cases, was obviously based on the reason that such an arrangement and the pagination of the volumes were not original works of authorship within the meaning of the Copyright Act.⁵⁹

⁵⁸ It is to be noted that Justice Harlan was a member of the Court that decided *Banks v. Manchester* and *Callaghan*. He summarized what each case held in his opinion in *Howell v. Miller*. Justice Harlan did not suggest that the official status of the reporter was a factor that played a part in either decision.

The passage of time has not eroded the precedent of *Howell v. Miller*. For Justice Harlan’s statement was recently quoted with approval in *State of Georgia v. Harrison Co.*, 548 F. Supp. 110, 114 (N.D. Ga. 1982), *vacated per stipulation*, 559 F. Supp. 37 (1983).

⁵⁹ The Second Circuit expressly concurred in Judge Hazel’s “reasoning and conclusion that the arrangement of reported cases *in sequence*, their paging, and distribution into volumes, are not features of such importance as to entitle the reporter to copyright protection of such details.” *Id.* at 391.

Dissenting Opinion

Attention should therefore be focused on whether the opinions reported in the volumes of the "U.S." reports in litigation had, in fact, been merely arranged "in sequence." For I do not believe that it can be doubted that all the volumes in litigation were in the record considered by the district court and Second Circuit in *Banks*. Examination of each "U.S." volume in litigation establishes that the Court's official reporter, Bancroft Davis (whose testimony was quoted in Judge Hazel's opinion) meant exactly what he said when he testified that he simply took the cases "as they came." *Id.* at 389.⁶⁰ Examination of those "U.S." volumes establishes that the cases were, in fact, published *in the sequence* in which they had been decided.

The record in this case shows that the district court asked West's counsel whether it was West's theory that "the *page numbers* express the arrangement" of West's cases. (A301). West's counsel replied that "they certainly do, your Honor." (*Id.*). West's counsel directed the district court's attention to 300 F. Supp. 100 to illustrate West's arrangement. (A203).

MDC attached an addendum to its brief (A32a-A38a) that compared how the cases would have been arranged in 300 F. Supp. had the cases been arranged by date of decision with the actual arrangement of the cases as they were, in fact, reported in 300 F. Supp. That addendum shows that West's actual arrangement of cases was inconsistent with the method stated in West's affidavits. West, in its brief filed in this Court, replied to MDC's argument by stating that its affidavits set forth only West's "current practice" and stated that 300 F. Supp. "was published in

⁶⁰ Both Judge Hazel and the Second Circuit obviously refused to accept portions of Mr. Davis' quoted testimony which might be said to suggest the cases were arranged in some other manner.

Dissenting Opinion

1969 before [West's] current practice was adopted." (West's brief, p. 15, n.11).

West's answer to MDC's argument raises two factual questions, neither of which were considered by the district court or by the majority. First, if the West affidavits cover only the manner in which West has arranged its cases since 1969, there is nothing in the record to support any finding of fact in regard to how West may have arranged its cases in all the volumes of reports published by it from January 2, 1910 to 1969.⁶¹ Second, and perhaps of greater importance, if West simply publishes cases in the chronological *sequence* that cases are handed down by a particular court, such an arrangement would fall within the factual circumstances and decision in *Banks*.

I disagree with the majority's suggestion, at 1225-1226, that time has somehow eroded *Banks*' application of the principles of law that were settled by *Wheaton v. Peters*. The Second Circuit followed *Banks* in *Eggers v. Sun Sales Corporation*, *supra*, 263 Fed. 373. That case rejected a plaintiff's argument which was substantially the same as West's *Callaghan* argument in this case. The question

⁶¹ I have additional doubts about the record before the district court. For one of West's affidavits stated that "West does not give any judge the opportunity to approve West's corrections prior to publication." (A51). While that statement may be accurate in regard to West's current practice, judges appointed before 1969 will recall West's pre-1969 practice of sending the galley proof of an opinion designated for publication back to the judge who wrote the opinion for corrections prior to publication.

The record, as I read it, does not reflect either the pre-1969 practice or the reasons for West's apparent abandonment of that practice. Those factual circumstances may, in my view, be relevant to the determination of the factual questions presented on the merits in regard to how West has "arranged" its cases both before and after 1969. For the permanent injunctive relief sought by West covers both periods of time.

Dissenting Opinion

presented was whether the defendants' use of the same pagination used by the plaintiff in its copyrighted publication of General Pershing's World War I Official Report to the Secretary of War, a document in the public domain, could be said to infringe plaintiff's copyright. A panel of the Second Circuit that included Henry Wade Rogers (*see* footnote 42, *supra*) affirmed the district court's dismissal of plaintiff's infringement action.

On the facts of that case, defendants did not reproduce any of the drawings, photographs or any other feature of plaintiff's pamphlet that were admittedly subject to copyright. Defendants did, however, use plaintiff's page numbers in its publication after learning that "there was a good market for the report"; there was no question that the defendants did, in fact, imitate "plaintiff's attractive get-up." *Id.* The *Sun Sales* court recognized that defendants' conduct "may be called mean" and that, on the facts, it was "even possible that defendants' printers set up the official report from a copy of plaintiff's book; identity of pagination leads to that suspicion." 263 Fed. at 375.

The court, however, in express reliance on its earlier decision in *Banks*, stated in that regard that "legally that is not of sufficient importance to constitute infringement of copyright." *Id.* at 375. The court concluded that "[a]ssuming, * * * that plaintiff's pamphlet contains any copyrightable matter, we are of the opinion * * * that defendants' is not an infringement." *Id.* at 375.

It is thus clear that the Second Circuit's decision in *Banks* does not stand alone. I suspect the reason that there are but few cases that involve questions of whether the pagination of a document in the public domain is subject to copyright is because few plaintiffs have ever tried to make such a claim in regard to the page numbers on their copyrighted

Dissenting Opinion

publication.⁶² But whatever the reason, such a claim has been rejected by every court that has had occasion to decide the question.

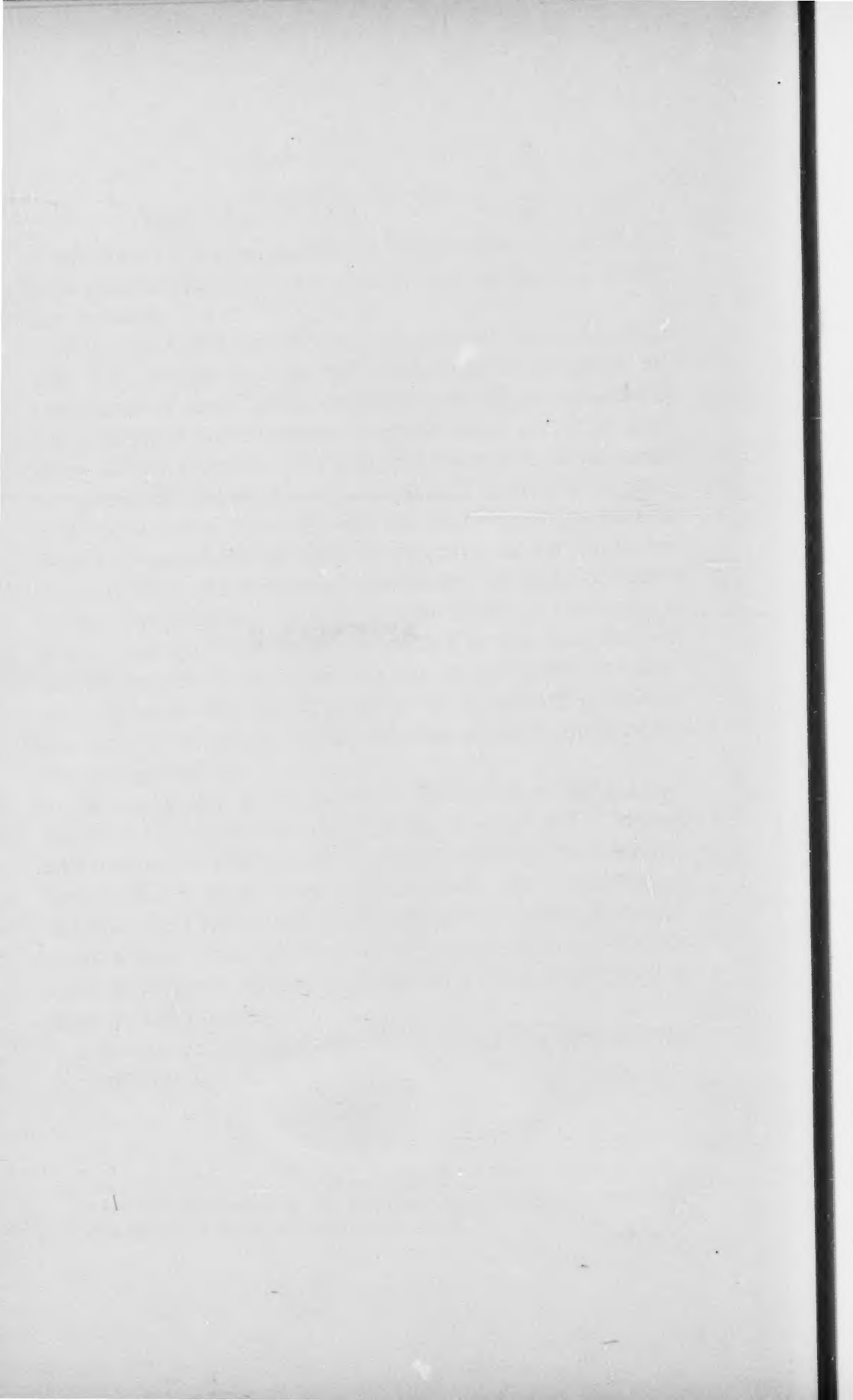
West has cited no authority to support its contention that it is entitled to copyright protection of either its arrangement of cases or the pagination of all the volumes it has published since January 2, 1910 under either its past or its current practice. I believe that this court, particularly on a Section 1292(a)(1) appeal, should hesitate to suggest that the scope of the copyright act can be said to protect West's arrangement of cases which may, on the facts, be no more than the sequential publication of court opinions in the chronological order in which the cases are handed down. Nor do I believe on the record in this case that we should suggest in any way that the scope of West's copyright is broad enough to protect the placement of arabic numbers on the pages of the volumes in which those opinions are published.

As I suggested at the outset, I would follow the lead of the First Circuit in *Building Officials & Code Adm.*, *supra*, and reverse the district court's grant of a preliminary injunction on this Section 1292(a)(1) appeal. For I believe, as did the First Circuit, that final judgment in this case should await a more complete hearing on the merits in the district court and a later review of that court's final decision on a Section 1291 appeal.

I concur in part and respectfully dissent in part for the reasons stated.

⁶² See the discussion of the page numbers on a new compilation of Shakespeare's work, *supra*, at page 31, n. 18.

APPENDIX C



Memorandum Order

UNITED STATES DISTRICT COURT

DISTRICT OF MINNESOTA

FOURTH DIVISION

Civil No. 4-85-931

WEST PUBLISHING CO.

v.

MEAD DATA CENTRAL, INC.

Vance K. Opperman, Diane M. Hellund,
Joseph R. Kernan, Jr., OPPERMAN
& PAQUIN, Minneapolis, Minnesota
for plaintiff.

John D. French, Duane W. Krohnke,
John F. Beukema, FAEGRE & BEN-
SON, Minneapolis, Minnesota for
defendant.

In this action, plaintiff West Publishing Company (West) alleges copyright infringement by defendant Mead Data Central, Inc. (MDC) on the basis of MDC's proposed introduction of "star pagination" keyed to West's reports in its LEXIS legal research system. West is before the Court seeking a preliminary injunction enjoining this introduction pursuant to Rule 65 of the Federal Rules of Civil Procedure (F.R.Civ.P.). MDC has answered, and moves for dismissal of all counts, alleging plaintiff's failure to state a claim upon

Memorandum Order

which relief may be granted, pursuant to Rule 12(b)(6), F.R.Civ.P. The Court heard oral argument on September 17, 1985. Based upon the files, briefs, affidavits, arguments of counsel, and all other matter submitted, the Court grants plaintiff's motion for preliminary injunction, and denies defendant's motion for dismissal.

Background

For all purposes relevant to these motions, West is engaged in the business of collecting, selecting, compiling and reporting the judicial opinions of state and federal courts. West arranges these opinions into a series of books collectively known as the "National Reporter System" publications. Each case report West publishes (West report) is assigned to one of the individual series within the overall National Reporter System. This is done on the basis of court and/or subject matter of the opinion. West reports are further categorized, arranged and assigned to a volume within the series. The volumes and pages are then sequentially numbered to allow detailed reference to West's reports. The exact location of each West report in the overall arrangement of case reports, can be found ("cited") by stating the volume number, series designation, and page number of the report. West represents that upon completion of each volume it registers a copyright claim with the Register of Copyrights and receives a separate Certificate of Registration. (See, Affidavit of Arnold O. Ginnow; Affidavit of Darrin [sic] Pepper.) Copies of the Certificates of Registration were provided during argument of the present motion. for purposes of this decision, the validity of the documents are not in question.

The Court takes notice of West's success in its field. Judicial decisions are routinely identified by the names of

Memorandum Order

the parties and the West citation, i.e. volume numbers, series designation, and first page of the opinion.

MDC owns and operates LEXIS, a computer-assisted legal research tool containing decisions of state and federal courts (LEXIS reports) in its database. The judicial opinions stored in the LEXIS database note the citations to the first page of the judicial opinions as reported in West's National Reporter System. This is done by displaying at the top of the LEXIS computer screen a West series designation, volume number, and page number on which the opinion begins.

In June of 1985, MDC announced its plan to include "star pagination" within the text of LEXIS reports by October of 1985. MDC's announcement and subsequent advertisements of this new feature indicate that star pagination will consist of "the addition of the official page cites to the full text of online case law material." (See defendant's Exhibit E.) Star pagination was acknowledged at oral argument to be the insertion of numbers from West's National Reporter System publications within the body of LEXIS reports. This will permit the LEXIS user to determine the West page number coinciding with the text of a LEXIS report taken from the LEXIS screen or computer printout, without the physical necessity of referring to the volume of the National Reporter System publication in which the report appears.

West claims that MDC's intended star pagination constitutes an appropriation of West's comprehensive arrangement of case reports in violation of the Copyright Revision Act of 1976, 17 U.S.C. 101, *et seq.* On this basis, West seeks this preliminary injunction to enjoin MDC's alleged infringement.

*Memorandum Order**Discussion*

The factors to be considered in the decision to grant or deny a preliminary injunction are set forth by the Eighth Circuit in *Dataphase Systems Inc. v. C.L. Systems, Inc.*, 640 F.2d 109 (8th Cir. 1981). *Dataphase* mandated an analysis of the probability of the movant's success on the merits; the threat of irreparable harm to the movant if the preliminary injunction is denied; the balance between this harm and the harm the preliminary injunction, if granted, would cause to the other party; and the public interest in granting or denying the preliminary injunction. No one of the above factors determines whether a preliminary injunction should issue. Rather, the equities must be balanced to achieve a just determination. *Id.* at 113, 114.

I. West's probability of success on the merits.

West's probability of success on the merits at trial depends on the validity of its copyright infringement claim. West claims that its National Reporter System publications are protected by copyright. At the hearing of its motion West presented certificates of copyright registration for each of its reporter volumes. A copyright registration generally constitutes prima facie evidence of a valid copyright. 17 U.S.C. 410(c); *Eckes v. Card Prices Update*, 736 F.2d 859, 861 (2nd Cir. 1984). Defendant has the burden of overcoming this presumption. *Southwestern Bell T. Co. v. Nationwide Ind. Dir. Serv., Inc.*, 371 F. Supp. 900, 905 (W.D.Ark. 1974).

Neither party questions that some parts of West's National Reporter System publications are appropriate subjects for copyright protection. The focus is on which portions of those publications are under the protection of the copyright laws. West claims that its arrangement

Memorandum Order

of cases in its volumes and the page numbers it sets forth can be copyrighted. MDC denies West's claim. The Court finds two cases of particular interest and importance in providing an analytic framework in which to consider the claims of the parties. They are *Callaghan v. Myers*, 128 U.S. 617 (1888) and *Banks Law Pub. Co. v. Lawyers Co-Operative Pub. Co.*, 169 F. 386 (2nd Cir. 1909). It is to these two cases that the Court must first turn.

In *Callaghan*, the plaintiff, Myers, became the owner of several volumes of the reports of the Supreme Court of the State of Illinois. These volumes were prepared by and acquired from the official reporter of the Supreme Court of the State of Illinois. The volumes contained not only the opinions of the Court, but also considerable matter original to the reporter including the title page, table of cases, headnotes, statements of facts, arguments of counsel, indices, etc. The Court held that all the matter in the law reports, excluding the opinions of the Court, were the appropriate subject matter of copyright protection. *Callaghan*, 128 U.S. at 647.

The Court in *Callaghan* specifically delineated the copyrightable portions of the law reports, saying:

Such work of the reporter, which may be the lawful subject of copyright, comprehends . . . the *order of arrangement of the cases, the division of the reports into volumes, the numbering and paging of the volumes, the table of cases cited in the opinions, (where such table is made,) and the subdivision of the index into appropriate, condensed titles, involving the distribution of the subjects of the various headnotes, and cross-references, where such exist.* (Emphasis added).

Callaghan, 128 U.S. at 649.

Memorandum Order

It is clear the Supreme Court found that under appropriate circumstances pagination and arrangement ascend to a level appropriate for copyright protection. If the arrangement of cases and the paging of the book depend simply on the will of the printer, or the order in which the cases have been decided, or upon other accidental circumstances, they of course are not subject to copyright protection because they then involve no labor, talent, or judgment. *Callaghan*, 128 U.S. at 661, 662.

West's comprehensive arrangement of cases satisfies the Supreme Court's *Callaghan* test of labor, talent, and judgment. West collects cases from every state and federal court in this country. West does not then simply take any cases it has on hand, put them together in any order, and bind in a hardback volume. They first separate state court decisions from federal court decisions. The state court decisions are further subdivided into regions and placed in a regional reporter appropriate for the case in question. The federal decisions are divided at the district court and appellate court level. District court decisions are further subdivided according to the subject matter of the decision be they bankruptcy, federal rules or other miscellaneous matter. This comprehensive process involves considerable planning, labor, talent, and judgment on West's part.

For its proposition that the arrangement and pagination of West's National Reporter System publications are not appropriate subject matter for copyright protection, MDC relies primarily on *Banks Law Pub. Co. v. Lawyers Co-Operative Pub. Co.*, 169 F. 386 (2nd Cir. 1909). In *Banks*, the plaintiff was the successor-in-interest to the official reporter of the United States Supreme Court. He engaged in the business of printing, publishing, and selling the Court's decisions as compiled, edited and arranged by the

Memorandum Order

official reporter. The defendant was in the business of printing, publishing and selling a competing edition of the Supreme Court's decisions. Plaintiff claimed that defendant's edition infringed its copyright since the arrangement of cases in defendant's edition, as well as the division of the decisions into volumes were the same as in plaintiff's books. Plaintiff also claimed that defendant's edition star paginated to plaintiff's official reports. The Court held that the official reporter's arrangement of cases within his volumes and the subsequent pagination of those volumes were *not* appropriate subjects of copyright protection. *Banks*, 169 F. at 390.

This Court finds that MDC, in relying upon *Banks*, has chosen a fragile bark upon which to sail the rocky shoals of copyright law. While *Banks* is offered for the proposition that "mere" pagination and arrangement do not rise to a dignity sufficient to justify the grant and protection of a copyright, this assertion bears further scrutiny. In *Banks*, the Court dealt with the rights of the assignee of the official reporter, whose statutory duty it was to report the decisions of the Supreme Court. He was required, by law, to organize them into volumes, and have them printed and published. According to the Court, it was the reporter's statutory duty to supply paging for the volumes together with an orderly arrangement of the cases. *Banks*, 169 F. at 389.

MDC claims that any distinction between the official or unofficial status of the Court's reporter is trivial. This Court disagrees. The *Banks* Court emphasized the official nature of the reporter's duties and declined to flatly deny copyright protection to pagination and arrangement. "In my estimation, no valid copyright for these elements or details *alone* can be secured to the official reporter. * * *

[A]n action for infringement does not lie if the defendant's

Memorandum Order

asserted wrongdoing *simply* consisted of reprinting the decisions of the court with the paging. (Emphasis supplied)." *Banks*, 169 F. at 390, 391. The Court could easily have said, "We hold that copyright protection may not be had for printed arrangement and pagination." Why did it not do so?

The answer lies in the inherent nature of printing when one is mandated to officially record a court's decision. The raw (slip) opinions must be collated and arranged. They then must be placed with a printer whose selection of type-face and page size dictate a certain number of words or lines for each page. Each page must be numbered sequentially. When one is mandated (as an official reporter) to perform these functions, the result is not an exercise of independent judgment or discretion. The arrangement and pagination inhere in the official process and become part of the public domain. For a person who stands in this official position, no copyright protection can be granted for arrangement or pagination.

The holding in *Banks*, then, does not stand for the proposition that arrangement and pagination are not copyrightable per se. Rather, it indicates that when required to do so by law, those labors do not reflect any independent judgment or discretion and as such become part of the public domain. *Banks* does not prohibit West Publishing Company from obtaining a copyright in the pagination or arrangement of its publications. West is not the official reporter for any court in this country nor is it required by statute to arrange or page its volumes. It does these things of its own initiative expending considerable labor, talent, and judgment in the process. West's page numbers and its arrangement of cases are necessarily within the scope of copyright protection.

Memorandum Order

If this were not so, one could not collect Shakespeare's plays—themselves not subject to copyright—into a copyrighted work. *See*, 17 U.S.C. 103. Someone's version of the bible would be able to be duplicated by another. *See*, 17 U.S.C. 103. One could photoduplicate them in whole without protection. Why are these works subject to copyright? Because while the base data lies in the public sphere, the arrangement and pagination of this public material reflects the skill, discretion and effort of the person crafting the arrangement.

Lastly, the Court feels it appropriate to indicate its belief that neither the *Callaghan* Court in 1888, nor the *Banks* court in 1909, could possibly have considered the effect of the computer with its nearly infinite information-gathering capability. There now exists a cybernetic technology which will random access the entire body of decisional law in a unified database. While matching arrangement and pagination once may have made one work parallel to another, it now enables one work to be totally ingested into another. These facts beggar a simple one-to-one analogy between one printed format and another. The courts in *Callaghan* and *Banks* could not have realized that the taking of an arrangement or page numbers from a collection of cases would absolutely do away with the underlying work.

Based on the foregoing, this Court finds that *Callaghan* supports and *Banks* does not bar copyright protection for West's laboriously prepared, voluntary arrangement of cases.

Beyond analysis of caselaw, this Court finds further reason to extend copyright protection to West's arrangement and pagination of its law reports: There is an additional contribution by West Publishing Company which

Memorandum Order

goes beyond the simple copyright which exists for their editorial work. The genius of this work is that it is self-indexing.* By assembling cases as they have been arranged in sequenced volumes, a case can be indexed by following its name with a volume number, series designation, and page number. In fact, this is the most common method of referencing cases in the field of legal research. By this device, the case of *United States ex rel. Miller v. Twomey*, consisting of several printed pages, and issued on May 16, 1973, by the Seventh Circuit Court of Appeals, is transformed.

The statement of the mere existence of the case of *United States ex rel. Miller v. Twomey*, standing alone is useless. It is useless because that decision, as issued, cannot be accessed. Its voice is silent, and its teachings are unheeded. This is so, as long as no person, beyond the Seventh Circuit Court as author, arranges it in accessible form and indexes the case. Interestingly, both parties to the present cause have done so. It is mutually as accessible in both LEXIS and the West publications. For neither party is the decision itself susceptible to copyright, since it is the Law as expounded by the Seventh Circuit Court of Appeals. In LEXIS, the case, in full text, is available by keying in appropriate signals to a computer in the memory of which the decision is held.

Or, you can refer to it as 479 F.2d 701.

What does 479 F.2d 701 mean? It means that the decision is found on the seven-hundred-and-first page of the

* The significance of this indexing function is seen by the fact that another whole enterprise, Shepard's Citations, has been established which indexes West's internal index. This is not unlike the system dealt with in *New York Times Co. v. Roxbury Data Interface, Inc.*, 434 F. Supp. 217 (D.N.J. 1977). This has proven to be an invaluable tool for promoting legal research.

Memorandum Order

four-hundred-seventy-ninth volume of the second series of the Federal Reporter, *according to West Publishing Company's arrangement of cases.*

The West Publishing Company's arrangement is a significant work of skill and enterprise which is itself entitled to copyright protection. 17 U.S.C. 103. That protection has been properly perfected and is of a nature cognizable in this Court.

This set arrangement is either a virtue or a defect depending on how it is viewed. LEXIS holds as one of its strengths in the marketplace, that unlike the West Company's static arrangement, in LEXIS a case's location is variable. Where the case is forever locked in Volume 479 of West's Federal second volumes, in the LEXIS system it is computer accessible at any time. It may be random accessed in any order, preceded and followed by whatever cases the mind and skills of the legal researcher compels. Defendant's Memorandum in Opposition to Plaintiff's Preliminary Injunction Motion, at 13.

LEXIS has long noted at the beginning of each of its cases the "cite" according to the West Publishing Company's arrangement. This West acknowledges as a fair use of its copyrighted material. Plaintiff's Reply Memorandum of Law in Support of Motion for Preliminary Injunction, at 17; 17 U.S.C. 107. It should be noted, parenthetically, that this is not necessarily altruism on West's part. That cite calls a researcher to West's books—which they are in business to sell as well as create.

But this case turns on whether or not the succeeding page numbers themselves are protected by copyright, even if the overall arrangement is a copyrightable entity. This Court holds that they are so protected.

In the present case, the text of the decisions is held in both the bound volumes of the West arrangement and the

Memorandum Order

computer memory of the MDC access devices.* As such the body of the decisional law in our courts is equally accessible to both parties. But the Court finds that the use of the second and succeeding numbers following the initial citation to West's arrangement, the so-called "jump cite" (i.e. 479 F.2d 701, 702), infringes on West's copyright. It does so because it goes beyond fair use. Once one has access to the MDC data base, using the LEXIS keyboard, one has the full text of the opinion. Once one has the jump cite, one has access to the copyright-protected overall arrangement as delineated by West Publishing Company.

With immediate access to the jump cite, there is instant access to West's whole arrangement; you never again need to purchase West's books in the marketplace to get each and every aspect of West's copyrighted arrangement of cases. This is the instance when "... a use that supplants any part of the normal market for a copyrighted work would ordinarily be considered an infringement." Senate Report [No. 94-473], cited in *Harper & Row Publishers v. Nation Enterprises*, 105 S.Ct. 2218, 2235 (1985). The computer "owns" West's copyrighted arrangement.

MDC argues that West's effort to claim copyright protection for page numbers is an attempt to copyright a numbering system. This argument is a sophistry. MDC urges that the pagination of West's volumes is simply a succession of arabic numbers, in serial order commencing with "1" and continuing through a book. Of course this is so, but the statement is trivial. It is beyond cavil that one cannot

* While the parties may, at this early stage of the litigation, dispute whether or not the precise words of each decision are exactly the same or vary significantly from West to MDC, for the purposes of this opinion, the texts of the decision are regarded as substantially identical.

Memorandum Order

copyright the arabic numbering system. 17 U.S.C. 102. But as is seen above, this is not just a series of numbers each rising by one over its predecessor, it is the basis of the West arrangement—the key to the self-index by which West's arrangement is accessed. This is, the Court finds, what is meant by the words "taken as a whole" in the copyright definition of "compilations". 17 U.S.C. 101. The sophistry is apparent when one considers that just as one cannot copyright the arabic number, so one cannot copyright the Latin alphabet or the English language. If MDC's argument were to be taken seriously, West's headnotes and case synopses would be susceptible to MDC's computers, too. They are all composed of Latin letters and words in the English language.

West has made an adequate showing, for *Dataphase* purposes, that its National Reporter System publications constitute a copyrightable arrangement of which the numbering and pagination of its volumes are a part. Since West's claim that it has copyrighted these publications is not currently disputed, West has the exclusive right to reproduce and distribute this arrangement. 17 U.S.C. 106.

MDC claims that its star pagination will not infringe West's arrangement because its random generated arrangement is entirely different from West's arrangement. It argues that star pagination will not bring the arrangements closer together. But for infringement purposes, MDC need not physically arrange its opinions within its computer bank in order to reproduce West's protected arrangements.* "[D]atabases are simply automated compilations—collections of information capable of being retrieved in various

* In a sense, the whole concept of serial order in a computer memory is meaningless. In LEXIS, the "opinions" are actually only recorded, accessible, electronic impulses.

Memorandum Order

forms by an appropriate search program . . . [I]t is often senseless to seek in them a specific fixed arrangement of data." *Rand McNally & Co. v. Fleet Management Systems*, 600 F. Supp. 933, 941 (N.D. Ill. 1984). This Court finds that MDC will reproduce West's copyrighted arrangements by systematically inserting the pagination of West's reporters into the LEXIS data-base. LEXIS users will have full computer access to West's copyrighted arrangement.

MDC claims that even if its star pagination would otherwise constitute infringement, it is legal fair use under 17 U.S.C. 107. This provision provides as follows:

[T]he fair use of a copyrighted work for purposes such as criticism, comment, news reporting, teaching, . . . scholarship, or research is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- 1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- 2) the nature of the copyrighted work;
- 3) the amount and substantiality of the portion used;
- 4) the effect of the use upon the potential market for or value of the copyrighted work.

Upon consideration of the statutory factors, this Court concludes that MDC's intended star pagination does not constitute fair use.

1. Purpose and character of the use.

MDC acknowledges that it hopes to introduce star pagination to enhance its position in the marketplace. In

Memorandum Order

other words, MDC's star pagination is a commercial use intended for profit. The Supreme Court in *Harper & Row Publishers v. Nation Enterprises*, 105 S.Ct. 2218, 2231 (1985) indicated that such a use tends to weigh against a finding of fair use. "[E]very commercial use of copyrighted material is presumptively an unfair exploitation of the monopoly privilege that belongs to the owner of the copyright." *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 451 (1984). Therefore, considering MDC's stated purpose of star pagination, it is difficult to find a fair use.

2. Nature of the copyrighted work.

Original works are generally accorded a higher degree of fair use protection than that granted to compilations. *Harper & Row Publishers v. Nation Enterprises*, 105 S.Ct. 2218, 2232 (1985). While the fact that the protected work is an arrangement might otherwise mitigate in MDC's favor, fair use claims involving compilations have been rejected. *See, e.g., Schroeder v. William Morrow & Co.*, 566 F.2d 36 (7th Cir. 1977). This is especially true when the purported fair use is commercial. *Financial Information, Inc. v. Moody's Investors*, 751 F.2d 501, 509 (2nd Cir. 1984). As acknowledged at argument, star pagination is being introduced to increase MDC's revenues, and enhance its market position. Under this factor, it cannot prevail on its fair use claim.

3. Amount and substantiality of the portion used.

MDC claims that West's page numbers constitute a miniscule portion of the total material contained in a given volume of a West reporter. While this may be true, it is not necessarily enlightening. When viewed in the light of MDC's intent and ability to expropriate each and every page number from each and every volume of West's reporters, the appropriation takes on a greater magnitude.

Memorandum Order

This Court holds, above, that this "small amount" is the key to the West arrangement.

This Court is convinced that MDC's star pagination of West's arrangements is both quantitatively and qualitatively substantial. Isolated instances of minor infringements, when multiplied many times, becomes in the aggregate a major intrusion upon the copyrighted material and must be prevented. *Harper & Row Publishers v. Nation Enterprises*, 105 S.Ct. 2218, 2235 (1985). By taking West's page numbers, MDC is taking West's arrangement justifying the grant of a preliminary injunction.

4. Effect of the infringing use on the market.

The final factor to examine in determining the validity of MDC's fair use claim is the effect that star pagination will have on the market for West Reporters. The fair use doctrine has always precluded a use that supersedes the use of the original. *Harper & Row Publishers v. Nation Enterprises*, 105 S.Ct. 2218, 2225, 2226 (1985). If both plaintiff's and defendant's works are used for the same purpose and they fulfill the same function in terms of actual or potential customer demand, then a fair use cannot be found. *Metro-Goldwyn-Mayer v. Showcase Atlanta Co-op Prod.*, 479 F. Supp. 351, 361 (N.D. Ga. 1976).

There can be little doubt that MDC's incorporation of West's page numbers into the LEXIS reports database will supercede a substantial use of West's hard bound volumes of reporters. Although each is a different medium, both MDC's computers and West's books, serve the function of providing the text of judicial opinions to the public. MDC's star pagination will supplant the need for West's National Reporter System publications; this is not a fair use.

MDC has thus far failed to show that its proposed star pagination is not a taking of West's copyrightable arrange-

Memorandum Order

ments, and MDC has not established that its star pagination constitutes a fair use. For *Dataphase* purposes, West has met the test of probable success on the merits in its claim of copyright infringement.

II. The threat of irreparable harm to West if the preliminary injunction is denied.

In order for a preliminary injunction to issue in this case, West must show that it will be threatened with irreparable harm if the preliminary injunction is denied. This Court finds that West has made the required showing of harm, for *Dataphase* purposes.

The general rule in alleged copyright infringement cases is that, for a preliminary injunction motion, irreparable injury is presumed once the movant has established a *prima facie* case of copyright infringement. *Video Views, Inc. v. Alexander*, No. 4-84-623, slip op. (D. Minn. Feb. 19, 1985); *Northwestern Bell Tel. Co. v. Bedco of Minn., Inc.*, 501 F. Supp. 299, 303 (D. Minn. 1980). Although this Court has noted that the general rule is more commonly applied to copyrighted materials other than compilations, it nonetheless recognizes the presumption when the movant has a strong claim for copyright infringement. *Northwestern Bell*, 501 F. Supp. at 303. This Court sets forth its holding that West has made a strong claim for copyright infringement. Therefore, the presumption of irreparable harm can be applied.

Even if the Court did not apply the presumption of irreparable harm, it is apparent that West has still made the necessary showing of harm for *Dataphase* purposes. If the defendant's use of plaintiff's copyrighted product may materially reduce the demand for West's product, a sufficient showing of irreparable injury for preliminary

Memorandum Order

injunction purposes has been made. *Wainwright Sec. v. Wall Street Transcript Corp.*, 558 F.2d 91, 94 (2nd Cir. 1977). West has asserted by affidavit that star pagination may reduce the need for its services and, in fact, claims that cancellation of a subscription to West's law reports has already occurred as a result of MDC's impending star pagination. *See*, Affidavit of Thomas A. Woxland. Therefore, West has made the requisite showing of irreparable injury.

III. The harm to West if the injunction is denied compared to the harm to MDC if the injunction is granted.

Dataphase requires balancing the harm inflicted by the grant of a preliminary injunction against any harm that will result from its denial. At oral argument on this subject, the principal harm suggested by MDC is loss of market supremacy for its having achieved this claimed advance in legal research. There was also a possibility that West might use the delay caused by an injunction to develop its own star pagination technique. This Court finds that neither position is substantial enough to seriously weigh in the *Dataphase* balance.

The market supremacy claim is easily dealt with: this Court finds that any market supremacy which MDC has generated is a function of its ability to infringe a copyright. This the Court will not protect.

As to MDC's second claim, it is true that West has a computer-assisted legal research system similar to LEXIS known as WESTLAW. MDC states that WESTLAW does not have a star pagination feature and indicates that if a preliminary injunction is issued, West will have time to develop such a feature, thus destroying any market lead time MDC may have had in introducing star pagination. This claim is speculative at best. MDC cannot possibly know what fea-

Memorandum Order

tures West intends to introduce in its WESTLAW system. Even if West were to introduce a star pagination feature, it should be noted that West would be referring to its own page numbers, from its own volumes of law reports, from its own National Reporter System publications. MDC has failed to show that any speculative harm to it will outweigh the probable harm to West.

IV. Public Interest.

The final factor to consider in determining whether a preliminary injunction should issue under *Dataphase* is the public interest in granting or denying the proposed injunction. The Court finds that the public interest favors preliminary injunctive relief.

The Constitution grants to Congress the power "[t]o promote the progress of . . . useful arts, by securing for limited times to authors . . . the exclusive right to their respective writings". U.S. CONST. art. I, sec. 8, cl. 8. This is a means by which an important public purpose may be achieved. It is intended to motivate creative activity by the provision of a special reward, and eventually allows the public total access to the products of their genius after the limited period of exclusive control has expired. The monopoly created by copyright thus rewards the individual author in order to benefit the public. *Harper & Row Publishers v. Nation Enterprises*, 105 S. Ct. 2218, 2223 (1985). Without the economic incentive to create which copyright protection provides, this incentive and the advantages it creates for the society may well be lost.

MDC in its briefs and memoranda finds it both "ludicrous" and "absurd" to believe that West would abandon its currently lucrative business if copyright protection was not extended to its page numbers. Considering, however, that MDC's star pagination may do away with the need

Memorandum Order

for West's reporters, this conclusion is not so hard to believe.

MDC claims that the public interest favors denying a preliminary injunction because its intended star pagination would give judges, lawyers and citizens freer access to the entire body of law. That is, the public need for access to the law, which is currently embodied in West's publications, should reduce or eliminate West's exclusive rights in its material. This Court is not persuaded. In dealing with a similar assertion, the Supreme Court in *Harper & Row Publishers v. Nation Enterprises*, 105 S. Ct. 2218, 2230 (1985) stated that:

It is fundamentally at odds with the scheme of copyright to accord lesser rights in those works that are of greatest importance to the public. Such a notion ignores the major premise of copyright and injures author and public alike. "[T]o propose that fair use be imposed whenever the 'social value [of dissemination] . . . outweighs any detriment to the artist,' would be to propose depriving copyright owners of their right in the property precisely when they encounter those users who could afford to pay for it." . . . "If every volume that was in the public interest could be pirated away by a competing publisher, . . . the public [soon] would have nothing worth reading."

As the Supreme Court makes clear, reducing copyright protection to works of public import would create an economic disincentive to create the work which would ultimately jeopardize the creation of these very works. Therefore, the public interest mandates that MDC's star pagination be restrained.

*Memorandum Order**Conclusion*

Based upon the above analysis of the factors necessary for a preliminary injunction under *Dataphase Systems, Inc. v. C.L. Systems, Inc.*, 640 F.2d 109 (8th Cir. 1981) and for the reasons set forth herein,

IT IS ORDERED that:

1. Plaintiff's motion for a preliminary injunction pursuant to Rule 65, F.R.Civ.P. is granted.
2. This preliminary injunction shall be effective upon the plaintiff's filing with the Clerk of this Court a bond pursuant to Rule 65(c), F.R.Civ.P., in the amount of \$100,000.
3. Defendant's motion to dismiss plaintiff's complaint pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure is denied.

Dated: October 3, 1985

/s/ JAMES M. ROSENBAUM

.....
JAMES M. ROSENBAUM
United States District Judge



APPENDIX D

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Modified Order for Preliminary Injunction

UNITED STATES DISTRICT COURT

DISTRICT OF MINNESOTA

FOURTH DIVISION

Civil File No. 4-85-931

WEST PUBLISHING COMPANY,

Plaintiff,

v.

MEAD DATA CENTRAL, INC.,

Defendant.

This matter is before the Court on plaintiff's motion for a preliminary injunction and on defendant's motion for modification of the Order for Preliminary Injunction, entered October 8, 1985. The Court heard arguments on plaintiff's motion on September 17, 1985. Vance K. Opperman, Diane M. Helland and Joseph R. Kernan, Jr., 100 Washington Avenue South, Suite 2200, Minneapolis, Minnesota 55401, appeared on behalf of plaintiff. John D. French, Duane W. Krohnke and John F. Beukema, 2300 Multifoods Tower, 33 South Sixth Street, Minneapolis, Minnesota 55402, appeared on behalf of defendant.

Based upon all the files, records and proceedings herein, and the arguments of counsel at the hearing,

IT IS HEREBY ORDERED that defendant, its officers, employees, agents, servants and all those in active concert or participation with defendant in the operation or programming of defendant's computer-assisted legal research service, LEXIS, are preliminarily enjoined from displaying, referenc-

Modified Order for Preliminary Injunction

ing or including the page numbers of any and all publications within plaintiff's National Reporter System, including, but not limited to, *Supreme Court Reporter*, *Federal Reporter* and *Federal Reporter Second Series*, *Federal Supplement*, *United States Claims Court Reporter*, *Federal Rules Decisions*, *Bankruptcy Reporter*, *Atlantic Reporter* and *Atlantic Reporter Second Series*, *California Reporter*, *North Eastern Reporter* and *North Eastern Reporter Second Series*, *North Western Reporter* and *North Western Reporter Second Series*, *New York Supplement* and *New York Supplement Second Series*, *Pacific Reporter* and *Pacific Reporter Second Series*, *Southern Reporter* and *Southern Reporter Second Series*, *South Eastern Reporter* and *South Eastern Reporter Second Series*, and *South Western Reporter* and *South Western Reporter Second Series*, published during the period from January 2, 1910 to the present within or in relation to the text of court opinions contained in the LEXIS database.

PROVIDED, that this order in no way prohibits defendant from continued use of plaintiff's volume numbers, series designations or page numbers on which court opinions begin in the National Reporter System publications, as currently used and displayed by defendant on the LEXIS screen.

PROVIDED FURTHER, that this order in no way requires defendant to delete the star pagination which is incorporated in the internal LEXIS database as of October 8, 1985, until further order of this Court.

PROVIDED FURTHER, that this order in no way prohibits defendant from internal display, review and maintenance of the star pagination which is incorporated in the internal LEXIS database as of October 8, 1985, until further order of this Court.

Modified Order for Preliminary Injunction

IT IS FURTHER ORDERED that defendant is to take all reasonable steps to make its officers, agents, servants, employees, attorneys and those in active concert and participation with it aware of the existence and terms of this preliminary injunction order, as well as their duty to abide by said order.

IT IS FURTHER ORDERED that this preliminary injunction shall be effective upon the plaintiff's filing with the Clerk of this Court a bond pursuant to Rule 65(c), F.R.Civ.P., in the amount of \$100,000.

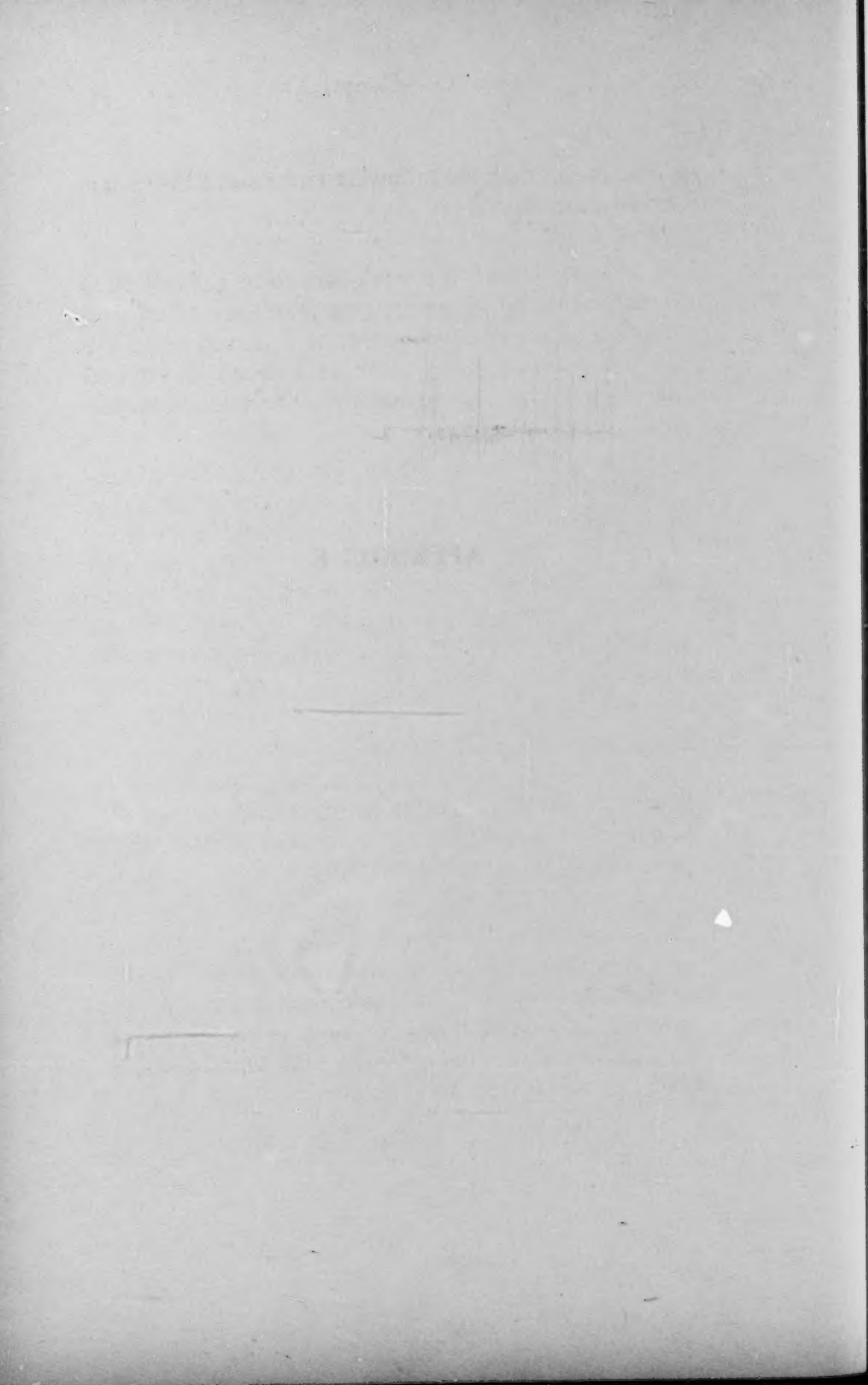
IT IS FURTHER ORDERED that defendant's motion to dismiss plaintiff's complaint pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure is denied.

Dated: October 31st, 1985

/s/ JAMES M. ROSENBAUM

.....
JAMES M. ROSENBAUM
United States District Judge

APPENDIX E



Title 17—Copyrights

§ 101. Definitions

As used in this title, the following terms and their variant forms mean the following:

* * *

A "compilation" is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term "compilation" includes collective works.

"Copies" are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term "copies" includes the material object, other than a phonorecord, in which the work is first fixed.

* * *

To "display" a work means to show a copy of it, either directly or by means of a film, slide, television image, or any other device or process or, in the case of a motion picture or other audiovisual work, to show individual images nonsequentially.

* * *

"Literary works" are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

* * *

Title 17—Copyrights

A "work of the United States Government" is a work prepared by an officer or employee of the United States Government as part of that person's official duties.

A "work made for hire" is—

(1) a work prepared by an employee within the scope of his or her employment; or

(2) a work specially ordered or commissioned for use as a contribution to a collective work, as a part of a motion picture or other audiovisual work, as a translation, as a supplementary work, as a compilation, as an instructional text, as a test, as answer material for a test, or as an atlas, if the parties expressly agree in a written instrument signed by them that the work shall be considered a work made for hire. . . .

A "computer program" is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.

§ 102. Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

(1) literary works;

(2) musical works, including any accompanying words;

Title 17—Copyrights

- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works; and
- (7) sound recordings.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

§ 103. Subject matter of copyright: Compilations and derivative works

(a) The subject matter of copyright as specified by section 102 includes compilations and derivative works, but protection for a work employing preexisting material in which copyright subsists does not extend to any part of the work in which such material has been used unlawfully.

(b) The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

§ 105. Subject matter of copyright: United States Government works

Copyright protection under this title is not available for any work of the United States Government, but the United

Title 17—Copyrights

States Government is not precluded from receiving and holding copyrights transferred to it by assignment, bequest, or otherwise.

§ 106. Exclusive rights in copyrighted works

Subject to sections 107 through 118, the owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

(1) to reproduce the copyrighted work in copies or phonorecords;

(2) to prepare derivative works based upon the copyrighted work;

(3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

(4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; and

(5) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly.

§ 411. Registration as prerequisite to infringement suit

(a) Subject to the provisions of subsection (b), no action for infringement of the copyright in any work shall be instituted until registration of the copyright claim has been made in accordance with this title.

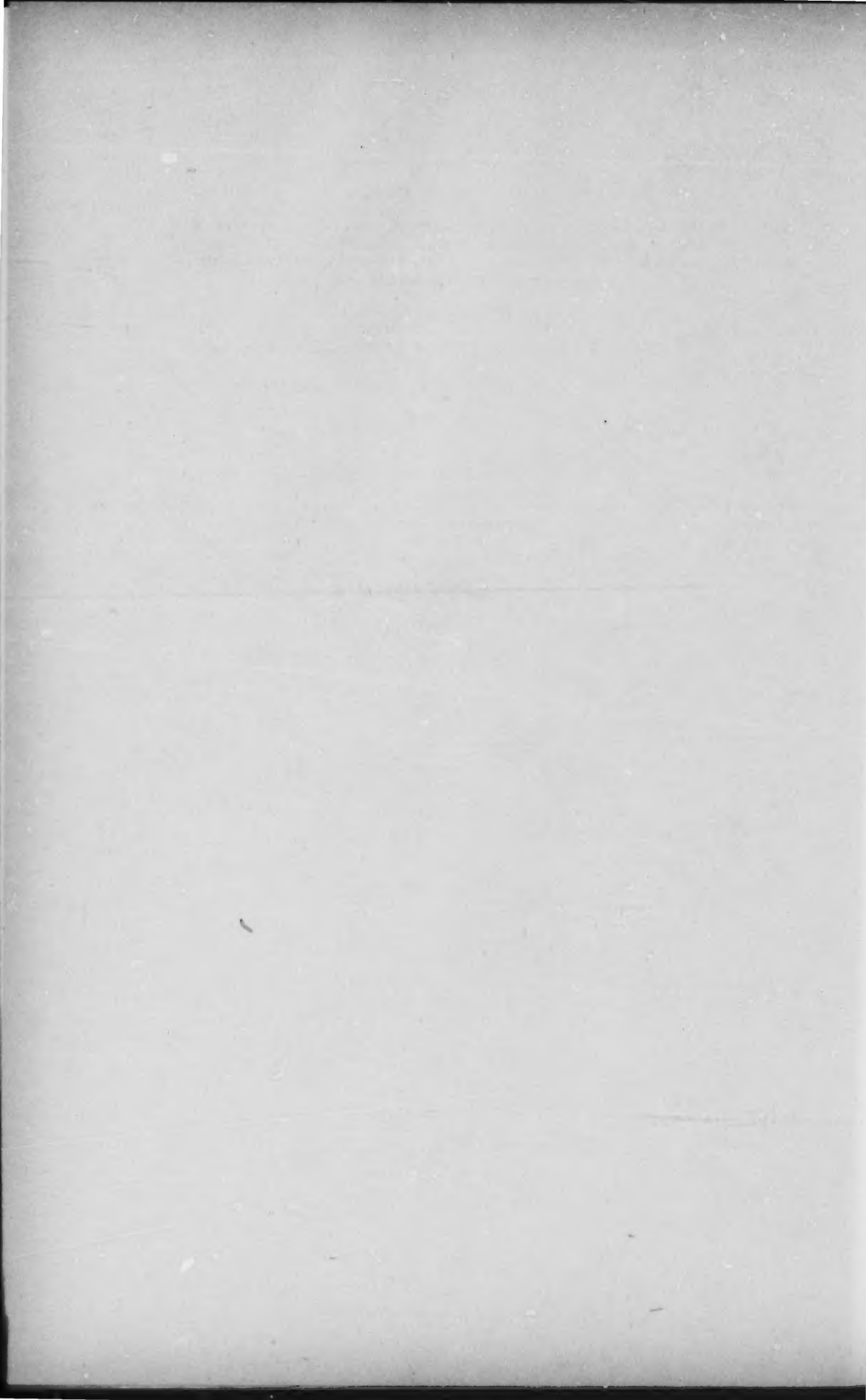
Title 17—Copyrights

§ 501. Infringement of copyright

(a) Anyone who violates any of the exclusive rights of the copyright owner as provided by sections 106 through 118, or who imports copies or phonorecords into the United States in violation of section 602, is an infringer of the copyright.



APPENDIX F



LEVEL 1 - 1 OF 2 CASES

PETER P. GARDINCHIUS, ADMINISTRATOR OF THE ESTATE OF PAUL C. GARDINCHIUS, PLAINTIFF-APPELLEE, v. BOSTON EDISON COMPANY, DEFENDANT-APPELLANT-APPELLEE, and CHARLES CONTRACTING CO., INC., DEFENDANT-APPELLANT.

No. 79-1365; No. 79-1376

United States Court of Appeals for the First Circuit

621 F.2d 1171; 29 Fed. R. Serv. 2d (Callaghan) 745

May 28, 1980

OPINION:

... special question on the degree of comparative negligence of the parties.

We start on a sour note. Most of the issues we address involve Massachusetts law, yet none of the parties has complied with our local rule 11(h), which requires that citations to state cases include the National Reporter System. Since the writing judge does not have ready access to the Massachusetts Reports, he has had to do a lot of work that is the responsibility of counsel. This comment is particularly appropriate when parties cite only the Advance Sheets

621 F.2d 1171; 29 Fed. R. Serv. 2d (Callaghan) 745

of the Massachusetts Appeals Court, which no federal judge should be expected to possess.

...

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LEVEL 1 - 1 OF 2 CASES

PETER P. GARDINCIUS, ADMINISTRATOR OF THE ESTATE OF PAUL C. GARDINCIUS, PLAINTIFF-APPELLEE, v. BOSTON EDISON COMPANY, DEFENDANT-APPELLANT-APPELLEE, and CHARLES CONTRACTING CO., INC., DEFENDANT-APPELLANT.

No. 79-1365; No. 79-1376

United States Court of Appeals For the First Circuit

421 F.2d 1171; 29 Fed. R. Serv. 2d (Callaghan) 745

May 28, 1980

OPINION:

... (1173) special question on the degree of comparative negligence of the parties.

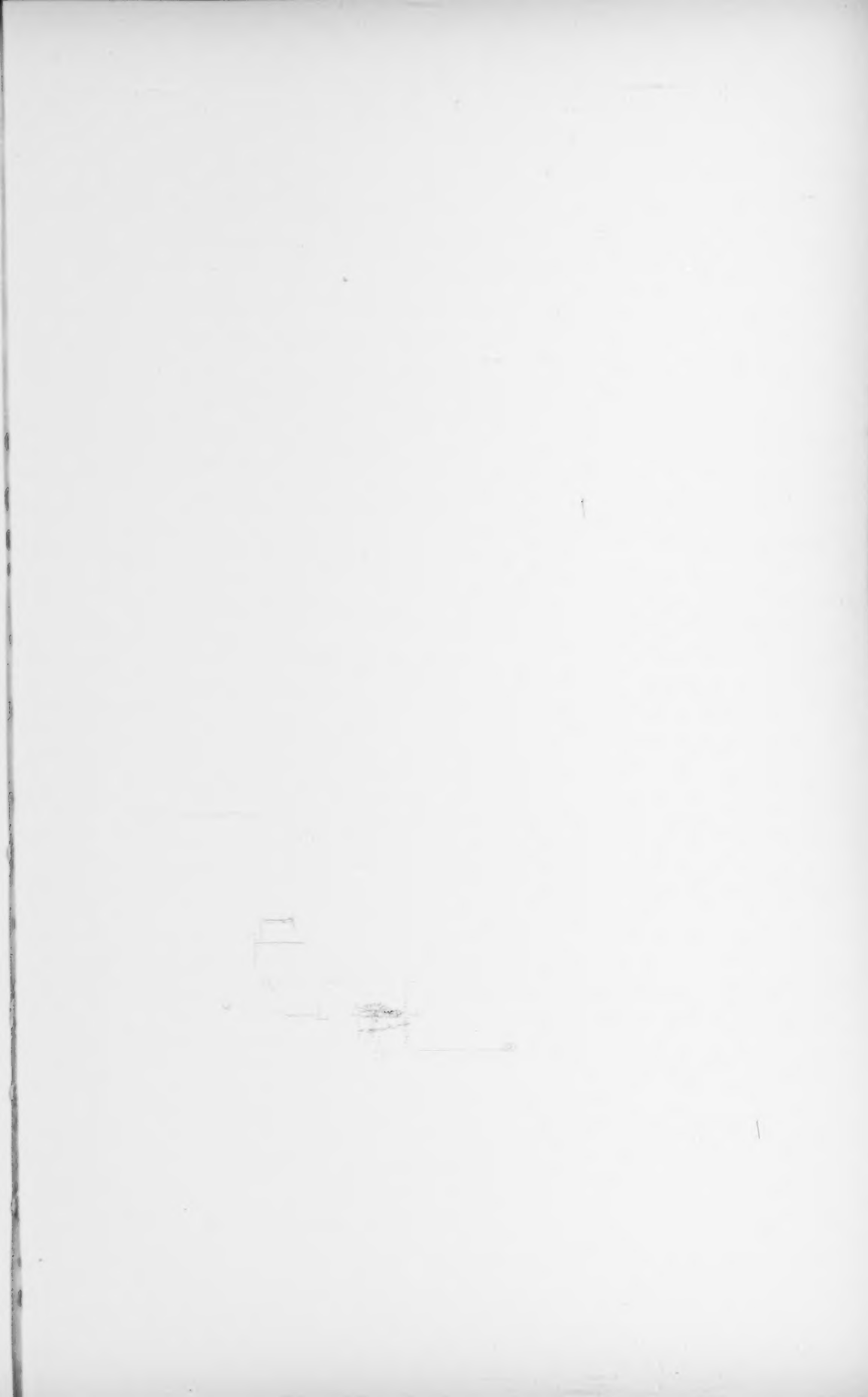
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421 F.2d 1171, 1174

responsibility of counsel. This comment is particularly appropriate when parties cite only the Advance Sheets of the Massachusetts Appeals Court, which no federal judge should be expected to possess.

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2
No. 86-891

Supreme Court, U.S.
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In the
Supreme Court of the United States
October Term, 1986

MEAD DATA CENTRAL, PETITIONER,

vs.

WEST PUBLISHING COMPANY, RESPONDENT.

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ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

=====

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BRIEF IN OPPOSITION

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December 31, 1986

Questions Presented for Review

Petitioner's star pagination will supplant the need for respondent's copyrighted case report compilations which are protected by §§ 103 and 106 of the Copyright Revision Act of 1976. Respondent sought preliminary and permanent relief from petitioner's unauthorized commercial use of respondent's arrangements of case reports in its copyrighted works. The court of appeals affirmed the district court's grant of a preliminary injunction.

The questions presented are:

1. Whether it was error to issue a preliminary injunction restraining petitioner from reproducing and displaying on LEXIS the arrangements from respondent's copyrighted case report compilations.
2. Whether respondent's arrangements within its case report compilations satisfy the standard of originality under copyright law.
3. Whether petitioner's "star pagination" in its computerized database is an infringing use of respondent's copyrighted works.

Statement Pursuant to Rule 28.1

Respondent West Publishing Company is a privately held corporation organized under the laws of the State of Minnesota. It has no parent company or affiliates. The Foundation Press, Inc. is a subsidiary of West Publishing Company which is not wholly owned.

TABLE OF CONTENTS

	Page
Questions Presented For Review	i
Statement Pursuant To Rule 28.1	ii
Table of Authorities	iv
Statement of the Case	1
A. Procedural History	2
B. Factual Background	4
ARGUMENT	6
I. The Court Of Appeals' Decision Does Not Create A Conflict In The Circuits	6
II. The Court Of Appeals' Decision Is Consistent With The Applicable Statute And Precedents Of This Court	8
A. Copyright Law Protects West's Arrangements of Case Reports	8
B. MDC's Star Pagination Infringes West's Copyrights	10
III. Review By This Court Prior To Full Development Of The Factual Record Would Be Premature	11
IV. The Issues Raised By MCD's Petition Do Not Merit This Court's Attention	12
CONCLUSION	14

TABLE OF AUTHORITIES

Cases	Page
<i>Banks Law Publishing Co. v. Lawyers Co-Operative Publishing Co.</i> , 169 F. 386 (C.C.S.D.N.Y. 1909), <i>aff'd per curiam</i> , 169 F. 391 (C.C. 2d Cir. 1909), <i>appeal dismissed per stipulation</i> , 223 U.S. 738 (1911)	3, 6, 7
<i>Brotherhood of Locomotive Firemen & Enginemen v. Bangor & Aroostook Railroad Co.</i> , 389 U.S. 327, 328 (1967)	12
<i>Callaghan v. Meyers</i> , 128 U.S. 617 (1888)	2, 8
<i>Columbia Pictures Industries, Inc. v. Aveco, Inc.</i> , 800 F.2d 59 (3d Cir. 1986)	11
<i>Dataphase Systems, Inc. v. C L Systems, Inc.</i> , 640 F.2d 109, 113 (8th Cir. 1981) (en banc)	3
<i>Harper & Row, Publishers, Inc. v. Nation Enterprises</i> , 105 S.Ct. 2218 (1985)	2, 9, 10, 11
<i>Rice v. Sioux City Memorial Park Cemetery</i> , 349 U.S. 70, 79 (1955)	13
<i>Sony Corp. of America v. Universal City Studios, Inc.</i> , 464 U.S. 417 (1984)	2, 10, 11
<i>Texas v. Mead</i> , 465 U.S. 1041 (1984)	6
<i>United States v. Johnston</i> , 268 U.S. 220, 227 (1925)	6

Statutes

Copyright Act of March 3, 1905, 33 Stat. 1000 (1905)	7
Copyright Act of 1909, 17 U.S.C. § 7 (1909)	7
Copyright Act of Revision 1976:	
17 U.S.C. § 101	2, 7, 8, 9
17 U.S.C. § 102	9
17 U.S.C. § 103	8
17 U.S.C. § 106(1)	10
17 U.S.C. § 106(5)	10
Lanham Act, 15 U.S.C. § 1125(a)	2, 12
Minnesota Deceptive Trade Practices Act, <i>Minn.</i> <i>Stat. § 325D.44</i>	2, 12
Minnesota Unlawful Trade Practices Act, <i>Minn.</i> <i>Stat. § 325D.13</i>	2, 12
Sup. Ct. R. 17.1(c)	13

Other Authorities

Final Report of the National Commission on New Technological Uses of Copyrighted Works (July 31, 1978)	10
H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 57, <i>reprinted in 1976 U.S. Code Cong. & Ad. News</i> 5659	9
H.R. Rep. No. 96-1307 Part I 96th Cong. 2d Sess. 23, <i>reprinted in 1980 U.S. Code Cong. & Ad</i> <i>News</i> 6460	10
M. Nimmer, 2 <i>Nimmer on Copyright</i> (1985)	10



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ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

BRIEF IN OPPOSITION

West Publishing Company ("West") opposes the petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Eighth Circuit on an interlocutory appeal entered in this action on September 4, 1986.

STATEMENT OF THE CASE

West commenced this action to restrain Mead Data Central, Inc. ("MDC"), both preliminarily and permanently, from copying the arrangements of case reports from West's copyrighted compilations. MDC, a major competitor, designed its star pagination to reproduce West's arrangements of case reports for MDC's LEXIS subscribers and to supplant West's copyrighted works. MDC's star pagination does not consist of copying only West's "page numbers." MDC intends to reproduce West's volume

numbers; Reporter names; the points within the text of each case report at which West begins each page of text ("page breaks"); and the numbers used to reflect each page of text. MDC intends to unite these elements with the full text of the court opinions displayed on LEXIS, thereby electronically reproducing the arrangements from West's copyrighted Reporter volumes.

The district court granted preliminary relief. On appeal, the court of appeals examined the factors it balances on a motion for a preliminary injunction and affirmed the district court's order. The court of appeals' finding that there was a substantial likelihood that West would prevail on its copyright infringement claim at trial is in accordance with the Copyright Revision Act of 1976 ("1976 Copyright Act"), 17 U.S.C. § 101 *et seq.*, and applicable decisions of this Court. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S.Ct. 2218 (1985); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984); *Callaghan v. Meyers*, 128 U.S. 617 (1888).

A. Procedural History

On July 26, 1985 West filed an eleven-count Complaint against MDC in the United States District Court, District of Minnesota, alleging causes of action under the 1976 Copyright Act, 17 U.S.C. § 101 *et seq.*; Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); the Minnesota Deceptive Trade Practices Act, *Minn. Stat.* § 325D.44; the Minnesota Unlawful Trade Practices Act, *Minn. Stat.* § 325D.13; and the common law of misappropriation and unfair competition. The Complaint sought relief from MDC's announced plan to reproduce in its LEXIS database, and to display to its LEXIS subscribers, West's arrangements of case reports from its copyrighted compilations through MDC's star pagination.¹ On August 27, 1985, West moved for a preliminary injunction

¹ West did not seek to prohibit MDC from using West's Reporter names, volume numbers and the initial page numbers, i.e., the numbers of the pages on which case reports begin. West believes the use of these aspects of its arrangements, without more, constitutes "fair use" since this use does not supplant the need for the copyrighted works.

restraining MDC from further reproduction and display of West's arrangements until a final determination on the merits of West's claims could be reached.²

The District Court (Honorable James M. Rosenbaum) issued the preliminary injunction on October 7, 1985. MDC filed an interlocutory appeal on November 1, 1985. The Eighth Circuit Court of Appeals affirmed, holding that there was a substantial likelihood that West's arrangements within its copyrighted compilations met the standard of originality required by copyright law and that MDC's star pagination infringed West's copyrights. 799 F.2d 1219, 1228 [Pet. App. A at A17].

Three aspects of the court of appeals' decision require emphasis:

1. The Eighth Circuit Court of Appeals balances four factors³ in determining whether a preliminary injunction should issue. No one factor — including likelihood of success on the merits — by itself is determinative.⁴ However, in the instant case the court of appeals, like the district court, found that on the factual record before it, *all four* factors weighed in favor of the preliminary injunction. 799 F.2d at 1229 [Pet. App. A at A19].

2. The court of appeals rejected MDC's claim that the district court's order is in conflict with the decision of the Second Circuit Court of Appeals in *Banks Law Publishing Co. v. Lawyers Co-Operative Publishing Co.*, 169 F. 386 (C.C.S.D.N.Y. 1909), *aff'd per curiam*, 169 F. 391 (C.C. 2d Cir. 1909), *appeal dismissed per stipulation*, 223 U.S. 738

² West's preliminary injunction motion was limited to the copyright infringement claim (Count I) of the Complaint.

³ The factors that the court of appeals examines are: (1) the probability that the movant will succeed on the merits; (2) the threat of irreparable harm to the movant should a preliminary injunction be denied; (3) the balance between this harm and the harm that granting the injunction will cause to the opposing party; and (4) the public interest. *Dataphase Systems, Inc. v. C L Systems, Inc.*, 640 F.2d 109, 113 (8th Cir. 1981) (en banc).

⁴ Notably, MDC does not seek review of the factors employed by the court of appeals for a preliminary injunction. Rather, MDC requests this Court to determine whether its star pagination infringes West's copyrights based on an incomplete factual record.

(1911). The court of appeals below determined that the *Banks* finding that the work was not copyrightable "was based upon the *official status* of the reporter," 799 F.2d at 1225 [Pet. App. A at A9-A10] (emphasis added), and thus factually distinguishable. The court of appeals further held that changes in both statutory and decisional copyright law since 1909 rendered the *Banks* case inapplicable to this action. 799 F.2d at 1226 [Pet. App. A at A11-A12].

3. The court of appeals explicitly and repeatedly qualified its conclusions pending further factual development at trial. "[O]ur observations as to the governing law made in this opinion, are tentative and provisional, in the sense that different findings or conclusions might be warranted after a trial on the merits." 799 F.2d at 1229 [Pet. App. A at A19] (citations omitted). Although no trial on the merits has yet occurred,⁵ MDC served West with the petition for certiorari on December 4, 1986.

B. Factual Background

West collects, compiles and publishes opinions of state and federal courts from throughout the nation in several series of volumes it calls National Reporter System publications. Before it publishes an opinion, West checks the accuracy of case and statutory citations in the opinion and adds parallel citations, prepares headnotes and a synopsis for the opinion, and arranges the text of the opinion in West's style and format. West then assigns its report of each opinion to one of the individual series in the National Reporter System, such as *Federal Reporter*, *Second Series* or *Southern Reporter*, *Second Series*; this assignment is based on the court and/or the subject matter of the opinion. Next, West assigns the case report to a volume in the series and further categorizes and arranges the case reports within each volume. For example, West

⁵ The parties stipulated to an order on September 25-26, 1985 staying all discovery during the course of any appeal from the district court's decision. Order of September 27, 1985. As a result, discovery has only recommenced in the last 90 days and is in the initial stages.

currently arranges the decisions it publishes in *Federal Reporter, Second Series* advance sheets by grouping all opinions from each circuit court of appeals together; then, within each grouping it arranges all opinions with West-supplied headnotes first, then memorandum decisions without headnotes, and finally listings of decisions rendered without published opinions. For each separate volume, West then prepares additional materials, such as indices and tables of cases. Volumes and pages are numbered sequentially to facilitate precise reference to West's case reports; citing the proper volume number, Reporter name and page number communicates the exact location of a West report, or a portion thereof, within the National Reporter System. Upon publication of each volume, West registers its copyright claim with the Register of Copyrights and receives a Certificate of Registration for the volume.

Although MDC currently displays on LEXIS the West citations (*i.e.*, volume numbers, Reporter names and page numbers on which case reports begin),⁶ it does not employ any arrangement of its own which is useful for citation purposes.⁷ On June 24, 1985 MDC announced that by the end of September, 1985 it would add star pagination to the text of federal judicial opinions stored in the LEXIS database. (Answer ¶¶ 15 and 16). MDC admits this would consist of copying each and every page break and page number from West's reports in *Federal Reporter*, *Federal Reporter, Second Series*, *Federal Supplement*, *Federal Rules Decisions* and *United States Claims Court Reporter* and incorporating these page breaks and page numbers within the text of LEXIS reports. (Answer

⁶ MDC's star pagination is unlike mere citation to West case reports in several important respects: (1) MDC's star pagination encompasses the total of *all* page numbers of West's Reporter volumes; citation involves far less than the total; (2) star pagination, unlike citation, marks the page *break* for each and every page of text; (3) star pagination, unlike citation, is used in conjunction with the entire text of court opinions; and (4) most importantly, star pagination supplants the need for West's Reporters.

⁷ Obviously, MDC could easily do so. For example, it could number the paragraphs or the screens of its case reports; either would provide its subscribers with a detailed citation method.

¶¶ 15 and 16). As a result of this copying, MDC will be able to display and print for its subscribers West's sequencing of case reports. It is MDC's stated belief that doing so will increase "the number of LEXIS users, the use of LEXIS and the revenues MDC derives therefrom." (Answer ¶¶ 18 and 62). MDC also admits that incorporating West's page breaks and pagination within the text of LEXIS reports will in some instances completely replace the use of West's Reporters. (Transcript of Hearing on September 17, 1985 at pp. 72-73.)

ARGUMENT

A writ of certiorari is unwarranted. The court of appeals' decision merely affirms an interlocutory order for a preliminary injunction based upon tentative conclusions of law subject to modification upon further factual findings. Moreover, the court of appeals' application of law to the specific and unusual facts presented is entirely consistent with the language of the statutory provisions at issue and established precedents of this Court. Even after a full trial, this Court does not issue a writ of "certiorari to review evidence and discuss specific facts." *United States v. Johnston*, 268 U.S. 220, 227 (1925); *Texas v. Mead*, 465 U.S. 1041 (1984). In any event, there is no conflict between the decisions below and any decision of this Court or any other court of appeals.

I. The Court Of Appeals' Decision Does Not Create A Conflict In The Circuits.

Key factual differences and congressional revisions of the Copyright Act distinguish the court of appeals' decision at issue from the Second Circuit Court of Appeals' decision in *Bank's Law Publishing Co.*, *supra*. The court of appeals below held that there was a substantial likelihood that West's arrangements within its compilations of case reports are original; the court thus concluded they are protected by the 1976 Copyright Act. 799 F.2d at 1227 [Pet. App. A at A14]. This conclusion followed from a critical

factual finding — a finding of originality — which is fact specific and unique to each copyright claim.

The plaintiff in *Banks*, on the other hand, failed to establish that his arrangements of case reports were original. The *Banks* court held that the plaintiff, as an *official reporter*, had not exercised sufficient originality in his arrangements of case reports, beyond his statutory obligations, to obtain copyright protection. 169 F. at 389-390. Unlike the arrangement of case reports at issue in *Banks*, West's arrangements within its National Reporter System publications are not dictated by contract or statute.⁸ They are original to West. The different outcomes in *Banks* and this case are thus a result of the different sets of *facts* presented to the courts; no conflict of law exists.

In addition, major revisions of the Copyright Act in 1909 and 1976 explicitly enlarged the scope of copyright protection. Significantly, the statute in effect at the time of the *Banks* decision did not expressly provide copyright protection for either compilations or arrangements. Act of March 3, 1905 Ch. 1432, Pub. L. No. 58-165, 33 Stat. 1000 (1905) (repealed 1909). Four months after the *Banks* decision, Congress codified copyright protection for compilations. 17 U.S.C. § 7 (1909) [effective July 1, 1909]. The most recent comprehensive revision of statutory copyright law occurred in 1976. In the 1976 revisions, Congress specifically declared copyrightable an author's original efforts in selecting, coordinating and arranging preexisting materials.⁹ The *Banks* court interpreted and applied a statute repealed in 1909. The court of appeals below interpreted and applied the provisions of a *different* statute — a statute enacted in 1976.

⁸ Of course, there is no evidence that West is, or ever was, the official reporter for the federal courts. The evidence presented below reveals only *one* instance, in 1894, where West indicated that it was the official reporter for the federal courts.

⁹ The 1976 Copyright Act defines a compilation as:

A work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

17 U.S.C. § 101.

Because of the critical factual differences in this case and congressional changes in copyright law, the 1909 *Banks* decision is not controlling in the resolution of the issues presented by West's motion for a preliminary injunction. No conflict was, or could be, created by the court of appeals' decision under current law.

II. The Court Of Appeals' Decision Is Consistent With The Applicable Statute And Precedents Of This Court.

The court of appeals held that, under the 1976 Copyright Act, West's original case report compilations are copyrightable. 799 F.2d at 1223-1224 [Pet. App. A at A6-A7]. The court below further held that MDC's star pagination would infringe West's copyrights.¹⁰ 799 F.2d at 1228 [Pet. App. A at A17]. The 1976 Copyright Act and precedents of this Court support the court of appeals' conclusions.

A. Copyright Law Protects West's Arrangements of Case Reports.

The copyright statute provides protection for compilations. 17 U.S.C. § 103. The 1976 Copyright Act definition of a compilation explicitly recognizes an author's efforts in selecting, coordinating and arranging preexisting materials. 17 U.S.C. § 101. Original compilations of case reports are no exception. This Court long ago noted:

Such work of the reporter, which may be the lawful subject of copyright, comprehends also the order of arrangement of the cases, the division of the reports into volumes, the numbering and paging of the volumes. . . .

Callaghan, supra, 128 U.S. at 649. Rather than departing from traditional standards, the court of appeals' decision is

¹⁰ MDC's claim that publishers of case reports traditionally star paginate to parallel sets of reports fails to note that publishers have traditionally star paginated to the *official reports*, not to unofficial reports of private publishers.

thus in harmony with the text of the 1976 Copyright Act and fundamental principles of copyright law established by this Court.

The copyright statute protects any expression original to the author once it is fixed in a tangible medium. 17 U.S.C. § 102. The definition of "literary works" makes clear that the *form* of an author's copyrightable expression is unlimited, provided it is both fixed and original. 17 U.S.C. § 101. It "does not connote any criterion of literary merit or qualitative value: it includes catalogs, directories and similar factual, reference or instructional works and compilations of data." H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 57, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5667. As this Court recently noted, "[c]reation of a non-fiction work, even a compilation of pure fact, entails originality." *Harper & Row, Publishers, Inc., supra*, 105 S.Ct. at 2224. West's compilations — embracing its sequencing and pagination of case reports — are thus copyrightable "literary works" within the definition of the 1976 Copyright Act.

MDC's contention that West's "page numbers"¹¹ are uncopyrightable misapprehends the expression the court of appeals held was protected by copyright law. The letters of the alphabet or specific words, like page numbers, cannot be copyrighted. 17 U.S.C. § 102. But when an author combines numbers, letters or words in a manner that reflects an original work of authorship, they constitute copyrightable expression. *Id.* Thus, the issue is whether MDC is reproducing West's copyrightable expression — its original arrangements of case reports — not whether individual page numbers are copyrightable.

¹¹The terms of the injunction belie MDC's claim that the issue is the copyrightability of "page numbers". MDC is free to list West's page numbers *apart from* the text of the opinions. The injunction simply prohibits MDC from using West's page numbers "within or in relation to the text of court opinions contained in the LEXIS database." Modified Order for Preliminary Injunction (Pet. App. D at D2).

B. MDC's Star Pagination Infringes West's Copyrights.

Modern copyright law supports the court of appeals' conclusion that MDC's star pagination is likely to infringe West's copyrights. The statute reserves to West, the copyright owner, the exclusive right "to reproduce the copyrighted work in copies. . . ." 17 U.S.C. § 106(1). The statutory definition of a "copy" under the 1976 Copyright Act, 17 U.S.C. § 101, makes clear that the act of *inputting* a copyrighted work into a computer database, in and of itself, constitutes copyright infringement. M. Nimmer, 2 *Nimmer on Copyright* § 8.08 at 8-104 (1985); Final Report of the National Commission on New Technological Uses of Copyrighted Works at p. 12 (July 31, 1978).¹² The statute also explicitly reserves to West the right to display its copyrighted works publicly.¹³ 17 U.S.C. § 106(5).

The result of MDC's star pagination is a complete reproduction of West's ordering of its case reports. It is not, as MDC contends, mere "citation to" West's publications. It is not an isolated use of West's copyrighted compilations. It is the wholesale appropriation of every aspect of West's arrangements of case reports. It is " 'a major inroad on copyright that must be prevented.' " *Harper & Row, Publishers, Inc., supra*, 105 S.Ct. at 2235 (quoting S. Rep. No. 94-473, 94th Cong., 1st Sess. at 65 (1975)).

MDC's characterization of LEXIS as a "service" to the public which imparts "knowledge" does not change the nature of the infringement. "[A]ny copyright infringer may claim to benefit the public by increasing public access to

¹² The Commission's recommendations were accepted by Congress (See H.R. Rep. No. 96-1307 Part I 96th Cong. 2d Sess. 23 reprinted in 1980 U.S. Cong. & Ad. News 6460, 6482) resulting in enactment of the "Computer Software Copyright Act of 1980," Act of December 12, 1980, Pub. L. No. 96-517.

¹³ Unlike the principal defendants in *Sony Corp. of America, supra*, MDC is not being charged as a vicarious infringer by virtue of simply supplying a machine used by another for infringing purposes. Here, MDC is a direct infringer in two respects: (1) it has reproduced West's arrangements in a computer database; and (2) it intends to display West's arrangements from its copyrighted works publicly. 17 U.S.C. § 106(1) and (5).

the copyrighted work." *Harper & Row, Publishers, Inc.*, *supra*, 105 S.Ct. at 2235. Significantly, this case does not involve restrictions on access to judicial opinions or statutes themselves. The preliminary injunction does not prevent MDC from continuing to disseminate its LEXIS case reports as it has since 1973, or otherwise restrict MDC's display of judicial or legislative materials. Rather, the district court's order only prevents MDC from reproducing and displaying West's particular arrangements of case reports.¹⁴

Finally, the claim that the public importance of West's arrangements should result in reduction or elimination of the exclusive rights normally granted by copyright law was recently rejected by this Court. *Harper & Row, Publishers, Inc.*, *supra*, 105 S.Ct. at 2230. Rather, this Court reemphasized its holding in *Sony Corp. of America*, *supra*, that "every commercial use of copyrighted material is presumptively an unfair exploitation. . . ." *Harper & Row Publisher, Inc.*, *supra*, 105 S.Ct. at 2231 (citations omitted). Thus, the 1976 Copyright Act and recent decisions of this Court provide strong support for the court of appeals' conclusion that West has a substantial likelihood of succeeding on its copyright infringement claim.

III. Review By This Court Prior To Full Development Of The Factual Record Would Be Premature.

The court of appeals affirmed the district court's grant of a *preliminary* injunction. The court of appeals explicitly set forth the conditional nature of its decision. "[O]ur observations as to the governing law made in this opinion, are tentative and provisional, in the sense that *different findings or conclusions might be warranted after a trial on the merits.*" 799 F.2d at 1229 [Pet. App. A at A19] (emphasis added) (citations omitted).

¹⁴ The fact that MDC employed technological innovations to infringe West's copyrights does not justify the infringement. Courts have always been quick to proscribe new ways of infringing copyrights. See *Columbia Pictures Industries, Inc. v. Aveco, Inc.*, 800 F.2d 59 (3d Cir. 1986).

Numerous facts which may be critical to the outcome were not developed prior to the district court's order. These facts relate to such matters as the method by which West gathers, edits, assigns and sequences its case reports, and the method by which MDC intends to reproduce and display West's arrangements in its database.¹⁵ No documents were produced by either side prior to the district court hearing, nor were any depositions taken. Because a final judgment has not been entered, this case "is not yet ripe for review by this Court." *Brotherhood of Locomotive Firemen & Enginemen v. Bangor & Aroostook Railroad Co.*, 389 U.S. 327, 328 (1967).

Further, West's Complaint alleges additional causes of action under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); the Minnesota Deceptive Trade Practices Act, *Minn. Stat.* § 325D.44; the Minnesota Unlawful Trade Practices Act, *Minn. Stat.* § 325D.13; and the common law of misappropriation and unfair competition. West limited its preliminary injunction motion, however, to the copyright infringement claim of its Complaint. Thus, the court of appeals rendered no opinion, tentative or otherwise, on the remaining ten counts of the Complaint. The issues presented by MDC's petition may well become moot after a full trial on all counts of the Complaint. In any event, a trial on the merits will generate a complete record upon which the lower courts, and possibly this Court, may make final determinations on the controlling legal issues.

IV. The Issues Raised By MDC's Petition Do Not Merit This Court's Attention.

Not surprisingly, no decision addressing the issue of star pagination of judicial opinions was reported between the *Banks* decision in 1909 and the district court's decision

¹⁵ For example, on appeal to the court below MDC consistently denied that its star pagination would permit a LEXIS user to retrieve, display or print cases in the sequence or order in which West arranges them in volumes. Brief for Appellant at p. 38-39; Reply Brief for Appellant at pp. 12 n.8, 17. Yet, at oral argument, MDC conceded its star pagination *would* permit the LEXIS user to page through each case and successive cases utilizing West's sequencing. 799 F.2d at 1227 [Pet. App. A at A14].

below in 1985. The reason is not difficult to discern. The issues raised by MDC's petition affect a minute segment of society — private publishers of case reports. Unlike MDC, those private publishers such as Commerce Clearing House, Lawyers Co-Operative Publishing Company, Prentice-Hall, the Bureau of National Affairs, Callaghan & Company and others have developed and utilized their own arrangements of case reports.

One of the considerations established by this Court governing review on certiorari is whether "a federal court of appeals has decided an important question of federal law which has not been, but should be, settled by this Court..." Sup. Ct. R. 17.1(c). Importance is measured by the impact of the decision on the public "as distinguished from that of the parties." *Rice v. Sioux City Memorial Park Cemetery*, 349 U.S. 70, 79 (1955). This Court has stated:

A federal question raised by a petitioner may be 'of substance' in the sense that, abstractly considered, it may present an intellectually interesting and solid problem. But this Court does not sit to satisfy a scholarly interest in such issues. Nor does it sit for the benefit of the particular litigants.

Id. at 74.

While the issues presented by MDC's petition are significant to the parties and possibly interesting to lawyers, the outcome has virtually no impact on non-parties or the public at large. Moreover, MDC's claimed success with its LEXIS service over the last 13 years demonstrates its ability to offer an electronic, competitive alternative to traditional hard copy publications. Review by this Court of the interlocutory decision of the court of appeals is thus unwarranted.

CONCLUSION

Based on the foregoing, the petition for a writ of certiorari should be denied.

Respectfully submitted,

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OCTOBER TERM, 1986

MEAD DATA CENTRAL, INC.,

Petitioner,

—against—

WEST PUBLISHING COMPANY,

Respondent.

PETITIONER'S REPLY BRIEF

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TABLE OF CONTENTS

	PAGE
I. The Court of Appeals' Decision Is Ripe for Review on the Present Record.	5
II. The Court of Appeals' Decision Conflicts With Applicable Decisions of This Court.	6
III. The Court of Appeals' Decision Conflicts With a Decision of the Second Circuit on the Identical Question.	7
IV. The Issues Presented by MDC's Petition Are of General and Public Importance.	9
CONCLUSION	10

TABLE OF AUTHORITIES

	PAGE
<i>Cases</i>	
<i>Banks Law Publishing Co. v. Lawyers' Co-Operative Publishing Co.</i> , 169 F. 369 (2d Cir. 1909), appeal dismissed, 223 U.S. 738 (1911)	7, 8, 9
<i>Callaghan v. Myers</i> , 128 U.S. 617 (1888)	9
<i>Harper & Row, Publishers, Inc. v. Nation Enterprises</i> , 105 S. Ct. 2218 (1985)	7
<i>Sony Corp. v. Universal City Studios, Inc.</i> , 464 U.S. 417 (1984)	7
<i>Twentieth Century Music Corp. v. Aiken</i> , 422 U.S. 151 (1975)	7
<i>United States v. General Motors Corp.</i> , 323 U.S. 373 (1944)	6
<i>Statutes</i>	
17 U.S.C. § 106	6, 7
<i>Other Authorities</i>	
W. Patry, <i>Latman's The Copyright Law</i> (6th ed. 1986)	1-2, 4

IN THE
Supreme Court of the United States

October Term, 1986

No. 86-891

MEAD DATA CENTRAL, INC.,

Petitioner,

—against—

WEST PUBLISHING COMPANY,

Respondent.

PETITIONER'S REPLY BRIEF

West's Brief in Opposition understandably fails to defend—or even to mention—the actual holdings of the courts below. West has nothing to say in defense of the District Court's holding that “page numbers themselves are protected by copyright,” 616 F. Supp. at 1579 [Appendix C at C11], or the Court of Appeals majority's altogether different holdings that “jump cites” are infringing because they impart “knowledge” of where specific portions of judicial opinions can be found, or because readers might use them to deduce the sequence of opinions in published volumes. 799 F.2d at 1227-28 [Appendix A at A15].

Because the holdings below are so obviously wrong and constitute “a most extreme misreading” of the law of copyright, W. Patry, *Latman's The Copyright Law* 63 n.212

(6th ed. 1986),¹ West does not even argue their correctness here. Instead, by means of misstatement and incorrect paraphrasing, West attempts to make this case appear to involve ordinary and different issues than were actually presented and decided below.

West's attempted recasting of this case can be appreciated by comparing West's Brief in Opposition with the corresponding portions of the record:

West's Brief in Opposition

"The Complaint sought relief from MDC's announced plan to reproduce . . . West's *arrangements*. . . ." (West Br. at 2) (emphasis added).

Record

"The *page numbers* contained in each volume of West's National Reporter System publications are a material and substantial portion thereof. . . .

. . . MDC's intended use of West's *page numbers* will constitute copyright infringement" (Complaint ¶¶ 27, 28) (emphasis added).

* * *

* * *

¹ Referring to the District Court's decision in this case, Mr. Patry continues:

Contrary to this decision, there is no copyrightable interest in the pagination of plaintiff's reporters. The numbering of the pages is a purely mechanical process dictated entirely by the format. There is no "collection and assembling of pre-existing materials or data," and there is no selection, coordination, or arrangement of any such material.

W. Patry, Latman's The Copyright Law 63 n.212 (6th ed. 1986).

West's Brief in Opposition

"West moved for a preliminary injunction restraining MDC from further reproduction and display of West's *arrangements . . .*" (West Br. at 2-3).

Record

"PLEASE TAKE NOTICE that . . . [West] will move the Court for a preliminary injunction enjoining [MDC] . . . from displaying, referencing or including the *page numbers* of plaintiff's National Reporter System publications . . . within or in relation to the text of court opinions in . . . LEXIS" (Notice of Motion dated August 27, 1985) (emphasis added).

* * *

* * *

"[T]he district court's order only prevents MDC from reproducing and displaying West's particular *arrangements . . .*" (West Br. at 11) (emphasis added).

"IT IS HEREBY ORDERED that defendant . . . [is] preliminarily enjoined from displaying, referencing or including the *page numbers* of [West publications] . . . within or in relation to the text of court opinions. . . ." (Appendix D at D2) (emphasis added).

* * *

* * *

*West's Brief in Opposition**Record*

"[T]he issue is whether MDC is reproducing West's . . . *arrangements* of case reports" (West Br. at 9) (emphasis added).

"[T]his case turns on whether or not the succeeding *page numbers* themselves are protected by copyright." 616 F. Supp. at 1579 [Appendix C at C11]; 799 F.2d at 1236 [Appendix B at B15] (Oliver, J., dissenting) (emphasis added).

* * *

* * *

"MDC's contention that West's 'page numbers' are uncopyrightable misapprehends the *expression* the Court of Appeals held was *protected* by copyright law" (West Br. at 9) (emphasis added).

"[T]he specific goal of this suit is to *protect* some of West's *page numbers*, those occurring within the body of individual court opinions." 799 F.2d at 1227 [Appendix A at A13] (emphasis added).

West's protestations to this Court notwithstanding, the purported "arrangements" of opinions in West publications have nothing to do with this case. While original "arranging" activity may, in appropriate circumstances, be protected by copyright,

this was *not* the activity [West] sought to protect. Rather, [West] claimed an interest in the mechanical process of assigning page numbers to the compilation *after* it was created. W. Patry, Latman's The Copyright Law 63 n.212 (6th ed. 1986) (emphasis in original).

Reflecting this fact, the preliminary injunction in this case does not even mention any purported "arrangements" in West publications (see Appendix D).

The very nature of star pagination, furthermore, demonstrates that it involves no “reproduction” or “display” of how cited sources may be “arranged.” Both *Lawyers’ Edition* (“L. Ed.”) and *Supreme Court Reporter* (“Sup. Ct.”) volumes star paginate to *U.S. Reports* (“U.S.”), yet the “arrangement” of opinions in L. Ed. and Sup. Ct. volumes, as the Court is doubtless aware, bears no similarity whatever to that in U.S. volumes. Similarly, the LEXIS Star Pagination Feature would not change at all the way in which opinions are now reported and “arranged” in LEXIS, which “arrangement” bears no similarity whatever to that in any West publication. The only change would be the addition of jump cite references to the page numbers of published sources, as shown in Appendix F to MDC’s petition.

When the issue that was actually presented and ruled on below—“MDC’s proposed use of West page numbers,” 799 F.2d at 1227 [Appendix A at A14]—is kept in mind, the basis for West’s opposition to certiorari evaporates. There is no dispute about the nature or uses of star pagination, the decisions below clearly conflict with applicable decisions of this Court and of the Second Circuit, and the importance of star pagination to the legal profession is beyond doubt.

I.

The Court of Appeals’ Decision Is Ripe for Review on the Present Record.

With the LEXIS Star Pagination Feature, “MDC intends to do no more than what other law book publishers have been doing for a long, long period of time.” 799 F.2d at 1235 [Appendix B at B13] (Oliver, J., dissenting). The

nature of star pagination—how it works and what it does—is familiar to every lawyer, and has been in common use in this country for more than 100 years. Neither the District Court nor the Court of Appeals had the slightest difficulty understanding “MDC’s proposed use of West page numbers.” 799 F.2d at 1227 [Appendix A at A14]. West’s suggestion that there are undeveloped “facts” which “may” bear on how star pagination “uses” page numbers (West Br. at 12) is, at best, baseless speculation.

Review now by this Court is essential, not only because of the importance of this case to the legal profession, but because the holdings below are “fundamental to the further conduct of the case.” *United States v. General Motors Corp.*, 323 U.S. 373, 377 (1944). Absent this Court’s timely intervention, the parties will be required to spend what may be years litigating, at enormous cost to themselves and the judicial system, issues such as West’s purported “arranging” activity over a 75-year period which have no relevance to this case under a proper view of the law. The legal issues presented in MDC’s petition are dispositive of the copyright claims in this case, and can and should be decided now.

II.

The Court of Appeals’ Decision Conflicts With Applicable Decisions of This Court.

As MDC has previously shown, the Court of Appeals majority wrongly extended copyright protection to bar use of uncopyrighted matter, and did so even though the Copyright Act of 1976 confers upon authors no exclusive right to make “jump cites,” to make “references,” to impart “knowledge of the location” of published matter, or any remotely analogous rights. *See* 17 U.S.C. § 106 [Appendix E at E4].

The lower courts' injunction against "MDC's proposed use of West page numbers," 799 F.2d at 1227 [Appendix A at A14], plainly conflicts with applicable decisions of this Court. West now concedes that "page numbers, cannot be copyrighted" (West Br. at 9). Under this Court's decision in *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S. Ct. 2218 (1985), it is settled that "copyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original." *Id.* at 2224. West's Brief in Opposition does not dispute, but simply disregards this principle and its applicability to uncopyrighted page numbers.

West's assertion that "star pagination supplants the need for West's reporters" (West Br. at 5 n.6) similarly ignores that copyright protection does not extend to "constituent elements" of a work "that are not original," *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S. Ct. 2218, 2224 (1985), and does not prohibit uses which are not exclusively reserved to authors under 17 U.S.C. § 106 (1982) [Appendix E at E4]. If star pagination or any other "unlicensed use of a copyrighted work does not conflict with an 'exclusive' right conferred by the [copyright] statute, it is no infringement of the holder's rights." *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 155 (1975). *Accord Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 433 (1984).

III.

The Court of Appeals' Decision Conflicts With a Decision of the Second Circuit on the Identical Question.

The conflict between *Banks Law Publishing Co. v. Lawyers' Co-Operative Publishing Co.*, 169 F. 369 (2d Cir. 1909), appeal dismissed, 223 U.S. 738 (1911), in which

star pagination was held *not* to be an infringement of copyright, and the majority opinion below, which held that star pagination *would be* an infringement of copyright, could hardly be more obvious. The Second Circuit in *Banks* held that the page numbers of the plaintiff's volumes were not an "original" element thereof, and the majority below reached the same conclusion. But unlike the majority below, the Second Circuit in *Banks* correctly held that star page references to uncopyrighted page numbers could not be an infringement of copyright, even though the defendant's reporting of opinions with star paging undoubtedly "supplanted" sales of the plaintiff's reports.²

West wrongly asserts (West Br. at 7) that the outcome in *Banks* was somehow affected by the plaintiff's "official" status, and by a supposed absence in 1909 of copyright protection for compilations. Both assertions are specious.

It was undisputed in *Banks* that the plaintiff's volumes—in which federal statutory copyright had been registered and perfected—were protected by copyright; the only issue was whether, as in this case, the plaintiff's copyright claims extended to page numbers. The outcome in *Banks* was determined, not by any lack of statutory protection for compilations, but by the lack of any creative intellectual labor behind "such details" as page numbers. 169 F. at 391.

The Second Circuit in *Banks* also considered, and expressly *rejected*, the theory (put forward by West here) that the plaintiff's "official" status in that case operated to preclude a finding of infringement. Contrary to West's mischaracterization, the Second Circuit in *Banks* held that

² "[O]n the facts in *Banks*, the purchase of defendant's 'L.Ed.' because of defendant's use of star pagination, completely eliminated the need to purchase any of plaintiff's 'U.S.' reports." 799 F.2d at 1245 [Appendix B at B36] (Oliver, J., dissenting).

official reporters, no less than unofficial reporters, are entitled to copyright protection for their original writings, *see* 169 F. at 388; *accord* *Callaghan v. Myers*, 128 U.S. 617, 647 (1888), but that sequential page numbers are not “original” in the copyright sense. Judicial notice can be taken that “official” reports of opinions—such as N.Y.2d, Cal. 3d, and U.S. App. D.C.—bear copyright notices and are registered with the Copyright Office, notwithstanding their publishers’ “official” status.

IV.

The Issues Presented in MDC’s Petition Are of General and Public Importance.

West asserts that the outcome of this case “has virtually no impact on non-parties or the public at large” (West Br. at 13). The assertion is patently untrue. The preliminary injunction in this case affects the way in which the entire legal profession can conduct legal research, and has deprived a substantial segment of the public—including all those who cannot afford or who have no room for thousands and thousands of books—of the ability to comprehend or to make jump citations to published judicial opinions, or to comply with court rules and conventions which require jump citations to opinions as reported in West publications.

The importance of star pagination to the legal profession is beyond doubt. It is demonstrated by its appearance in thousands upon thousands of West and non-West reports of opinions spanning more than 100 years. To ban star pagination is to deprive the profession and the public of an important means of access to judicial opinions and, in this case, of an important technological achievement. The lower courts have acted to restrain effective competition between MDC and West, to block off public access to public domain material, and to force the legal profession

—as a condition of being able to cite case law authorities in accordance with court rules and universal custom—to deal with a copyright monopolist and pay whatever tribute West may choose to exact for the privilege.

This case, in short, clearly raises issues of general and public importance which merit immediate review by this Court.

CONCLUSION

For the reasons set forth above and in MDC's original petition, a writ of certiorari should issue to review the judgment of the Court of Appeals for the Eighth Circuit.

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January 9, 1987



5
No. 86-891

Supreme Court, U.S.

FILED

JAN 21 1987

JOSEPH E. SPANIOL, JR.
CLERK

In the
Supreme Court of the United States
October Term, 1986

MEAD DATA CENTRAL, INC., PETITIONER,

vs.

WEST PUBLISHING COMPANY, RESPONDENT.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

BRIEF IN OPPOSITION TO MOTION
FOR LEAVE TO FILE BRIEF AMICUS CURIAE

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DIANE M. HELLAND

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OPPERMAN & PAQUIN

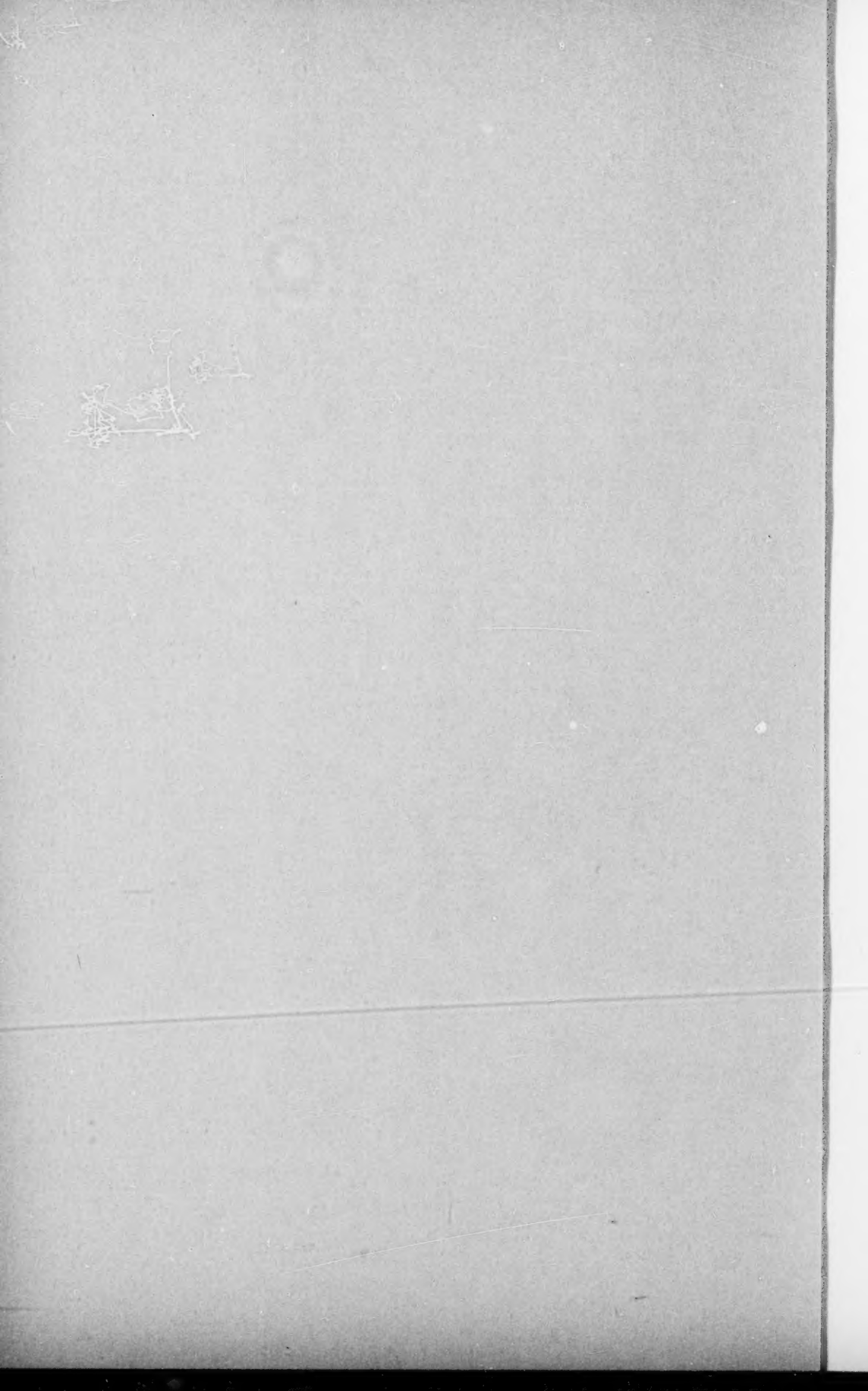
2200 Washington Square

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(612) 339-6900

January 22, 1987



West Publishing Company ("West")¹ emphatically opposes The Lawyers Co-operative Publishing Company's ("LCP") untimely "Motion for Leave to File Brief and Brief Amicus Curiae" filed January 15, 1987. Further, while it would be inappropriate for West to address the numerous distortions, material omissions and outright misstatements contained in the proposed brief itself, West notes and strongly objects to LCP's failure to disclose its affiliation and close economic association with the petitioner, Mead Data Central, Inc. ("MDC").²

West opposes LCP's Motion for Leave to File Brief on the following four grounds:

I. Both the motion and proposed brief were submitted in direct violation of this Court's Rule 36.1, twelve days *after* the rules required Respondent's Brief in Opposition to be submitted. Supreme Court Rule 36.1 clearly provides that a proposed *amicus curiae* brief as well as motion for leave to file it must be submitted "within the time allowed for filing of the . . . brief in opposition." Neither was.

¹ Respondent West Publishing Company is a privately held corporation organized under the laws of the State of Minnesota. It has no parent company or affiliates. The Foundation Press, Inc. is a subsidiary of West Publishing Company which is not wholly owned.

² On information and belief, LCP and MDC are partners or joint venturers in, among other ventures, Veracorp., the supplier of serveral computer-assisted legal research services, including Veralex. A skeptic might conclude that LCP's proposed brief is no more than an attempt by its "partner," MDC, to submit yet another reply brief of its own.



II. LCP's motion was not accompanied by West's written consent as favored by Rule 36.1. In fact, when LCP sought West's consent on January 15, 1987, West expressly refused. "A motion for leave to file such a brief when consent has been refused is not favored."³ Sup. Ct. R. 36.1

III. LCP failed to make a timely motion for an extension of time in which to file the instant motion and proposed brief. Sup. Ct. R. 29.2. LCP does not suggest any valid reason for this failure but lamely offers that it "did not trouble you with an earlier application for extension of time, which might have turned out to be moot." (Letter of Mr. Cumming to Mr. Stevas, January 15, 1987, p. 2) While LCP's motive—to spare the Court "trouble"—may be admirable, its sincerity is questionable. Moreover, the only conceivable basis upon which the request would have "turned out to be moot" was if West—in an astonishing reversal of the conventional posture of a respondent—had joined its adversary, MDC, in supporting the Petition for a Writ of Certiorari. This did not happen. Ordinary foresight could have predicted it.

³ With advance notice West might have consented to a well-reasoned brief that provided new views, insight, or perspective on the issues. LCP's tardy effort is not that; it is, rather, a repackaging of its "partner" MDC's shop-worn arguments and adds nothing except invective. Why LCP's counsel was unable to contact West's counsel to seek its consent sometime during the six weeks preceding January 15 is a mystery. The offices of Opperman & Paquin were open during regular business hours, at a minimum, for that entire period. At least one of the attorneys identified as counsel for respondent was available at all times.

IV. LCP offers no reason for the delay in filing the instant motion and proposed brief, except to say that until it received West's Brief in Opposition on January 9 (more than a week after it was submitted) it did not know whether it should seek to file an *amicus* brief or, if so, what it should say. Motion for Leave to File Brief, p. 3. In effect, LCP is requesting the right to file a reply brief—albeit a tardy one, even for a reply.⁴ In adopting its rules, this Court must have considered that many, if not most, would-be *amici* would like to submit briefs in the nature of reply briefs. Nonetheless, the Court chose not to provide such a privilege. See Sup. Ct. R. 36.1. Where this Court has clearly chosen to deny *amici* the privilege of submitting reply briefs, LCP should not be allowed to achieve—through sheer tardiness—the precise result the Court has chosen to deny.

For all of these reasons West opposes LCP's untimely Motion for Leave to File Brief.

Respectfully submitted,

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January 22, 1987

⁴ MDC filed the real Petitioner's Reply Brief on January 9, 1987.

MOTION FILED
JAN 15 1987

No. 86-891

4

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1986

MEAD DATA CENTRAL, INC.,
Petitioner,

VS.

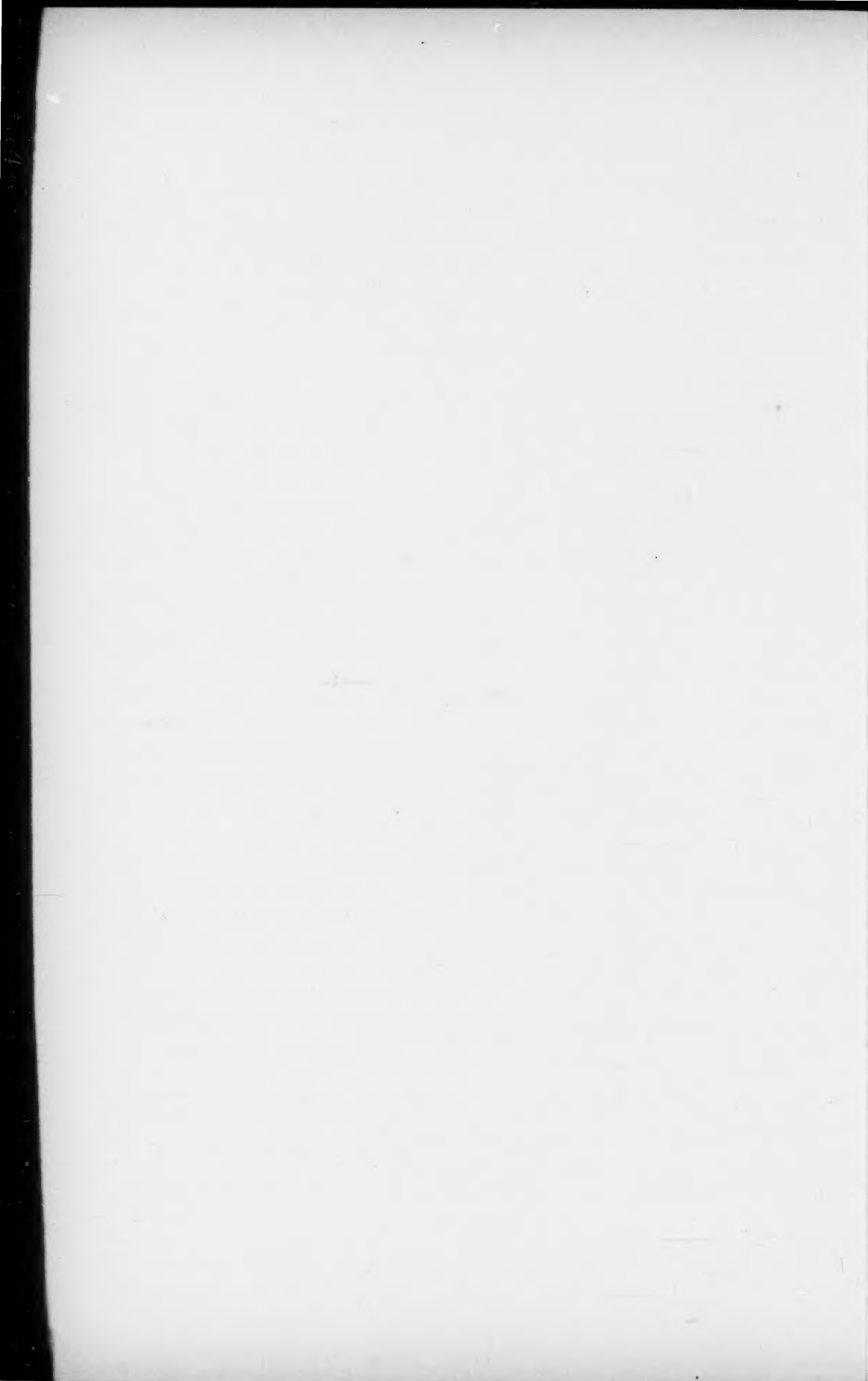
WEST PUBLISHING COMPANY,
Respondent.

MOTION FOR LEAVE TO FILE BRIEF
and
BRIEF AMICUS CURIAE OF
THE LAWYERS CO-OPERATIVE PUBLISHING CO.

In Support of the Petition for a Writ of
Certiorari to the United States
Court of Appeals for the
Eighth Circuit

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16 pp



SUBJECT INDEX

	<u>Page</u>
Motion for Leave to File Brief Amicus Curiae	1
Brief Amicus Curiae of The Lawyers Co-Operative Publishing Co.	4
Description and Interest of Amicus Curiae	4
Publication and "Arrangement" of the Law in Today's Marketplace	6
<i>Wheaton v. Peters</i> : No One May Own the Law, or Charge a Monopolist's Tax for Its Dissemination	8
Other Litigation Spawned by the Decision Below	11
Conclusion	13

INDEX OF AUTHORITIES

Cases

	<u>Pages</u>
Bancroft-Whitney Co. v. West Publishing Co., USDC, D. Minn., Civil No. 4-86-473	11
Banks Law Pub. Co. v. Lawyers Co-Operative Pub. Co., 169 Fed. 386 (2 Cir. 1909)	7, 11
Callaghan v. Myers, 128 U.S. 617 (1888)	7
Continental T.V., Inc. v. GTE-Sylvania, Inc., 433 U.S. 36 (1977)	3
Harper & Row v. Nation Enterprises, 471 U.S. 539 (1985)	6, 8, 10
Marbury v. Madison, 1 Cr. (5 U.S.) 137 (1803)	6n
Sony Corp. v. Universal City Studios, Inc., 464 U.S. 417 (1984)	3, 5
United States v. Loews, Inc., 371 U.S. 38 (1962)	11
Wheaton v. Peters, 8 Pet. (33 U.S.) 591 (1834) ...	8-10, 12, 13

Rules

Rules of the Supreme Court of the United States, Rule 36.1	1, 4
---	------

Other Authorities

C. Joyce, <i>Wheaton v. Peters: The Untold Story of the Early Reporters</i> , Yearbook 1985 of the Supreme Court Historical Society 34 (1985)	8
W. Patry, <i>Latmans The Copyright Law</i> (6 Ed. 1986)	6n

No. 86-891

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1986

MEAD DATA CENTRAL, INC.,
Petitioner,

VS.

WEST PUBLISHING COMPANY,
Respondent.

**MOTION FOR LEAVE TO FILE BRIEF
AMICUS CURIAE**

Pursuant to Rule 36.1, The Lawyers Co-Operative Publishing Co. ("LCP") moves the Court for leave to file the attached brief, as *amicus curiae*, in support of the petition of Mead Data Central, Inc. for a writ of certiorari to the United States Court of Appeals for the Eighth Circuit. Counsel for petitioner has consented to the filing of the brief. To date, we have been unable to reach counsel for respondent, in order to request his consent.

LCP is one of the nation's older and larger law book publishers, whose array of decisional reports, statutes and codes, treatises, and other works include such familiar titles as LCP's Lawyers Edition reports of the decisions of this Court, United States Code Service, California and California Appellate Reports, and American Jurisprudence.¹ As such, LCP is a principal competitor of respondent West Publishing Company, whose counterpart works

¹ Some are published by, or with, Bancroft-Whitney Company, a wholly owned subsidiary of LCP. Per Rule 28.1, we advise the Court that LCP is a New York corporation whose capital stock, and that of its subsidiaries, is privately held.

include West's Supreme Court Reporter, United States Code Annotated, California Reporter, and Corpus Juris.

Although LCP's motion is "not favored" under Rule 36.1, it is presented in the belief that the brief *amicus curiae* may assist the Court in its Rule 17 consideration of both the importance of the questions presented, and the vice of the decision below, particularly in light of West's effort to deflect attention from these matters in its recent Brief in Opposition. LCP's points of motion are these:

1. In its Brief, West portrays the case as a private dispute of no public importance, and even goes so far as to imply that LCP and other publishers should join West's applause of the decision below, which necessarily extends the copyright monopoly to every page of every published report of public law, under the guise of protecting whatever "arrangement" of decisions or statutes is there found. (Br. Opp., 12-13).

2. But just the opposite is true, and an office of LCP's brief is to state why LCP, in contrast to West, believes that the public's right of access to the texts of judicial opinions, statutes, and other embodiments of law should not be impeded by the payment of monopoly tribute to those who publish the law for all to read.

3. The decision below sharply alters the delicate balance of accommodation between private gain and the public necessity of unfettered dissemination of the law, first carefully struck in *Wheaton v. Peters*, 8 Pet. (33 U.S.) 591, 668 (1834). The distinguishing, competitive, and original features of competing law reports are not their common texts of the law as embodied in opinions and statutes, however they may come to be "arranged" in the volumes of each book. Rather, what distinguishes one book from the next is the editorial work product of each publisher, reflected in its own particular headnotes, digests, and annotations. Copyright law properly protects originality in editorial enhancements, but neither West nor anyone else possesses any legitimate claim to "pagination." Page citation is simply the means by which particular passages of the law are conveniently identified by bench and bar, in accordance with custom, practice, and judicially imposed rules of citation. West's views to the contrary deserve a

reply from LCP, so that the Court may know that other law publishers do not share them.

4. West's Brief in Opposition, to which LCP asks leave to respond, is dated December 31, 1986, and a copy was obtained by counsel for LCP only a week ago (January 9, 1987). Technically, therefore, LCP's motion and brief may be out of time under Rule 36.1; if so, we respectfully move also for an extension of that deadline, as it would have been presumptuous of LCP to approach the Court before we knew exactly what West had to say.

CONCLUSION

In *Sony Corporation v. Universal City Studios, Inc.*, 464 U.S. 417, 442-47 (1984), the Court had the benefit of the views of other copyright holders presented at the trial, and in *Continental T.V. Inc. v. GTE-Sylvania, Inc.*, 433 U.S. 36, 54-56 (1977), review was likewise aided by briefs *amicus curiae* of other organizations affected by the challenged restraint. Since presentation of similar views here is beyond the spheres of petitioner and respondent, LCP requests leave to do so by way of the brief attached to this motion.

DATED: San Francisco, California
January 15, 1987

Respectfully submitted,

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No. 86-891

In the Supreme Court
OF THE
United States

OCTOBER TERM, 1986

MEAD DATA CENTRAL, INC.,
Petitioner,

VS.

WEST PUBLISHING COMPANY,
Respondent.

**BRIEF AMICUS CURIAE OF
THE LAWYERS CO-OPERATIVE PUBLISHING CO.**

This brief *amicus curiae*, accompanied by motion for leave to file under Rule 36.1, is presented by The Lawyers Co-Operative Publishing Co. in support of the petition of Mead Data Central, Inc. for a writ of certiorari to review the decision of the United States Court of Appeals for the Eighth Circuit in this cause, reported below at 799 F.2d 1219. The importance of the questions presented is at once obvious from the very requirement that bench and bar cite passages of the opinion below, and of other pertinent decisions, according to the precise pages upon which those passages appear in the decisional reports of respondent West Publishing Company.

DESCRIPTION AND INTEREST OF AMICUS CURIAE

Amicus curiae The Lawyers Co-Operative Publishing Co. ("LCP"), founded over a century ago, is among the nation's leading law book publishers, to whose activities respondent West calls attention at pp. 12-13 of its Brief in Opposition here. LCP and affiliate companies publish a wide variety of decisional reports, statutes and codes, treatises and other legal works, among

the most familiar of which are LCP's Lawyers Edition reports of decisions of this Court, United States Code Service, California Reports, and American Jurisprudence.¹

As such, LCP is one of the many competitors of respondent West, the nation's largest law book publisher, whose counterparts to the works of LCP include such as West's Supreme Court Reporter, United States Code Annotated, West's California Reporter, and Corpus Juris. Indeed, West so blankets the field that the vast majority of offerings by LCP and newer entrants either compete with existing works of West, or spur West to produce counterpart works of its own.²

Perhaps, as West intimates (Br.Opp. 12-13), LCP and other established publishers should join West in applauding the decision below, for new entrants who "pirate" West's works doubtless covet the right to star paginate to the works of LCP and others as well. Indeed, West itself is one of those whose activities it condemns, for every volume of West's California Reporter, for example, cheerfully star paginates to the California Reports and California Appellate Reports of LCP's subsidiary Bancroft-Whitney. West's effort to excuse its star pagination, while simultaneously hectoring that of a newcomer (Br.Opp., 8 and n.19) is simply a denial of this reality: Star pagination has been a widespread practice of legal publishers for over a century, and the necessity and propriety of the practice had never been doubted until the decision below.

Therefore, LCP does not support West's position here, and for many of the same reasons that caused a number of broadcast copyright holders to speak out against the position of respondents in *Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 442-

¹ As noted in the accompanying motion, LCP is a privately held New York corporation. Some of its works are published by or with Bancroft-Whitney Company, a California subsidiary wholly owned by LCP.

² Thus, for example, petitioner's electronic "Lexis" service provoked West to offer "WestLaw," and this litigation is no more than an effort by West to fence-out the originator, in order to make up the distance lost in the competitive race.

47 (1984). At stake here is a matter of public interest and necessity perhaps even more significant than that in *Harper & Row v. Nation Enterprises*, 471 U.S. 539 (1985), for unfettered access to the pronouncements of judges and legislators is access to the law itself, rather than to the private but interesting memoirs of those who make or faithfully execute the law.

The decision below is a heresy which should be rooted out before it spreads.³ The Court should not mistake the views of West for those of others in the industry, and the office of this Brief is to set matters straight.

PUBLICATION AND "ARRANGEMENT" OF THE LAW IN TODAY'S MARKETPLACE

A century or more ago, law "reports" were more analogous to today's treatises and casebooks, for reporters of old frequently published only selected portions of the law, chosen by them to serve some purpose other than complete dissemination of all the law.⁴ So it is that *obiter dictum* about "arrangement," found in early decisions, must not be considered apart from the historical context in which those statements were made. The court below failed to acknowledge changed circumstances, and thereby ignored critical differences in the dissemination of law by publishers in today's marketplace.

Modern publishers have long since abandoned the "casebook approach," in preference to their respective reports of "all" the

³ Patry labels the decisions below "a most extreme misreading" of copyright law. W. Patry, *Latmen's The Copyright Law* 63, n.212 (6th ed. 1986), and the decisions have already spawned litigation between West and LCP's subsidiary, Bancroft-Whitney. See pp. 12-13 of this Brief, *post*.

⁴ For example, the reports of Alexander Dallas (1-4 U.S.) were something of a hodge-podge of state and federal decisions, thought by him to be of primary interest to lawyers of Philadelphia. Had William Cranch not departed from this practice, one might find *Marbury v. Madison*, 1 Cr. 137 (1803) bound up together with writ of dower opinions of the Pennsylvania courts, e.g., *Sharp v. Pettit*, 4 Dal. 212 (Pa. Sup. Ct. 1800).

law, be it all the law of a particular field, or all the law pronounced by a particular court or legislature. For this reason, the order of presentation within particular volumes is no part of the process by which the works of individual reporters compete for public attention and acceptance. Simply put, what distinguishes LCP's Lawyers Edition from West's Supreme Court Reporter is not the order of presentation of decisions within each particular volume, but the editorial enhancements of each publisher—the headnotes, digests, and annotations that reflect the original and different work product of each editorial staff. The latter has always been the proper “stuff” of copyright protection in the field of legal publication. Petitioner's “Lexis” service reproduces not a syllable of any editorial work product of West, and so West's statement that Lexis will “supplant” West's books and “WestLaw” is no more than a confession that West's own editorial enhancements do not enjoy universal respect. For this reason, Lexis offers different editorial work product, some of it supplied by LCP under contracts with petitioner.

West's entire argument about star pagination was put to rest in a single terse sentence of *Banks Law Pub. Co. v. Lawyers Co-Operative Pub. Co.*, 169 Fed. 386, 391 (2 Cir. 1909):

“We concur with [District] Judge Hazel in his reasoning and conclusion that the arrangement of reported cases in sequence, their paging and distribution into volumes, are not features of such importance as to entitle the reporter to copyright protection of such details.”

West quotes dictum in *Callaghan v. Myers*, 128 U.S. 617, 649 (1888), about “case arrangement” (Br.Opp., 8), but that is exactly what plaintiff in *Banks* unsuccessfully cited, to which Judge Hazel replied (169 Fed. at 390):

“This excerpt [of *Callaghan*] conspicuously intimates that, if the elements infringed consisted simply of the arrangements of the cases and the pagination, a different conclusion would have been reached.”

How, then, did the court below fall into such hopeless disagreement with the Second Circuit? The answer, and the reason why a writ should be granted, are one and the same: West's claim of

“arrangement” is nothing but a smokescreen that deflected the attention of the court below from the crucial distinction between uncopyrightable *dissemination* of law and copyrightable comment *about* the law. That is why copyright law has protected editorial work product, but has never before been extended to pagination of reports, the office of which is merely to enable bench and bar to cite particular passages of law in the manner dictated by custom, practice, and judicially imposed rules of citation. West’s effort to erect a tollgate to the dissemination and citation of law flies in the face of the most fundamental principle of *Wheaton v. Peters*, to which we now turn.

**WHEATON V. PETERS: NO ONE MAY OWN THE LAW,
OR CHARGE A MONOPOLIST’S TAX FOR ITS
DISSEMINATION**

The delicate balance of accommodation between the interests of private gain and public necessity, most recently before this Court in *Harper & Row v. Nation Enterprises*, *supra*, was first decisively struck in the very last sentence of *Wheaton v. Peters*, 8 Pet. (33 U.S. 591, 668 (1834)):

“It may be proper to remark, that the court are unanimously of opinion, that no reporter has or can have any copyright in the written opinions delivered by this court; and that the judges thereof cannot confer on any reporter any such right.”

By remarkable coincidence, the Court has available to it not only the arguments of counsel in that cause, but also the recent and fascinating address of one who has given his attention to the history and important principles at stake, Craig Joyce, “*Wheaton v. Peters: The Untold Story of the Early Reporters*,” printed just a month ago in *YEARBOOK 1985 OF THE SUPREME COURT HISTORICAL SOCIETY* 34 (1985). From these sources, several truths emerge:

1. The judges “cannot confer” any copyright in their opinions, because Marshall, Story, and the others were “unanimously of opinion” that the public’s right of access to its laws was far too important to be the subject of whim or monopoly tax extracted by individual reporters, public or private. C. Joyce, *supra*, at 70-71.

As Mr. J.R. Ingersoll summed up for defendant Peters (8 Pet. (33 U.S.) at 619-22):

“It is proper here to draw a distinction between *reports*, the immediate emanations from the sources of judicial authority, and mere *individual dissertations*, or *treatises*, or even *compilations*. These may be of great utility, but they are not the law. * * * Reports are the means by which judicial determinations are disseminated, or rather they constitute the very dissemination itself. * * * The matter which they disseminate is, without a figure, the *law of the land*. * * * Accordingly, in all countries that are subject to the sovereignty of the laws, it is held, that their promulgation is as essential as their existence. * * * It is, therefore, the true policy, influenced by the essential spirit of the government, that laws of every description should be universally diffused. To fetter or restrain their dissemination must be to counteract this policy; to limit, or even to regulate it, would, in fact, produce the same effect. Nothing can be done, consistently with our free institutions, except to encourage and promote it.”

2. That is what the present case is all about. By custom and practice, those whose calling is the law must be able to cite it freely, paying to publishers only the minimum that competition among reporters fairly extracts. For so long as only one publisher chooses to disseminate the law pronounced by a particular court or legislature, it is undeniably true that all will cite to the pages of his report, and pay him a monopolist's charge for that privilege. But that is a natural and proper monopoly, not a creature of the copyright laws, and it is neither necessary nor appropriate to perpetuate that monopoly by erecting copyright barriers as soon as new entrants emerge in the field. The decision below thereby ignores the distinction between *dissemination* and editorial *comment*, eloquently stated by Mr. Ingersoll, upon which *Wheaton v. Peters* rests.

3. Unfettered dissemination of the law is not only useful for its own sake, but also promotes the public interest of competition among those who disseminate the law as given. Thus, for example, Joyce notes that *Wheaton v. Peters* spawned a surge of

entrepreneurial energy at every level of court reporting, particularly in New York, where the important pronouncements of the great Chancellor Kent previously were held ransom "by the exorbitant price asked by the bookseller." C. Joyce, *supra*, at 91, n. 452, quoting 15 Am. Jurist & L. Mag. 249 (1836), in which it was said:

"The decision of the Supreme Court of the United States, in the case of *Wheaton v. Peters*, . . . has entirely shaken the right of property in the written opinions of any court. It is presumed that no just cause of complaint will exist in any quarter, if the admirable judgments of Chancellor Kent should be released from the state of confinement in which they are at present kept by means of the large sums asked for the volumes that contain them. The more extended circulation, which they will naturally have, if published in a cheaper form than that in which they now appear, will contribute to the already widespread fame of Chancellor Kent, and to the increase among the profession of a knowledge of the principles of Equity which he has expounded with so much learning and eloquence."

4. West is the principal beneficiary of *Wheaton v. Peters*, and as we have said, for so long as West alone was the only publisher of decisions of, e.g., the several United States Courts of Appeals, it properly enjoyed whatever profit from that endeavor the traffic would bear. But West is no longer in that position, and the custom, practice, and rules of procedure that require bench and bar to cite to its reports is not a basis upon which to award West a copyright monopoly in the page numbers that facilitate compliance with these obligations of the profession.

5. The distinction drawn between that which is essentially part of the law's dissemination, and no real part of editorial comment about the law, is the very same distinction drawn between former President Ford's uncopyrightable recount of historical fact, and his copyrightable comments about those facts, *Harper & Row v. Nation Enterprises*, *supra*, 471 U.S. at 556. Neither West's wooden citation of that case, nor its lack of attention to the principle upon which it rests, supports West's position here, for "the arrangement of reported cases in se-

quence,” and “their paging and distribution into volumes,” are simply details of dissemination, not of original editorial comment, *Banks Law Pub. Co. v. Lawyers Co-Operative Pub. Co.*, *supra*, 169 Fed. at 391.

6. As noted, the claim that “most importantly, star pagination supplants the need for West’s reporters” (Br.Opp. 5 n.6) is an admission by West that its headnotes and other original editorial comment are not nearly as desirable to the profession as are the opinions to which they are appended. Extension of the copyright monopoly to page numbers and other details of dissemination is to “block-book” the opinions and editorial comment, contrary to the principles of *United States v. Loew’s, Inc.*, 371 U.S. 38 (1962). Per famous footnote 6 of that decision (*id.* at 48), West’s reports of decisions in the Federal Reporter are akin to “Gone With the Wind,” and West’s headnotes are akin to “Getting Gertie’s Garter.”

The foregoing demonstrates the important public issues presented by the petition, and we now turn briefly to other litigation, whose existence belies West’s assertion that the present case is a *sui generis* private dispute of no general interest. (Br.Opp. 12-13).

OTHER LITIGATION SPAWNED BY THE DECISION BELOW

We would be remiss if we failed to mention related copyright litigation, now pending in the district court below, between West and LCP’s subsidiary, Bancroft-Whitney Company.⁵ We not only discharge our obligation to state the whole of LCP’s interest here, but also show, from another perspective, the mischief of the decision below.

Emboldened by the district court’s opinion in the present case, and its affirmance by the court of appeals below, West now seeks to erect yet another “tollgate” to the practice of law. Having succeeded to date on its claim of copyright in the means in which judicial opinions are universally cited, West now claims that its

⁵ *Bancroft-Whitney Co. v. West Publishing Co.*, USDC, D.Minn, Civil No. 4-86-473.

dominion extends also to the *numbers* by which state statutes are universally cited. There is, of course, no difference between the two as equally vital tools of the practice of law, for as Mr. Ingersoll remarked in his argument for Peters, *Wheaton v. Peters*, *supra*, 8 Pet. (33 U.S.) at 619-20:

“Both descriptions of laws are within the principle; the source from which they spring makes no difference; whether legislative acts, or judicial constructions, or decrees, knowledge of them is essential to the safety of all.”

The pending litigation between Bancroft-Whitney and West arises out of the historical fact that, in Texas, West and a predecessor company (Vernon) were the only publishers that chose to disseminate all the statutes adopted by that state's Legislature. This natural monopoly, not a product of copyright or other official grant, is now threatened by Bancroft-Whitney's desire to publish a competing set of statutes and codes, just as it has long done in states such as California.

In 1925, the Texas Legislature recodified all existing civil statutes into a scheme of sequentially numbered articles, and it is now repeating that process in the adoption of sequentially numbered sections of new civil codes. By historical accident, the Legislature has, on occasion since 1925, failed to include an article number in some new civil statutes enacted. In its dissemination of these laws, West has accommodated and cured the oversight by numbering them in its books, according to the Legislature's pre-existing scheme.

Uniformly, however, bench, bar, and the citizens of Texas have come to know and cite the laws of that state by article or section number, without regard to whether the number was affixed by the Legislature, or by West's accommodation of legislative oversight. Nevertheless, as in the present case, West asserts that its copyright monopoly extends to those numbers of citation, under the same guise of protecting West's so-called “arrangements.”

Although we are comfortable in the belief that the facts of the case just described are such as to preclude application of the rule announced by the court of appeals in the present case, the two matters are in parallel so far as the decision in one spawned the

other, and both proceedings cast a dark shadow over the practice of law and the public's unfettered right to have its laws disseminated by more than one publisher.

It is no answer to say that parallel citations, using different page numbers and different statute numbers, each to describe precisely the same pronouncement of law, is a complete or proper solution (Br.Opp. 13). Parallel citations are hardly a necessity, and disuniformity of citation is surely no proper goal of copyright law. In both spheres of the law—opinions and statutes—expansion of the copyright monopoly to include numbers of citation is to interfere with unfettered dissemination, and to defeat the competitive process that has flourished since *Wheaton v. Peters* drew the proper line of accommodation between dissemination and editorial comment.

The new litigation encouraged by the decision below is typical of that which will inevitably arise so long as that decision remains on the books. That is but another way of demonstrating the need for the writ sought by petitioner here.

CONCLUSION

Amicus curiae The Lawyers Co-Operative Publishing Co. submits that a writ of certiorari should be granted, and the decision below reversed.

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Respectfully submitted,

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